

**BIBLIOGRAPHY ON DESIGN PROTECTION**

**SUPPLEMENT 1976**

**Compiled by  
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SUPPLEMENT TO  
BIBLIOGRAPHY ON DESIGN PROTECTION

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### Introductory Note

This annotated bibliography is a guide to recent design protection legislation in connection with proposed revision of the Copyright Act and to specific articles and cases involving copyright, common law and unfair competition, design patents, patents, and trademarks, and with reference to foreign and international law.

It supplements earlier bibliographies on design protection -- a 1955 compilation by Barbara A. Ringer and a 1959 supplement by William Strauss, Borge Varmer, and Caruthers G. Berger, supervised by Barbara A. Ringer.

This publication has been prepared primarily for the purposes and use of the Copyright Office, which is appreciative of the competence and professionalism of Kelsey Martin Mott, Consultant and Compiler of this bibliography.



I. Books and Articles on Protection of Designs

A. Significant Background Material

Bugbee, Bruce W., "The Genesis of American Patent and Copyright Law," Public Affairs Press (Washington, D.C. 1967) 208 pages.

This book contains a foreword by Luther H. Evans who says that Dr. Bugbee has given us in this book "an exciting and readable account of the origins of our patent and copyright statutes." In the last paragraph of his Introduction the author of the book remarks that "in view of the role of the United States patent and copyright systems in stimulating and encouraging American technological and cultural growth, and in view of the need for an intelligent understanding of these systems as legal expressions of concern for the rights of individuals, it is perhaps worthwhile to examine the acorn from which they grew." The book then discusses European Origins, The Colonial Period in America, the Patents of the States, the State Copyright Laws, the U.S. Patent and Copyright Systems; it also contains an Epilogue.

Carroll, Thomas K., Jr., "Statutory Copyright - A Valuable Right for the Visual Artist," Georgia Law Review, Vol.7, No.1 (1971) 134.

The author's conclusion states that the statutory copyright is the only existing method by which an artist may effectively retain rights in his work after it has been sold. Common law copyright affords inadequate protection because it is usually lost prior to the sale of the work. Even if it is still extant at the time of the sale, it may pass to the buyer along with the work. An artist may retain more rights by contractual means, but to obtain contractual rights the artist must enjoy a strong bargaining position which is generally not possessed by the struggling artist. Thus, according to the author, all artists should obtain statutory copyright, but few do so; the national organizations should encourage artists to assign their copyrights to them and then proceed to enforce vigorously these copyrights. "Only then will artists fully realize a proper reward for their creations."



Dienger, John A., "Protection of Industrial Designs," Journal of the Patent Office Society, Vol. 45, No. 10 (October 1963) 673-685.

This article discusses the possibility of arriving at an adequate law for the protection of industrial designs, and maintains that protection is not adequate under either copyright or patent theories. It is proposed that there be enacted a Federal Unfair Competition statute dealing with industrial designs and that there be established a design registration office, with examination for novelty only.

Feldman, Franklin, and Stephen E. Weil, "Legal and Business Problems of Artists, Art Galleries and Museums," Practicing Law Institute (New York 1973) 705 pages.

This is number 36 of the Course Handbook Series, Patent, Copyright, Trademark and Literary Property. According to the Foreword, "This course handbook has been prepared for use at the Legal and Business Problems of Artists, Art Galleries and Museum Workshop.

Part III of this handbook is entitled Court Decisions. Of the cases cited, many were decided in England and relate to contractual arrangements between artists and those with whom they dealt. The American cases include among others, the well-known cases American Tobacco Co. v. Werckmeister, 207 U.S. 284 (1907), and Letter Edged in Black Press, Inc. v. Public Building Commission, 320 F. Supp. 1303 (N.D. Ill. 1970).

Gisla, John F., "Copyright protection for architectural structures," University of San Francisco Law Review, Vol. 11, No. 2 (April 1968) 320-328.

In this article the "question is approached by considering the extent of design protection under the federal patent statute; under the present federal copyright statute and the proposed Copyright Law Revision; and finally under the proposed Design Protection Act. In light of these three considerations copyright protection for artistic architectural structures could and should be included in the proposed Copyright Law Revision."

Goldstein, Paul, "Copyright, Patent, Trademark and Related State Doctrines," Callaghan and Company (Chicago, 1973) 1-938.

This treatise contains comments, notes, articles and cases and there is a part, pages 473-486, relating to Design Patents. In



his preface the author indicates that most people do not understand the difference between patents, trademarks and copyrights, and "this applies to clients, other lawyers and at times even judges." Professor Goldstein also states that "the habit of joint reference to copyright, patent and trademark also tends to play down the vital role of the federal laws' state law counterparts common law copyright, trade secrets and unfair competition, respectively."

Helfat, Bernard A., "Copyright protection for Fashions," Publishing Entertainment, Advertising and Allied Fields Law Quarterly, Vol.3, No. 2 (September 1963) 173-186.

An article which discusses the economic impact of the copyright law in relation to design piracy, and the protection afforded by that law, especially in reference to designs printed on textiles. The author points out that "since mass production of women's clothing became common in this country, the creators of new styles or fashions have been plagued by design piracy...which has thus threatened to destroy the high-style fashion houses completely." The author explains that effective use of copyrights to protect industrial products began with the decision of the U. S. Supreme Court in Mazer v. Stein, 347 U.S. 201 (1954), as a result of which the Copyright Office amended on August 11, 1956 its regulations, 37 CFR, Sec.202,10(b), specifically to authorize registration of designs printed on textiles. The author states that "an order has begun to emerge in the textile industry as a consequence of the use of copyrights, its effect has extended throughout the ready-to-wear garment industry."

The author also refers to S.1884, passed in the Senate of the Eighty-seventh Congress, 1962, which proposed a new type of registration for industrial designs, but remarks that "it would not grant greater protection to designs on textiles than is now available under the Copyright Law."

Jonakait, Randolph, "Do art exhibitions destroy common law copyright in works of art?," Copyright Law Symposium, No. 19 (1971) 81-116.

A study awarded National Third Prize in the 1969 Nathan Burkan Memorial Competition, of the legal problems raised by the question whether the exposure of a work of art to the view of thousands through public exhibition constitutes publication. The author indicates in the course of this discussion that the rules about exhibitions as publications are not settled, and that it might be



wise to counsel artists to show their works only at places that prohibit copying:

"But effective enforcement of such a restriction will not always be feasible... In addition, the logic of American Tobacco [Co. v. Werckmeister, 207 U.S. 284 (1907)] is suspect. Consequently, anyone attempting to counsel artists should feel the insufficient resolution of the tension caused by the application of the concept of publication to art exhibits."

The author concludes that the new proposals in the use of the term publication will ease the tension. "Thus because legal rights will not depend as much on the fact of publication under the new system as now, the tensions centered on exhibitions of art as publications will be lessened."

Kaplan, Benjamin, "An Unhurried View of Copyright: Proposals and Prospects," Copyright Law Symposium, No. 15, Columbia University Press, 1967 (142 p.)

Professor Kaplan's contribution was submitted to the Nathan Burkan Memorial Competition, 1965, and was published in the Columbia University Press, 1967. Lecture three was first published in 1966 in the Columbia Law Review, Vol. 66, No. 5 (May 1966) 830-854.

Professor Kaplan recapitulates the content of the first two lectures: the first "observed the evaluation of copyright from its origins in the English censorship of the sixteenth century to the threshold of the present United States statute, adopted in 1909;" the second "took up and anatomized the modern law of plagiarism--the infringement of copyright by unlicensed imitation of works."

In the last lecture the author comes "to proposals to reform the Copyright Act, which is in large part still the statute as approved on 4 March 1909." This lecture deals with major suggestions relevant to the new draft legislation.

Professor Kaplan refers to the Sears and Compco cases in the third lecture (p. 839): "...in the difficulty of spelling out the precise basis and reach of the 'presumption' of state law by the monopoly statutes or the Constitution, the Sears and Compco cases have been disturbing to those of settled or tidy mind... case[s] covered as to type but failing to qualify as was the configuration.



Kintner, Earl W. and Jack L. Lahr, "An Intellectual Property Law Primer: A Survey of the Law of Patents, Trade Secrets, Trademarks, Franchises, Copyrights, and Personality and Entertainment Rights." Macmillan (New York 1975).

A survey of the field in intellectual and intangible property rights in the United States designed for the general legal practitioner, the business executive, the technical administrator, and the student. Part 2 of the books deals briefly (p. 15) with Designs, pointing out that some designs may be both copyrightable and patentable, and "in such a situation the designer must elect to seek protection under only one of the two laws because the terms of protection are different." Also, "if protection has already been obtained under one of the statutes, some courts have ruled that protection cannot be later sought under the other statute. There is said to be a public interest in having the constitutional grant pass into the public domain as soon as possible." Under part 4 (Trademarks and Franchising) (pp 231-232) there is significant summarization of the subjects of "Label and Package Designs" and "Configuration of Containers and Goods."

The sections referred to do not discuss specific cases but the summarizations include pertinent conclusions about the law on the subjects considered. This is the pattern followed throughout the book, and as the authors state "the most important aspects of the law are clearly explained and difficult or confusing situations are illustrated by real life examples."

Law and the Visual Arts Conference, Portland, Oregon (March 15-16, 1974). Ed. Du Boff, Leonard D. and Mary Ann Crawford Du Boff.

This conference, which took place at Lewis & Clark College, was sponsored by Northwestern School of Law of that college, by the American Society of International Law, the National Endowment for the Arts, the Oregon Arts Commission, and Oregon Volunteer Lawyers for the Arts. The published papers of the speakers are included in eight sections: Section I, Counseling the Artist; Section II, Droit de Suite and Droit Moral-Artists' Property rights; Section III, Copyright Law and the Artist; Section IV, the Protection of Artistic National Patrimony Against Pillaging and Theft; Section V, Museum Acquisition Policies; Section VI, International Trade in National Art Treasures: Regulation and Deregulation; Section VII, Scientific Authentication of Art; Section VIII, the Disposal Past and an Adventure in International Understanding.



New York State: An Act to amend the General Business Law (Chapter 668).

The act relates to the right to reproduce works of fine art, approved June 21, 1966, effective September 1, 1966. The legislature of New York has added a new Article 12-e to the General Business Law (Sections 223 and 224). Section 1 of the Act states that it is "The policy of this state to establish clear guideposts for all parties concerning legal ownership of the right of reproduction of works of fine art." The right of reproduction is to include: reproduction of works of fine art as prints suitable for framing; facsimile casts of sculpture; reproductions used for greeting cards; reproductions in general books and magazines not devoted primarily to art, and in newspapers in other than art or news sections (when such reproductions in books, magazines and newspapers are used for purposes similar to those of material for which the publishers customarily pay); art films; television (except from stations operated for educational purposes or on programs for educational purposes from all stations); and reproductions used in any form of advertising including magazines, calendars, newspapers, posters, billboards, films or television. The right of reproduction does not include certain other reproductions published in various catalogs, art books, etc. all listed in Section 1.

Section 224 of the Business Law pertains to the right to reproduce works of fine art and provides that when an artist or his authorized representative (or, following his death, the authorized representative of his estate) sells any of his work, the reproduction rights thereto are reserved unless expressly transferred by a signed written instrument.

Chapter 668 of the New York Laws of 1966 thus reverses the rule in Pushman v. New York Graphic Society, 287 N.Y. 302 (1942), which held that when an artist sells a picture, the reproduction rights go with it in the absence of evidence to the contrary.

Additional Acts amend the general business law by an Article 12-C on "Artist-Art Dealer Relationships" and an Article 12-d on "Representations and Warranties of Works of Art," both amendments effective September 1, 1966.

Pollock, Phillip R., "Art Print Legislation in California, a Critical Review," Stanford Law Review, Vol. 25, No. 4 (April 1973) 586-604.

The introductory comment states that:



"The demand for works of graphic art has increased dramatically in recent years. For works by the most popular artists, the demand has far exceeded the available supply. As a result, unscrupulous practices ranging from overpricing to fraud have arisen to top this excess demand. Title 1.2 of the California Civil Code effective July 1, 1971, was the first statute in the United States enacted specifically to protect buyers of fine prints against these practices. This Note will first analyze the need for an art print statute, focusing on various types of objectionable selling practices and on the inadequacies of California law prior to the passage of the current Act. Next, the Note will examine the Act and the reasons why it fails to provide adequate protection for buyers of fine prints. Finally, the Note proposes specific revisions to the Act that would expand the scope of its coverage and eliminate its present defects."

Practising Law Institute, "Intangible property: rights and liabilities." (Patent, copyright, trademark and literary property; course handbook series, Vol. 4; New York, 1969) 312 pages.

This was a program devoted to current problems in the protection of tangible property rights, given in San Francisco, January 20-21, 1969. Walter J. Derenberg [and] Spencer Co. Olin were co-chairmen. Some of the topics listed in the contents consist of previously published articles.

Included (in part) in the (17) items are: 1. "Submission of ideas; typical form" by Melville B. Nimmer; 2. "Trade secrets: general considerations"; by John P. Sutton; 3. "Trade secrets: the first employer's case," by Warren T. Jessup; 4. "Trade secrets: the case for the employee," by John P. Sutton; 12. "Thirty months after Sears and Compco," by Seymour M. Bricker; 13. "Current problems in Design protection," by Alan Latman; 14. "Are your designs inventions, trademarks or writings?" by Walter J. Derenberg.

Sheehan, Timothy M., "Why Don't Fine Artists Use Statutory Copyright?—an Empirical and Legal Study", Bulletin of the Copyright Society of the U.S.A., Vol. 22, No. 4 (April 1974) 242-278.

The author states that "visual artists seldom take advantage of the legal protection offered by the copyright statute," and



amplifies by saying that -- "a study of the Copyright Office Catalogue of Entries for the class that includes all visual artists shows that many applied artists (designers of greeting cards, scarves, wall paper...) have taken the necessary legal steps to secure a statutory copyright, while very few fine artists (painters, sculptors...) have taken these steps. The focus of this article is the fine artist and the reasons why most fine artists do not use statutory copyright." The author, (citing cases) discusses specifically the questions whether 1) Do fine artists feel that copyright notice defaces a work of art? 2) Does judicial interpretation of the concept of publication deny copyright protection to fine artists? 3) To what extent is Collector and Art Gallery Director opinion an impediment to fine artists using statutory copyright? According to Mr. Sheehan, "laws need to be passed and classes need to be taught" so that more fine artists will be able to preserve their legal rights.

#### B. Design Protection in the United States

##### 1. Under the Present Law

Comment: "Electronic Plagiarism--the Display of Copyrighted Articles on Television," The Georgetown Law Journal, Vol. 56, No. 2 (December 1967) 360-680.

This comment relates to the decision in Mura v. Columbia Broadcasting System, Inc., 245 F. Supp. 587 (S.D.N.Y. 1965), in which the plaintiff owned copyrights in three hand puppets which she manufactured and sold on the open market, and which defendant purchased and used on the Captain Kangaroo show without permission; the federal district court stated that "the evanescent reproduction of a hand puppet on a television screen...is not a copy" and concluded that "even if such projection were an infringement, the defense of fair use would be applicable."

The writer, in a critical analysis, points out that "in a puppet the creative 'essence' might be embodied in a facial expression, a peculiar body configuration, or even the overall general appearance," and concluded that "however this essence is expressed, a malappropriation in any medium or in a different dimension should still be a 'copy' under the copyright law," in fact the "policy behind the copyright law, in particular the desire to provide incentives for continued advancement, militates in favor of such a holding."



Comments by several eminent scholars upon the opinions in Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964).

Comments requested by the Editors of the Columbia Law Review. Columbia Law Review, Vol. 64, No. 7 (November 1964) 1178-1228. The authors of these comments are: Daphne R. Leeds, Milton Handler, Walter J. Derenberg, Ralph S. Brown and Paul Bender.

Comment, "The Stiffel Doctrine and the Law of Trade Secrets," Northwestern University Law Review, Vol. 62, No. 6 (Jan.-Feb. 1968) 956-974.

The comment states that "the mere existence of a conflict between the patent law and some facets of law of unfair competition need not necessarily call Stiffel into play if there is sufficient evidence of congressional intent not to foreclose the conflict." It states further:

"The Patent Office does not contain an express savings clause regarding trade secrets analogous to section 2 of the Copyright Act. Thus, it might be inferred that Congress did in fact intend trade secret law to be given a Stiffel-like treatment. However, a further examination of the history of the Patent Act and other federal legislation belies that inference, for there is considerable evidence that the patent system was not intended to displace the law of trade secrets...it is a matter of historical fact that the patent system arose to supplement rather than supplant the law of trade secrets... The Patent Act... does not require that an invention be submitted for patenting; thus, the inventor with a patentable product has been given the choice of two equally available rights--patent or trade secret."

Committee Reports, 1975, American Bar Association, Section of Patent, Trademark and Copyright Law, presented at the Annual Meeting, August 8-13, 1975, Montreal, Canada.

Report of Committee No. 402, "Trade secrets, Interference with Contracts, and Related Matters." Subcommittee A of Committee No. 402 reported on the proposed Uniform Trade Secrets Act - proposed Resolution 33. It was resolved that the Section favors the principle of a uniform state law for protection of trade secrets; and the Section was urged to direct efforts toward supporting efforts to have a Uniform Trade Secret Law introduced in the state legis-



latures and enacted in each state. Subcommittee D (Resolution 53) resolved to reaffirm its approval of the enactment of a Federal Law of Unfair Competition by amending the Trademark Act of 1946 and specifically S.1362, 93rd Congress, First Session, introduced by Senators McClellan and Scott on March 26, 1973. It was pointed out here also that the last several subcommittees had not acted in regard to the proposed amendment pending the decision in the Kewanee case relating to the preemption question. [Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 181 U.S. P.Q. 673 (1974)].

"Copyrights--in general--broad copyright protection for textile designs despite absence of notice of copyright from finished dresses," Harvard Law Review, Vol. 73, No. 8 (Cambridge: June 1960) 1613-1616.

A case note on Peter Pan Fabrics v. Martin Weiner Corp., 274 F. 2d 487 (2d Cir. 1960).

NOTE: In Peter Pan Fabrics, Inc. v. Dixon Textile Corp., 125 USPQ 39 (2d Cir. 1960), defendant had also argued that plaintiff's copyright notice was insufficient, under circumstances where purchaser cut off the selvages and sold the fabric in dresses. The Court, on the authority of Peter Pan Fabrics v. Martin Weiner Corp. (supra) rejected this argument. "Weiner teaches that absence of notice is a defense, with the burden on the copyist to show it could have been embodied in the design without impairing its market value." Here as in Weiner, there had been no proof before the District Court on the question whether notice could be so embodied.

"Copyright--design copyrights--requirement of notice," New York University Law Review, vol. 36, No. 3 (March 1961) 745-752.

This article contains comments on Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960). The commentator concludes that "though the result of Peter Pan and Kolbe holdings as a weapon against design piracy is desirable, it is submitted that it was achieved by an unjustifiably liberal interpretation of [the notice requirements of] the copyright law."

Derenberg, Walter J., "Recent Judicial Developments," Copyright Society of the U.S.A., Vol. 12, No. 1 (New York: October 1964) 42-70.

This was one of the papers comprising the Copyright Symposium presented at the annual Convention of the American Bar Association, Patent Trademark and Copyright Section, New York City, August 8,



1974. Pages 49-51, part (g), dealt with "Textile and Fashion Designs," and discussed the cases of Cortley Fabrics Co. v. Slifka, H.M. Kolbe Co. v. Armigus Textile Co., John Wolf Textiles, Inc. v. Sundress Fabrics, Inc., Loomskill, Inc. v. Slifka, Condotti, Inc. v. Slifka, and Clarion Textile Corp. v. Slifka.

Derenberg, Walter J., "The Twentieth Year of Administration of the Lanham Trademark Act of 1946, Bureau of National Affairs, Patent, Trademark and Copyright Weekly Reports, Vol. 154, No. 8, Part II (Washington, September 11, 1967) 48 pages.

A contribution of special interest in view of Professor Derenberg's critical comments on court decisions which reflect the impact of the Sears and Compco cases on state unfair competition law. On the latter point he states in part:

"While Judge Smith of the Court of Customs and Patent Appeals, in his concurring opinion in the Mogen David case, concluded that, contrary to the position taken by the Solicitor of the Patent Office, no conflict between the Supreme Court's decisions and trademark legislation exists even with regard to three-dimensional container devices or configurations which are now or have at one time been the subject matter of design patent or mechanical patent protection, he and the court have thus far left unanswered the question what the effect of the Supreme Court decisions may be with regard to those alleged trademarks which, while enjoying patent protection, are embodied in the commercial product itself, rather than on its container or package."

Derenberg, Walter J., "The Twenty-fifth Year of Administration of the Lanham Trademark Act of 1946, Bureau of National Affairs, Patent, Trademark and Copyright Weekly Reports, Vol. 174, No. 7, pt. II, August 14, 1972 (Washington, 1972) 54 pages.

Of interest are discussions on registrability as trademarks of slogans, and configurations, ornamentation and color devices; section 43(a) of the Lanham Act; and, unfair competition and the "Sears-Compco" doctrine. Specific mention is made in the article (p. 19) to some cases in which the Patent Office Board of Appeals found no likelihood of confusion, and where differences of appearance were involved, for example a "silhouette representation of



a long-haired animal for travel trailers and opposer's "DEERE" and "JOHN DEERE," both per se and in association with a representation of a running deer, for agricultural, earthworking and logging machinery."

NOTE: This Deere case is summarized at p. 235 of this bibliography. Other cases involving pictorial representations for trademarks also appear in the bibliography.

Dorr, William Lent, "Unfair Competition: Simulation of Unpatented Goods: Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964)," Cornell Law Quarterly Vol. 50, No. 1, (Fall 1964) 118-127.

This Note concludes: "The decisions of the Supreme Court in the Stiffel and Day-Brite cases are to be preferred over the Seventh Circuit's interpretation of the law of unfair competition. Although there are arguments against the Supreme Court's position, the Court has, at least, brought the law of simulation of goods into a more uniform relationship with the patent laws, while creating serious doubts as to the extent of unfair competition protection in areas related to copyright. The author states that the consumer has been benefited, at least in the short run; yet states may still impose labeling statutes which require affirmative statements as to source, and adds that congressional action could clarify the law in this area.

Reference is made in the Note to copyright and unfair competition bills before Congress.

Ehrlich, Thomas, "Copyright of Textile Designs--Clarity and Confusion in the Second Circuit," Publishing, Entertainment, Advertising and Allied Fields Law Quarterly, Vol. 3, No. 2 (September 1963), 187-198, reprinted by permission from Michigan Law Review, Vol. 59, No.7, pp. 1043-52.

This article discusses the question of copyright notice on textiles, particularly in relation to Judge Hand's opinion in Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 2d. 279 (2d Cir. 1960). The author stresses the fact that a later decision by the Second Circuit than Peter Pan Fabrics v. Martin Weiner Corp. had left the law in complete confusion, H. M. Kolbe v. Armigus Textile Co., 279 F. 2d 555 (2d Cir. 1960), which on the basis of the Martin Weiner case, granted a preliminary injunction, although one notice appeared for every eight reproductions--each being a reproduction of the same "work of art--and the defendant con-



tended that it was commercially feasible to embody the notice on the design. As the author remarked, "if a temporary injunction is granted in a case like this, the plaintiff has obtained all he wants and the action will usually go no further." Moreover, the author concludes that "there appears no reason why a court rather than the proprietor should determine what is the proper artistic unit."

NOTE: The author, a member of the Wisconsin Bar, indicated that "I spent the last year as Law Clerk to Judge Hand, and happily acknowledge that my views on the subject of this article were tempered by his."

Foster, Stanley H., "Comments on Painton & Company v. Bourns, Inc.," Journal of the Patent Office Society, Vol. 53, No. 11 (November 1971) 732-742.

Comments on both the district court and appellate decision, 309 F. Supp. 271, (S.D.N.Y. 1970), rev'd, 442 F. 2d 216 (2d Cir. 1971), involving mainly the question of the enforceability of trade secrets contracts. The subject-matter related to electronic circuit components known as potentiometers, no patent application having been made.

Goldstein, Paul, "The Competitive Mandate: From Sears to Lear," California Law Review, Vol. 59, No. 4 (June 1971) 873-904.

An article on the Supreme Court's approach to the economy's governing competitive principles "in a series of cases involving administration of the monopolies effected by the state law of trade secrets, common law copyright, unfair competition, and contract."

The writer points out that in Sears (376 U.S. 225 (1964)), and in Lear, Inc. v. Adkins, (395 U.S. 653 (1969)), the Court answered by striking down or severely restricting the state law: "Probably because the Court's answers lack the closely reasoned premises necessary for consistent and principled decision, they have been largely misapplied, circumscribed, or ignored by state and lower federal courts (citing cases) and have stirred no little confusion among scholars (citing articles)."

Hendershot, Thomas R., "Principal Trademark Registration and Patent Policy: an Inherent Conflict which Requires Denial of Registration to Container Designs," Villanova Law Review, Vol. 16, No. 3 (March, 1971) 533-550.



As explained by the author, it is the initial purpose of this comment to examine developing trademark law as it relates to configuration registration; second, to analyze the effect of Sears-Compco upon trademark registration and the status of the apparent inconsistency between those cases and Mogen David; finally, to examine the conflict between patent policy, as stated in Sears-Compco, and coexistent trademark protection, in order to reach a conclusion as to whether the existence of a valid, or expired design patent on a container configuration should, as a matter of law, preclude principal trademark registration.

Kavadas, Thomas, Jr., "Copyright -- Dress Designs -- Design Printed on Dress Fabric is Proper Subject of Copyright," Notre Dame Lawyer, Vol. 34, No. 3, (May 1959) 457-460.

A case note on Peter Pan Fabrics v. Brenda Fabrics Inc., 109 F. Supp. 142 (S.D.N.Y. 1959)

NOTE: This case is summarized in Bibliography on Design Protection, Supplement 1959, 106. (Copyright Office, Library of Congress, July 1, 1959)

Keating, William J., "The Inventor's Dilemma: the right to copy vs. proprietary rights," St. John's Law Review, Vol. 42, No. 1, (July 1967) 38-50.

A discussion of the impact of the Sears and Compco decisions. It arrives at the conclusion that the "lower courts...will follow the decisions only in fact situations which are nearly identical with the fact situations in [these cases, but] where fact situations differ, the courts tend to distinguish these cases and reapply the old-fashioned principles of honesty."

Keegan, Robert R., "Some Intelligence on Intellectual Property--An article on Patents, Trademarks and Copyrights for General Practitioners," The Arkansas Lawyer, Vol. 8, No. 3 (July 1974) 120-124.

This is a brief survey of the respective boundaries of patent, trademark and copyright protection. The author points out in the course of this article that "while trademark protection is primarily an adjunct of the law of unfair competition, the original user of a graphic or three dimensional commercial designation may acquire a trademark right to prevent its use by others similar to the right associated with the intellectual properties, patents and copyrights," citing In re Mogen David Wine Corp., 328 F. 2d 925 (C.C.P.A. 1964). He also emphasizes that the courts themselves are still struggling with the difficult areas; one interesting



and practical question is whether both patent and copyright protection can apply to the same article. He adds that "recently an unusual unqualified answer of 'yes' was given by the Court of Customs and Patent Appeals on this question" in In re Yardley, 493 F. 2d 1389 (C.C.P.A. 1974).

Latman, Alan, "Fifteen Years After Mazer v. Stein; A brief Perspective," Copyright Society Bulletin of the U.S.A., Vol. 16, No. 5 (June 1969) 278-285.

The author points out that:

"Long before turning to existing copyright law, proponents of design protection sought new legislation tailor-made to the needs of new designs... The copyright law protects too few designs with too much protection...it would appear that in the absence of such another form of protection [as that proposed by the design bills recently introduced into Congress] we will witness continuation of the trend issued by the Mazer case and encouraged by the...Supreme Court decisions [Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964); Compco Corp. v. Day-Brite Lighting, Inc. 376 U.S. 234 (1964)] severely limiting unfair competition relief against copying [of which] the predictable result would be coverage of an increasing number of works within a scheme of protection that fits only imperfectly."

Lunsford, Julius P., Jr., "The Protection of Packages and Containers," The Trademark Reporter, Vol. 156, No. 8 (August 1966) 567-577.

An attempt to make a case for the proposition that a distinctive package or container may be a trademark for a product contained therein, in which the Sears and Compco decisions are declared not inconsistent with this proposition.

Michaelsen, Alfred L., "Design Patents and Obviousness--Obvious to Whom?" Idea, The Patent, Trademark, and Copyright Journal of Research and Education, Vol. 13, No. 3 (Fall, 1969) 495-509.

The author at the beginning of the article states that "for years courts have held that when considering a design patent and 35 U.S.C. 103, the test to be applied is whether the design in question would have been obvious to the ordinary designer...one court [Laverne v. Laverne, 356 F. 2d 1003, 148 U.S.P.Q. 674 (C.C.P.A.



1966)] has held that the correct test is whether the design would have been obvious to the 'ordinary, intelligent observer.'" That case is discussed as well as some of the cases opposed to its holding, and the merits of the approach to the question of obviousness and design patents. The author goes on to outline design patents and their history and then to point out that the basic question considered is - when applying 35 U.S.C. 103 to designs - who is the person skilled in the art, "the ordinary designer, the ordinary draftsman, the capable designer, a skilled person with natural aptitudes, et cetera."

In his conclusion the author submits that the Laverne case and the resulting rule or test, i.e. obviousness to the ordinary, intelligent observer and not the competent designer, has much to recommend it and should be adopted by the district courts.

Mott, Kelsey Martin, "The Standard of Ornamentality in the United States Design Patent Law," American Bar Association Bulletin, Vol. 48, No. 6, June, and No. 7, July 1962.

The author discusses the characteristic "ornamental," in the patenting of any "new, original and ornamental design for an article of manufacture." In the first part of this two-part article she covers three main topics: (1) The purpose of the design statutes and a general definition of their subject matter; (2) the legislative history of the design patent statutes; and (3) judicial interpretations with respect to what is ornamental in a design. In the second part the author considers (1) the elements of an ornamental design and (2) aspects of the design itself; she also summarizes the important judicial determinations and definitions which relate to design in their ornamental aspects.

Mott, Kelsey Martin, "The Concept of Small Patent in European Legal Systems and Equivalent Protection under United States Law," Virginia Law Review, Vol. 49, No. 2 (March 1963) 232-261.

The author explains that the conflict between a patentee's right to protection and society's need to generally exploit its inventive skill has led to various systems designed to best accommodate these various interests. The requirements for patentability for both "inventions" and "designs" include inventiveness and novelty. Some of the major systems which employ a short-term patent for protection of innovations requiring less originality than ordinary patents are explored by her, and the arguments for and against this type of legislation are presented in light of the possibility that this sort of protection may be provided in the United States.



Nimmer, Melville, "Nimmer on Copyright," (Albany: Matthew Bender: 1963) 1220 pages, loose leaf. Supplements through 1975.

A very interesting and complete treatise on the subject of copyright. In its sections 19-20 and other references in this work, Professor Nimmer discusses works of art and reproductions of works of art, including textile designs, pointing out that "with respect to works of art the requirement of minimal creativity is not applied as a matter of policy [as with other types of works] but rather as a matter of definition. That is, unless a work evidences 'some creative authorship in its delineation or form' it cannot by definition be regarded as a work of art." He refers to Webster: "Art: ...application of skill and taste according to aesthetic principles..." Webster's New International Dictionary 2d Ed.

Professor Nimmer's text is amply supported by citation of cases, kept up to date by the yearly Supplements.

Peterson, John R., "The legislative mandate of Sears and Compco: a plan for a federal law of unfair competition," Dickinson Law Review, Vol. 69, No. 4 (Summer 1965) 347-348.

As indicated "this article reviews briefly the decisions of the [Supreme] Court in Sears and Compco and the historical developments of the law of unfair competition. Consideration is then given to several possibilities for legislation on unfair competition at federal and state levels."

Ringer, Barbara A., "Copyrights--Relationship to Patents," in The Encyclopedia of Patent Practice and Management, Calvert, Robert, ed. (New York, Reinhold, 1964) 165-170.

An article comparing and contrasting copyright and patent protection, with special attention to the relationship and overlapping of the two.

Ringer, Barbara A. and Mott, Kelsey Martin, "Design Patents", in The Encyclopedia of Patent Practice and Management, Calvert, Robert ed. (New York, Reinhold, 1964) 198-203.

An article on the protection afforded designs under the patent law, including and comment on originality as a standard of protection under both the copyright and patent laws.



Ringer, Barbara A. and Strauss, William. "Trends Indicated in the 1959 Supplement to the U. S. Copyright Office Bibliography on Design Protection," Bulletin of the Copyright Society of the U.S.A., Vol. 7, No. 6 (New York: August 1960) 281-286.

This article refers to the issuance by the Copyright Office on June 1, 1959 of a Supplement to the Bibliography on Design Protection published in June 1955, and emphasizes that there had been since 1955 a number of striking developments in the design protection area, including the introduction of two new design bills, the Willis Bill of 1957 and the O'Mahoney Bill of 1959, and that since the decision by the Supreme Court in Mazer v. Stein, 347 U.S. 201 (1954) the courts had been increasingly liberal in their attitude towards copyright in designs.

Ringer, Barbara A. and Gitlin, Paul, "Copyrights," Practising Law Institute, Revised Edition (1965) 187 p.

This work includes at pages 8, 11-12 an explanation that the copyright statute lists classes of copyrightable works, but adds that these "specifications" shall not limit the subject matter of copyright"; however, these provisions do not include industrial designs, even though Class G of section 5 of the law refers to works of art and designs for work of art. As pointed out by the authors-- "This classification, which has been the subject of much controversy and litigation since 1950, covers both works of the 'fine arts'-- paintings, drawings, and sculpture--and also 'works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspect' are concerned." 37 C.F.R. Sec. 202.10(a). The authors refer to the fact that unregistrable designs include automobiles, refrigerators, pots and pans, furniture, wearing apparel and machinery. This distinction is spelled out in its regulations. 37 C.F.R. Sec. 202.10(c).

Also mentioned was a regulation issued after the decision in Mazer v. Stein, 347 U.S. 201 (1954), C.F.R. Sec 202.10(b), which includes other refinements as to what a work of art must embody to be acceptable for registration by the Copyright Office, and a statement that "the potential availability of protection under the design patent law will not affect the registrability of a work of art, but a copyright claim in a patented design or in the drawings or photographs in a patent application will not be registered after the patent has been registered."



Spratling, Gary R., "The Protectability of Package, Container, and Product Configurations," University of San Francisco Law Review, Part I, Vol. V, No. 2 (April 1971) 451-515; Part II, Vol. VI, No. 1 (October 1971) 172-202.

This comment discusses whether a manufacturer may prevent a competitor from copying the shape of his package, container or product... The comment looks to the three types of protection for copying of shape for which a manufacturer might qualify; common law unfair competition protection with its requirements of secondary meaning and nonfunctional shape; design patent protection with its requirements of ornamentality, novelty and invention; and a federal trademark registration (Lanham Act) with its requirement of distinctiveness. Since the relationship of these three bodies of law was thrown into some confusion by the 1964 Supreme Court Sears and Compco decisions, the comment's analysis of protection from copying is divided into two major sections: (Part I) the scope of unfair competition, patent, and trademark protection prior to Sears and Compco; and (Part II), the continued vitality of these two areas - state unfair competition, patent, and trademark protection prior to Sears and Compco; and stressing the continued vitality of these two areas in the wake of these two Supreme Court decisions.

Symons, William L., "The Law of Patents for Designs," John Byrne & Co. (Washington, D.C. 1914) 134 pages.

This treatise did not appear in the Bibliography on Design Protection of 1955 and that of 1959 and is therefore included in this later Bibliography because it is frequently cited. The author indicates in his Preface written in 1914, that only two treatises on the subject of design patents had been published in the United States during the seventy-two years the laws granting patents for this character of inventions had been in force. The two mentioned were by William E. Simonds, (1874) and Hector T. Fenton (1889). The Simonds work, The Law of Design Patents, is mentioned in the 1955 Bibliography. After Mr. Symons' work appeared in 1914, another significant treatise appeared in 1929 and is also mentioned in the 1955 Bibliography on Design Protection, Patents for Designs (1929) by William D. Shoemaker.

"Trademarks--the Lanham Act--Existing design patent does not preclude trademark protection on shape of wine bottle," Harvard Law Review, Vol. 78, No. 6 (Cambridge: April 1965) 1269-1273.

A critical note on the decision in In re Mogen David Wine Corp. 51 C.C.P.A. (Patents) 1260, 382 F. 2d 925 (1964). The note explains



that as a result of Mogen David, the holder of a design patent may obtain a perpetual trademark on his innovation, even though the patent provided the holder with only a limited-term monopoly; thus the patent holder is able to use his patent grant, which prevents others from copying the innovation, to develop sufficient consumer identification necessary for Lanham Act registration. The writer of the note considers the decision anomolous in the light of Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964), in which the Supreme Court held that because plaintiff's design patent on a lighting fixture reflector was invalid, plaintiff could not obtain relief under Illinois unfair competition law to enjoin defendant from copying the design; "such relief would interfere with the federal policy...of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."

"Unfair Competition--Extent to which State Law of Unfair Competition may Prohibit Imitation of Commerical Product Designs," Vanderbilt Law Review, Vol. 17, No. 4, (October 1964) 1561-1564.

A note on the Sears and Compco decisions. The note concludes that all the Supreme Court has done is to restrict the doctrine of unfair competition to its original objective, the prevention of consumer confusion; the states may require proper labeling and advertising of the product to prevent the consumer from being misled as to its source, but may not enjoin the imitation itself:

"It should be noted that possibly the main reason that the law of unfair competition had been extended to the point of granting common law patents was the failure of the federal patent laws to grant adequate protection against product imitation. Now that whatever protection the states felt justified in giving to a first comer has been largely swept away, there is an even larger void in the amount of protection one may secure for an original product or design. As a result, assuming that federal common law will not be applied, the demands of the public for an extension of the patent laws to fill this void may be expected to increase."

Voorhees, Michael G., "Protecting architectural plans and structures with design patents and copyrights," Drake Law Review, Vol. 17, No. 1 (December 1967) 79-93.

The author commented that:



"The big disadvantage of copyright protection is that the scope of protection is limited to the drawings which are not a final manifestation of the architect's work product. Also, because of the requirement of showing copying to prove infringement, it is often difficult to successfully prosecute infringers. A design patent, on the other hand, directly covers the work product of the architect--the design and appearance of the building. If its validity could be counted upon, the design patent would provide ideal coverage for the architect. However, the fact that the validity of the design patent is always questioned in an infringement suit, and the frequency with which courts rule patents invalid leaves the architect in a very insecure position. Perhaps the answer is to obtain both types of protection. The Stein and Vacheron cases...indicated that the law will allow double coverage. Another course which architects may pursue is to seek legislation which will grant a type of protection under either the copyright or patent laws which is particularly adapted to the architect's needs."

Wydick, Richard C., "Trade Secrets, Federal Preemption in Light of Goldstein and Kewanee," Journal of the Patent Office Society, Vol. 55, No. 12 (December 1973) 736-758; Vol. 56, No. 1 (January 1974) 4-29.

The author of this article explains that the Sears and Compco cases (Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225; Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234) decided by the United States Supreme Court in 1964, touched off what has become a continuing debate over federal preemption of the state law of trade secrets. "The Court's 1969 decision in Lear, Inc. v. Adkins, (395 U.S. 653) gave further support to those who predicted that state trade secret law could not stand in the face of the patent and copyright clause of the Constitution (Act. I, § 8, cl. 8) and the federal patent laws." In further explanation the author said: "The question of trade secret preemption has now been considered by five of the United States Courts of Appeal. Four have concluded that there is still life in state trade secret law. But...the Sixth Circuit concluded that no state trade secret protection could be given to plaintiff's unpatented secret manufacturing process...Kewanee Oil Co. v. Bicron Corp. 478 F. 2d 1972 (6th Cir. 1973)."



This author concludes that the Kewanee case is in error: "state trade secret law should not be found in conflict with the Constitution, nor should it be deemed preempted by federal legislation."

NOTE: This article was written before the Kewanee case had reached the United States Supreme Court, which reversed the decision of the Sixth Circuit. Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974). See reference to the Supreme Court decision at p. 161 of this bibliography.

## B. Design Protection in the United States

### 2. Under Copyright Principles as Proposed in the Copyright Revision Bills.

American Bar Association 1975 Committee Reports. Section of Patent, Trademark and Copyright Law, presented at the Annual Meeting, August 8-13, 1975, Montreal, Canada.

Report of Committee 305, "Program for Protection of Industrial Designs." The subjects reported upon were 1) "Protection of Ornamental Designs of Useful Articles," and 2) "Concurrent Protection of Designs under both Copyright and Design Patent Law." As to the first subject there was no proposed resolution.

The report discussed briefly Title II of S.22, introduced by Senator McClellan in the 94th Congress, providing for the protection of ornamental designs of useful articles.

In discussing the second subject the report of the Committee referred to In re Yardley, 181 U.S.P.Q. 331 (CCPA 1974), which held that a design which was already protected by copyright could also be protected currently by a design patent.

Cambridge, Research Institute, "Omnibus Copyright Revision," American Society for Information Science (Washington, D.C. 1973) 1-280.

In the Foreword, Arthur B. Hanson, who commissioned this study, points out that several organizations chose to participate in support of this project of an overall study, including a comparative analysis of the proposed copyright law legislation vis-a-vis the existing law, to prove of assistance "to all persons concerned with copyright law and particularly to Senator McClellan's sub-Committee and its staff as well as to the House sub-Committee considering the same."



The study was requested in 1972 and took into consideration the proposed S. 644 then before the 92nd Congress and the predecessor of S.1361, introduced in the 93d Congress in 1973.

NOTE: There is no mention of section 113 of the revision bill (pictorial, graphic and sculptural works) in this work and Title III (later Title II) relating to protection of designs had not yet been incorporated into the revision bill.

Casser, Donald G., "Trade Regulation: Legal Protection of Commercial Design," Wisconsin Law Review, No. 4, (July 1959) 652-666.

The purpose of this comment, as indicated, is to examine each of the legal sources of design protection with the emphasis on marking out their limitations and, in addition, to submit a method of analysis for the assessment of present and future design protection legislation.

Copyright Office, Library of Congress, Circular 99 (Washington, D.C., June 1975). "Highlights of the Copyright Revision Bill," H.R. 2223.

A companion bill to S. 22.H.R. 2223 was introduced on January 28, 1975 by Representative Robert W. Kastenmeier, chairman of the Sub-committee on Courts, Civil Liberties, and the Administration of Justice of the House Judiciary Committee.

With respect to the last item, Ornamental Designs of Useful Articles, the circular explains that the bill contains, as a separate title (Title II), provisions for the protection of ornamental designs of useful articles. This measure, which as a separate bill had in previous Congresses been passed by the Senate and introduced in the House, would provide a new form of protection for five, or, if renewed, ten years to designs that may not be appropriately or adequately protected under the copyright or design patent statutes.

Dulin, Jacques M., "Design Protection: Walking the Pirate Plank," Copyright Society of the U.S.A., Vol. 12, No. 6 (August 1965) 321-360.

This article discusses the arguments of the three opposers of the current design protection bills, particularly S.776, which passed the Senate, December 6, 1963, (88th Congress, 1st Session (1963)) after having been introduced by Senators Hart and Talmadge; the



opposers being the National Retail Merchants Association, R.H. Macy & Co., Inc. and the Apparel Industries of New England. The author in his conclusion states that Congress has sufficient evidence to determine that piracy is unfair competition, and the proposed "design-right" protection is more "monopoly" than is copyright; that nothing NRMA states contradicts that evidence, their arguments being factually unfounded. The author also states that "copyright-type design protection remains the best solution, and promises competition with respect to designs without excessive protection."

"Protection for the Artistic Aspects of Articles of Utility," Harvard Law Review, Vol. 72, No. 8, (Cambridge, June 1959).

The author of this note indicates that it is intended to "examine the protection which can be found for designs for articles of utility under existing law, and will assess the problems confronting any legislative effort to grant more extensive protection for such designs."

Hellmuth, Theodore, "Obsolescence Ab Initio: The New Act and Architectural Copyright", Bulletin of the Copyright Society of the U.S.A., Vol. 22, No. 3 (February, 1975) 169-198.

The author stresses that neither the present Copyright Act nor the revision bill (S.1361, 93d Cong., 1st Sess. 1973) directly mentions architectural protection at all; the best solution is to set out explicit statutory guidelines in this area.

There is some interesting discussion of the revision bill, especially of the separate sections in it entitled "Protection of Ornamental Designs of Useful Articles" [Title III of the bill, now entitled Title II in the latest bill, H.R.2223, 94th Congress, 1st Session, July 17, 1975, §§201-235]. The author raises two questions: First, is there any compelling reason for creating a design copyright, separate from other copyright, and second, if the answer to the first question is yes, should works of architecture be treated under the main copyright scheme, or under the design copyright scheme.

The article discusses the experiences of other countries in this area, as well as the provisions in the U.C.C. and Berne texts to be considered in relation to architectural works, pointing out that there is no specific reference in Article I of the 1971 revision of the U.C.C. to such works, although there is no prohibition of protection for such works.



In any event, the author concludes that copyright should protect the architect of an original work and that he should be protected if he creates an original building.

Latman, Alan, "The New Design Protection Proposals Before Congress," Copyright Society Bulletin of the U.S.A., Vol. 8, No. 6 (New York: August 1961), 356-358.

Reference is made in this article to the identical design proposals, H.R. 6776, H.R. 6777 (87th Congress) introduced by Congressmen Ford and Flynt respectively and S. 1884 (87th Congress); the House bills paralleled the differences between the O'Mahoney-Wiley-Hart bill and the Talmadge bill. The author explains that the basic status quo with respect to copyright for works of art applied to or embodied in useful articles is thus preserved by the two bills, and that the only modifications on present law are: (a) "Useful articles" cannot be deposited in the Copyright Office; (b) The proprietor of a copyright in a work later embodied in a useful article who obtains registration for the resulting design under the design law cannot thereafter claim copyright protection in useful applications of his work.

The author adds that the other principal changes introduced in the two bills are summarized: a second five year term of protection is available; the screening or "limited opposition" procedure has been replaced by a provision for administrative cancellation; the definitions of excluded designs and the burden of proving originality have been refined.

Latman, Alan. "A Proposal for Effective Design Legislation: S. 2075 Examined," Bulletin of the Copyright Society of the U.S.A., Vol. 6, No. 6 (New York: August 1959) 279-286.

This article examines new federal legislation protecting the appearance of useful articles, S. 2075, introduced by Senators O'Mahoney, Wiley, and Hart on May 28, 1959. The author carefully compares this bill with the bill, H.R. 8873, previously introduced in the Eighty-Fifth Congress by Representative Willis, and indicates the changes made by S. 2075. The author's conclusion was that: the draftmen of S. 2075 had not solved all the problems since they were faced with the need for a delicate balance of interests which defies the drafting of a perfect piece of legislation in this area; it seemed clear, however, that they had taken full account of the need for legislation which protects, but neither unduly nor unfairly; S. 2075 represents notable progress toward moderate and equitable design legislation.



Comment: "Design Protection--Time to Replace the Design Patent,"  
Minnesota Law Review, Vol. 51, No. 5 (April 1967) 942-961.

The introduction to this comment states that:

"Although designs are not creations which would be attributed to an act of invention, they have long received patent protection in the United States. In providing such protection both Congress and the courts have analogized the standards for protecting designs to rules for granting mechanical patents. Since this analogy is basically unsound, Congress has had difficulty formulating legislation to provide suitable protection and the courts have found it difficult to apply these statutes. Although the courts have recently tended to alter their interpretation of the statutory standards of patentability for designs, resulting in a standard analogous to that applied under the English registration system, an examination of present design protection clearly indicates the need for reformation."

A recommendation is made for the formulation of an act "which would implement the desirable features of the present design protection law," and language is proposed to help provide a framework for such an Act.

Mott, Kelsey Martin, "An Analysis of the 'Unity of Art' Concept in European Legal Systems," Copyright Society Bulletin of the U.S.A., Vol. 11, No. 4, (April 1964) 242-261.

The article discusses the question whether useful articles of original character can or should be protected by a general law of copyright, even though they may not appear to contain elements which "speak of art," and considers the theory known in certain European countries as "the unity of art."

The author summarizes the important aspects of the "unity of art" concept: In European legal systems, particularly as understood in France and Belgium, the countries of leading proponents, the concept means that industrial designs should be assimilated to artistic designs and accorded the same protection. The conclusion is that the concept of unity of art has not actually been realized in the United States, although the easiest avenue would be paved by copyright, were the "work of art" concept not so rigid. Finally, the author says:



"Perhaps the best way to encourage the creative modern designer of the utilitarian articles of every day life would be by a special law tailored to meet his needs and those of the public, leaving the copyright law available for pictorial, graphic and sculptural works which can be identified as works of art even though embodied in a useful article."

NOTE: A French translation of this article appeared with permission, under the title "Analyses du concept de l'unite de l'art dans les systemes juridiques europeens," in Interauteurs, No. 160, (3d quarter 1965) 251-256.

Mues, Gregory R., "Dual Copyright and Design Patent Protection: Works of Art and Ornamental Designs," St. John's Law Review, Vol. 49, No. 3, (Spring 1975) 543-575.

This article comprises an overview of the development of copyright and patent law made in order to fully appreciate the significance of the decision in In re Yardley, 493 F.2d 1389 (C.C.P.Q. 1974). The author explains that the legislative evolution of copyright and design patent statutes has resulted in an overlapping zone of protection with respect to certain works of art and ornamental designs, and that in a recent break with precedent, the Court of Customs and Patent Appeals in In re Yardley disregarded the election doctrine, holding that the proprietor of an artistic design for a work of art may, in a proper case, obtain dual copyright and design protection. The author comments, however, that the court in Yardley, although it did not consider the design as obvious in comparison with another design referred to, had apparently overlooked the "test of obviousness" under sec. 103 of 35 U.S.C. also applicable to design patents (sec. 171, 35 U.S.C.). Reference is made in this connection to the [landmark] case of Graham v. John Deere Co., 338 U.S. 1 (1966).

The author also refers to the fact that the repeal of the design law has often been suggested and that coupled with the design for repeal, proposed reforms, aimed at mitigating the rigors of design protection, have been recurrent. He gives for an example of a more recent proposal, Title III [now II] of the draft of the general revision of the Copyright Law, S. 1361, 93d Congress, 1st Session (1973), providing for copyright protection for "Ornamental Designs



of Useful Articles," Finally, the author remarks, "For the present, however, Yardley offers the correct conceptual approach for acquiring both copyright and design patent protection, despite the practical obstacles involved."

NOTE: The Yardley case is referred to at p. 225 of this bibliography as is the Graham case at p. 227.

Myers, Gary R., "Section 113 of the Proposed Copyright Law Revision - a Proposed Amendment to Protect the Utilitarian Aspects of Useful Articles," Dickenson Law Review, Vol. 72, No. 2 (Winter 1968) 307-324.

This article proposes an amendment to section 113 of the copyright revision bill, S. 597 (90th Congress, 1st Sess., 1967), which section is essentially a modification of existing case law, Mazer v. Stein, 347 U.S. 949 (1954) with a few minor extensions. The proposal among other provisions, would afford protection which would begin upon publication of the three dimensional embodiment of the useful article with the proper copyright notice and would last for three years from the date of publication or until a patent issues, whichever occurs first. In the event of infringement the only available remedy should be a reasonable royalty imposed upon the infringing party for all acts of infringement during the term of the useful article copyright.

The author explains that what is proposed is the protection of an idea and not the expression of that idea--patent language in a copyright setting--and it is simply an effort to protect useful articles at an earlier date than they are now protected, recognizing that the reason for the delay is the administrative process of the design patent procedure.

Report of the President's Commission on the Patent System. "To Promote the Progress of...Useful Arts," U.S. President's Commission (Washington, D.C. 1966) 58 pages. (U.S. Government Printing Office, Washington, D.C.).

Recommendation IV of the Commission would end the practice of granting patents on designs:

"The Commission believes strongly that all inventions should meet the statutory provisions for novelty, utility and unobviousness and that the above subject matter cannot readily be examined for adherence to



these criteria.

Designs: A patent may now be granted on any new, original and ornamental design for an article of manufacture. Despite the statutory requirement of unobviousness, patents on designs are now granted, in effect, solely on the basis of novelty. Courts often find these patents invalid on the ground that the design is obvious. The Commission is aware of legislative proposals to protect ornamental designs against copying. Nevertheless, it believes that some means outside the patent system should be developed for the protection of new and original ornamental designs."

Rich, Giles S., "The Design Bill," Idea. Vol. 9, (1965) 127-134.

A brief survey of efforts to obtain more effective design protection legislation in the United States, delivered as an address at the Ninth Annual Public Conference sponsored jointly by the Patent, Trademark and Copyright Research Institute of the George Washington University and The Commemorative Committee of the 175th Anniversary of the United States Patent System.

Ringer, Barbara A., "The Case for Design Protection and the O'Mahoney Bill," Bulletin of the Copyright Society of the U.S.A., Vol. 7, No. 1 (New York: October 1959) 25-32.

The author points out that although the design patent law for its first 60 years appeared generally adequate, demands for congressional action to afford more effective design protection arose for reasons carefully explained: the requirement of novelty and the expense and delays in searching to determine whether a design is new; the requirement of "invention," which for the majority of designs that have been tested in the courts has proved an impossible standard to meet. The author explains that since the decision in the Mazer case, (Mazer v. Stein, 347 U.S. 201, 1954), the existing copyright law has become a major factor in design protection, but is inappropriate for this purpose. The author also explains that what is needed is a well-considered piece of legislation which the design bill, S. 2075 introduced by Senators O'Mahoney, Wiley, and Hart on May 28, 1959 is intended to accomplish; thus the bill does not require that the design be either "novel" or "inventive," but that it must be original and ornamental. The article contains in addition a summary of other aspects of the proposed legislation, "tailor-made to meet the contemporary design



situation."

NOTE: This article was first a paper delivered to the Ninth Annual Symposium on Copyright of the American Bar Association, held at the Annual Meeting of the Section in Miami, August 22-28-1959.

Sharpe, Albert P. III, "Copyrights and design patents--the common zone between," Cleveland-Marshall Law Review, Vol. 11, No. 2 (May 1962) 336-362.

The author traces the nature and extent of the area of overlapping protection under the copyright and design patent law and outlines the historical evolution of these laws. He also discusses the bills on design legislation of the 85th and 86th Congress, the Willis bill (H.R. 8873, 85th Cong. 1957), the O'Mahoney bill (S. 2075, 86th Cong. 1959). The author considers both the O'Mahoney and Talmadge bills, although they differ somewhat, are a long stride forward in providing the kind of protection a designer needs to protect his business effectively without at the same time subjecting his competitors to unwarranted restrictions. In his conclusion, the author states that the existing law on design protection is "confusing and disordered, with the result that the applications of law to facts is frequently inequitable and lacking in uniformity."

Silverman, Arnold B., "The Scope of Protection of Copyrights and Design Patents in the United States," University of Pittsburgh Law Review, Vol. 24, No. 1 (October 1962) 21-57.

This article, which won an award in the Nathan Burkan Memorial Competition [see Copyright Society of the U.S.A., Vol. 11, No. 1, (October 1963) 60, and ASCAP, Copyright Law Symposium, No. 12, (Columbia 1962) 152-200], explains that:

"It has been stated repeatedly that neither copyright nor design patent protection offers adequate protection for the industrial design. These designs often do not fall within the area of permissible subject matter for copyright protection, yet design patent protection may be unavailable due to a lack of novelty or invention. In addition to the inadequacy of the present system from the standpoint of the difficulty of qualifying for either a copyright or a design patent, there is the further problem that the rights obtained, if an industrial design



should qualify, are not adequate. Independent statutory recognition for the industrial design has been suggested as the only adequate solution to the problem" [citing Ringer, "The Case for Design Protection and the O'Mahoney Bill," Copyright Society of the U.S.A., Vol. 7, No. 1 (New York: October 1959) 25.]

Waldheim, Franklin, "Don't Maim our Copyrights," Copyright Society Bulletin of the U.S.A., Vol. 7, No. 4 (New York; April 1960) 160-163.

The Editor's note to this article explains that:

"The authors, [Assistant Counsel for Walt Disney Enterprises] while in favor of the new Design Law (S. 2075) [86th Congress], expresses disagreement with the part of the O'Mahoney Bill which would provide that, after embodying the work of art in a design of a useful art, the 56-year protection of the Copyright Law would be replaced by the five-year term... Mr. Waldheim favors the recently introduced Talmadge and Flynt Bills (S. 2852 [86th Congress] and H.R. 9870 [86th Congress])... which would leave the original copyright protection intact even after embodiment of the design in a useful article of manufacture."

NOTE: This author in a later article entitled "The Anti-Maim Rule-New Design Bill Shares Majority View Among Nations," Copyright Society Bulletin of the U.S.A., Vol. 8, No. 6 (New York: August 1961) 359-362, states that the point of view expressed in the earlier article (supra)--that in any law enacted for the protection of designs there should be no impairment of any of the rights afforded under the Copyright Law--has been adopted in the three identical bills introduced in the Eighty-Seventh Congress by Senators, Hart, Wiley and Talmadge (S. 1884) and by Congressmen Flynt (H.R. 6776) and Ford (H.R. 6777). The author points out that "the Hart bill provides for the protection of designs of useful articles but it specifies that the use of a copyrighted work upon a useful article shall in no way impair the protection afforded under the Copyright Law," and explains by reference to the laws of certain other countries, that "this bill enunciates a principle which is recognized by the great majority of the industrial nations of the world and passage of the bill would place the United States in harmony with the dominant theme of international thought."



Wasserman, Andrea Weiner, "Protection for Pirates? Lack of Statutory and Common Law Safeguards Against Copying in the Fashion Industry," Suffolk University Law Review, Vol. 5, No. 2 (Winter 1971) 487-503.

A discussion of the lack of effective design protection in the fashion industry with the conclusion that there is no apparent reason why that section of the copyright law which deals with "works of art and artistic craftsmanship" has to be revised in order to justify a judicial decision favorable to copyright protection for a dress design.

The author discusses the statutory protection afforded by the Design Patent Law, 35 U.S.C. § 171 (1964), indicating that protection given to dress designs under that law is illusory. Reference is also made to Title III (now Title II of S. 543 (91st Congress, 1st Session (1969)), the Copyright Revision Bill; that proposed legislation, entitled "Protection of Ornamental Designs for Useful Articles" specifically excludes coverage for a design that is "composed of three-dimensional features of shape and surface with respect to women's, and children's apparel, including undergarments and outerwear." The writer, in concluding that the Copyright Act is adequate to protect dress designs, refers to the "Works of Art" section of that Act 17, U.S.C. § 5 (g) 1964, and to the Copyright Office ruling 37 C.F.R. 202. 10, which embodies the holding in Mazer v. Stein, 347 U.S. 201 (1954). The author submits that a lamp (Mazer) is no less utilitarian than a dress, and that - "If the goal of federal and patent law is to encourage technological and non-technological creativity, it seems clear that an artistic creation by a dress designer ought to benefit from federal protection."

### C. International Design Protection

Benelux: Uniform Benelux Designs Law: Industrial Property, Vol. 13, No. 4 (April 1974) 178-182.

The Benelux Convention (Belgium, Luxembourg, Netherlands) held at Brussels, October 25, 1966, annexed to the Convention the "Uniform Benelux Designs Law" to enter into force January 1, 1975.

The Annex to the law (Chapter I, Designs) provides, Article I, that the "new appearance of a product having a utility function may be protected as a design." Article 3 states that without prejudice to the right of priority under the Paris Convention for the Protection of Industrial Property, the exclusive right to a design shall be acquired by the first deposit within the Benelux



territory and registration with the Benelux Designs Office or registration with the International Bureau for the Protection of Industrial Property. According to Article 10, international deposits shall be effected in conformity with the provisions of the Hague Agreement. Some other aspects of the Law are: the period of protection is for five years which may be renewed for two successive terms; the proprietor, by virtue of his exclusive right to a design, may prevent the manufacture, importation, sale, offering for sale, hire, offering for hire, display, delivery or use, or the holding for any of these objects, of a product identical in appearance with the design as deposited or differing only in minor respects.

Chapter II of the Annex (Designs of a Marked Artistic Character) provides in part (Article 21) that "a design having a marked artistic character may be protected by both this Law and by the copyright laws if the conditions for the application of both such legislations are met," and that "designs having no marked artistic character shall be outside the protection under copyright law."

Berne Convention for the Protection of Literary and Artistic Works of September 9, 1886, as revised. Completed at Paris on May 4, 1886, revised at Berlin on November 13, 1908, completed at Berne on March 20, 1914, revised at Rome on June 2, 1928, revised at Brussels on June 26, 1948, and revised at Stockholm on July 14, 1967, and revised at Paris on July 24, 1971. "Copyright Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, Vol. II, Item F.

Certain revisions to the Brussels Convention 1948, relating to works of applied art were made by the Stockholm Act of 1967. Article 5 of the Brussels Act, which contained two paragraphs and permitted countries of the Union to determine the extent of the application of their laws to works of applied art and industrial designs, was incorporated into Article 2 of the Stockholm Act as a subparagraph (7), to which was added a qualification in the following language: "however, if no such special protection is granted in that country, such works shall be protected as artistic works."

This language was retained in Article 2(7) of the Paris Act., 1971, a revision at Paris on July 24, 1971.

Article 2(7) of the Stockholm and Paris Acts also reworded line 1 to indicate specifically that the provision was subject to Article 7(4) of the Act which related to term of protection for works of applied art.



Blaustein, Renee, "La protection des oeuvres des arts appliques, des dessins et modeles; rapport par Renee Blaustein, Henri Desbois et Robert Plaisant," Il Diritto di Autore, No. 34, No. 4 (October December 1963). 50 Congresso dell'Associazione Litteraire et Artistique Internationale, Munchen, 19-14 settembre 1963. Rapporti

A comparative study of the legal protection of designs and models in selected European countries. The study, which was submitted as a report to the Fiftieth Congress of ALAI held at Munich, September 9-14, 1963, is primarily concerned with the question whether designs and models are protected by the copyright law as works of art, or by special legislation as industrial property. Various solutions are offered for reconciling the two different schools of thought on an international plane.

Bogsch, Arpad, "The Law of Copyright under the Universal Convention," Leyden, A.W. Sythoff [and] Bowker (New York 1964) 591 p.

A comprehensive analysis of the Universal Copyright Convention, organized into two main parts. The first part is a revised and updated edition of the author's "Universal Copyright Convention" (New York: Bowker 1958); and the second part, which is entirely new, is a comparative exposition of the cumulative effect of the Convention and domestic copyright laws on the protection available to foreign works.

The work contains some discussion relating to works of art and applied art on pages 9 and 49-50, stating (p. 9) that "the differentiation between 'pure' sculptures and three dimensional works of applied art is frequently very difficult and the views on where the line should be drawn, if one should be drawn at all, between the two are rather different in the various countries." At page 50 the author comments that:

"We are not aware of any law which, if it protects works of applied art as artistic works, protects them for less than 10 years; and all but three countries which protect photographs protect all kinds of photographic works for at least 10 years. The three exceptions are: Bulgaria, the U.S.S.R. and Yugoslavia, which protects certain kinds of photographic works for 5 years only."



Dawid, Heinz, "Basic Principles of International Copyright," Bulletin of the Copyright Society of the U.S.A., Vol. 21, No. 1 (October 1973) 1-24.

This article discusses the differences between the Berne Convention and the Universal Copyright Convention and especially the latest (1971) versions of these conventions. The author mentions briefly that in both conventions, in relation to protectable works, the general formula-"literary scientific and artistic work" -is a detailed catalog of individual types of work. In the UCC, different items are specifically named & include paintings, engravings and sculpture" (article I). The list is specifically provided for in Article 2 of Berne and refers to "works of drawing, painting, architecture, sculpture, engraving and lithography," "works of applied art;" "illustrations, maps, plans, sketches and three-dimensional works relative to...architecture." It is pointed out that the catalog of protectable and protected works under Berne as well as the UCC should not be misunderstood to mean that once a certain product appears to fit into one of the categories in the catalog it will necessarily be protected in all Convention countries. Other provisions in the two conventions are compared by the author, as well as the difference in treatment of the publication problem as between them.

Design Laws; Unesco and United International Bureau for the Protection of Industrial Property edited by Dr. Arpad Bogisch, "Design Laws and Treaties of the World," Bureau of International Affairs, Inc., (Washington: with A.W. Sythoff, the Netherlands: 1961).

This work "includes the texts in English of the national laws, decrees, and ordinances of France, Italy, Belgium, Germany, Switzerland, Mexico, the U.S.A., Great Britain, Canada, India, Australia and South Africa and of international multilateral conventions (The Hague, Paris, Berne and Universal) which regulate the legal protection of designs against unauthorized copying and exploitation."

The volume is to be supplemented as new or amended laws relating to design protection are adopted.

Duchemin, J.L. "Le Nouvel Arrangement de la Haye sur les Dessins et Modeles," Revue Internationale du Droit d'Auteur, no. 30 (January 1961) 110-139.

An analysis in French, English and Spanish of the new Agreement concerning the International Deposit of International Designs or



Models revised at The Hague on November 28, 1960, with particular reference to its economic aspects and the chief problems it raises.

NOTE: The Agreement of The Hague, concerning the International Deposit of Industrial Designs of 6th November, 1925, as revised at London on 2d June 1934, and at The Hague on 28th November, 1960. This conference drafted an entirely new treaty different from the one then in force among a small number of countries. The United States was one of the delegations at the Conference. See Arpad Bogisch, "Diplomatic Conference on the International Deposit of Industrial Designs," Copyright Society of the U.S.A., Vol. 8, No. 3, (New York; 1961) 156.

Duchemin, Jacques-Louis, "La Protection des Oeuvres, des Arts Appliqués et le Marché Commun," Revue Internationale du Droit d'Auteur, No. LX (April 1969) 46-75.

The author explains that the question of the international protection of works of applied art has assumed greater importance and urgency with the advent of the Common Market; this, in regard to the diversity and complexity of national legislations and international conventions on this subject. M. Duchemin points out that "within the framework of the Common Market, Belgium, France and the United Kingdom have more or less the same system for the protection of designs"--a dual system; Germany has a dual system "but leaves it to the Courts to assess the artistic value of the work"; in Italy the design may be protected as a design or ornamental model or as a utility model, industrial property legislation regulating the matter in both cases, and "again it may be protected as a model of pure art on the basis of a Court ruling, in which case copyright legislation applies;" in Luxembourg and the Netherlands there is no legislation on designs and models--"a Benelux law is expected to regulate the matter." The author adds that "in order to make this study complete, it should be added that in France there is a law on seasonal creations [which dates] back to 1952 and is connected with copyrights." Also specified by the author is that in all the countries "it is possible to pursue infringers for unfair competition."

The author in his conclusion urges that: "It is to be hoped that in the next few years all countries concerned with the protection of designs will adopt a single system of protection based on artistic property and industrial property similar to that adopted by the United Kingdom."



Gerbrandy, S. "Der Entwurf eines einheitlichen Benelux-Gesetzes auf dem Gebiet der Muster und Modelle," Gewerblicher Rechtsschutz und Urheberrecht, No. 11 (November 1965) 545-550.

An analysis of a draft uniform law of designs and models for the Benelux countries, and of a treaty upon which the enactment of such a law in the member states must depend. A German translation of the proposed treaty and law appears at 558-572.

NOTE: The Benelux Designs Convention, signed in Brussels on October 25, 1966, entered into force on January 1, 1974. The Uniform Benelux Designs Law which constitutes the Annex to the above Convention, entered into force on January 1, 1975. In the international context, it should be mentioned that the Governments of Belgium and the Netherlands (as far as the Kingdom in Europe is concerned) filed with the Swiss Government, on December 29 and 28, 1973, respectively, instruments of denunciation of the Hague Agreement concerning the International Deposit of Industrial Designs (1925) as well as the London Act (1934) and the Additional Act of Monaco (1961) of that Agreement (Luxembourg is not a party to the Agreement). In view of the fact that these denunciations are effective as of January 1, 1975, and that the Hague Act of 1960 has not yet entered into force, it follows that Benelux nationals can no longer effect international design deposits; also, international deposits registered after January 1, 1975, will have no effect in any of the Benelux countries. Industrial Property, 14th yr., No. 4, (April 1975) 126.

The Hague Agreement, Protocol and Regulations, 1960. "Design Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, Vol. 2, Item B-1 (1961).

This Agreement of the Hague concerns the International Deposit of Industrial Designs of November 6, 1925, as revised at London on June 2, 1934, and at the Hague on November 28, 1960.

The Agreement provides among other things that international deposit may be made by the International Bureau directly or through the National office of a Contracting State; an enumeration of the States in which the applicant requests the deposit to be effective; the designation of the article intended to incorporate the design; claim for right of priority; renewal of a deposit every five years; a term of ten years if the deposit was renewed or five years if not renewed; maintenance of an International Design Register by the Bureau; reference to an international use; notice (symbol D in a circle) and year and name of deposit (or usual abbreviation) of the depositor or a number. However no Contracting State may



require that the article incorporating the design mention deposit of the design, but if it provides for a notice the requirement is fulfilled if the international design notice is used. The Regulations were to enter into force simultaneously with the Agreement.

This Agreement is not yet in force. It was signed by France, Liechtenstein and Switzerland.

Arrangement of the Hague (of 1925) Revision, concerning the international deposit of designs and models. La Propriete Industrielle, Vol. 75, (November 1959) 212-219.

A committee of Experts: to examine a draft made by the three Benelux countries in collaboration with the International Bureau for the protection of industrial property. The object of the Conference was to bring about the adhesion of more States and to simplify the text of the Arrangement, to clarify certain provisions and to strengthen it. A draft of the revised Arrangement was submitted by the Committee.

The draft envisioned, among other things, the possibility of presenting the requests for international registration through the intermediary of the national administration; of publication of the designs and models by the International Bureau; a designation by the applicant of the countries in which the registration would not be effective; of use of the symbol D with the name or date; of a minimum period of five years plus five years.

Note: Hague Union Committee of Experts for the Revision of the Hague Agreement. Industrial Property, Vol. 13, No. 11 (November 1974) 432.

The Note states that pursuant to a decision taken in June 1974 by the Coordination Committee of WIPO, the Director General of WIPO convened a Committee of Experts for the Revision of the Hague Agreement Concerning the International Deposit of Industrial Designs. The Committee met in Geneva, September 30 and October 1, 1974. The Note explains in part that:

"The task of the Committee was to study measures which could be taken in view of the denunciation of the Hague Agreement by Belgium and the Netherlands. The reason for the denunciation by these two States is the incompatibility



of the new industrial designs law of the Benelux countries with the 1934 Act of the Hague Agreement. The new law is, however, compatible with the 1960 Act of the Hague Agreement.

After a thorough discussion, the Committee came to the conclusion that the International Bureau should prepare a draft protocol to the Hague Agreement whose purpose would be to enable States which are not bound by the 1934 Act, but which are able to accept the procedure provided for by the 1960 Act, to become members of the Hague Union without waiting for the entry into force of the 1960 Act and thus to participate in the system for the international deposit of industrial designs."

Ladas, Stephen P., "Patents, Trademarks, and Related Rights," Harvard University Press (Cambridge, Mass. 1975) 2115 pages, three volumes.

An invaluable and thoroughly detailed treatise on these subjects relating to both national and international protection of the rights involved. These volumes bring up to date the author's earlier work published in 1930 by the Harvard University Press under the title "The International Protection of Industrial Property."

Volume II contains three parts: Part IV contains International Regime of Industrial Designs and Models (including reference in full to the Arrangement of the Hague for the International Deposit of Designs; Locarno Agreement for International Classification of Designs, 1968); (Part V) International Regime of Utility Models; (Part VI) The International Regime of Trademarks (including treatment of the Madrid Arrangement for Trademarks, 1891, the Nice (1966, revised 1967) and Vienna Arrangements (1973) regarding classification of trademarks, & the Trademark Registration Treaty, 1973).

The Appendices contain the Principal Arrangements and Conventions discussed in the book, of which many are set forth, as well as the revisions at Stockholm in 1967, to the Hague Arrangement of 1960, to the Nice Arrangement of 1966 and to the Lisbon Arrangement of 1958.

Ladas, Stephen P., Chapter 22 on "National Treatment of Designs" in Part IV of Volume II of his treatise on "Patents, Trademarks, and Related Rights," Harvard University Press (Cambridge, Mass. 1975) 827-893.

Part IV of this Volume II relates to the International Regime of Industrial Designs and Models. The author points out that "As time



went on, the handling of industrial designs and models by the patent approach proved highly unsatisfactory from the domestic law viewpoint as well as from the international," and explains the reasons (pp. 831-833). He adds that:

"The pressure for a more adequate protection of industrial designs and models and for inclusion of designs in copyright law led particularly toward a more liberal acceptance of so-called works of applied art within the scope of copyright law. While a clear definition of such works is perhaps not possible, it is generally understood that the notion of works of art applied to industry...includes not only works which originally constituted 'pure art' and were later combined with industrial products or multiplied industrially, but also to creations which are admitted to be artistic but were intended originally for practical or ornamental purposes. It is with respect to the latter that the line of demarcation from industrial designs is particularly difficult. In any case, according to an investigation made in 1959 [Gerard Balla, *Oeuvres d'Art Applique et Dessins ou Modeles Industriels* (Extract from *Revue Internationale du Droit d'Auteur*) p. 65] a total of thirty-five countries protect works of applied art under the copyright law either by explicit inclusion in the Copyright Act or by decisional law."

Ladas, Stephen P., Chapter 30 on "National Treatment of Trademarks" in Part VI of Volume II of his treatise on "Patents, Trademarks, and Related Rights," Harvard University Press (Cambridge, Mass. 1975) 965-1196.

Part VI of this volume II relates to the "International Regime of Trademarks." The author initially explains that trademark protection is part of protection against unfair competition and that trademark protection has none of the elements of patent protection; the public interest is that every producer or trader should use different marks so that the public may be able to distinguish between them and choose between goods without being confused or deceived.

The author discusses devices or pictorial marks, which are "perceived by the eye rather than the ear." They must satisfy the basic



requirement of distinctiveness, and may function as an indication of origin if so understood by the buying public, and also three-dimensional marks: "the shape or any other presentation of products or their packages, on condition that they are not exclusively functional in nature" (the AIPPI definition). Reference is here made to In re Mogen David Wine Corp., 372 F.2d. 539 (C.C. P.A.) 1967) [This case appears at p. 246 of this bibliography]. Mr. Ladas also points out in this connection that the Unfair Competition Law will protect the shape of a product or of a container if there is a likelihood of confusion and passing off which will not ensure the owner an exclusive right against mere reproduction; moreover this law requires that the first user must have created a reputation and recognition of such shape as identifying origin with him.

Ladas, Stephen P., "What Does the Vienna Trademark Registration Treaty Mean to the United States?," Trademark Reporter, Vol. 63, No. 6 (Nov-Dec 1973) 551.

The author points out that at the time of writing it is quite doubtful whether most of the member countries of the Madrid Arrangement will determine to go into the new Treaty; however, Germany is an exception because the system of "speedy registration" provided for by Germany for marks which are to be registered at the International Bureau under the Madrid Arrangement has not worked out satisfactorily for German trademark owners, since such speedy registrations are subject to the equivalent of an opposition before the German Patent Office.

The countries which really take advantage of the Madrid Arrangement are Benelux, France, Germany, Italy and Switzerland, and according to the author it is quite unlikely that non-European countries, particularly developing countries, will adhere to the new Treaty because they have no interest in obtaining foreign trademark registrations for their own nationals.

The author also indicates that "the chances of the new Treaty becoming effective at all depends on whether new countries, not being party to the Madrid Arrangement, will ratify or accede to the TRT," and "only if such countries as the U.S., U.K., the Scandinavian States, U.S.S.R. and Japan may decide to adhere, then the present members of the Madrid Arrangement may decide also to become parties, if for no other reason, at least to obtain relief from the stricter requirements on applications for national registrations which prevail in these countries."



Lisbon Convention 1958. A Union for the Protection of Industrial Property. The text appears in "Design Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, Vol. 2, Item D-1.

The convention of Paris for the Protection of Industrial Property of March 20, 1883, revised at Brussels on December 14, 1900; at Washington June 2, 1911; at the Hague November 6, 1925; at London June 2, 1934; at Lisbon on October 31, 1958; at Stockholm on July 14, 1967. This Conference for the revision of the Convention of Paris for the protection of industrial property and the Arrangement of Madrid is primarily concerned with the repression of false or deceptive indications of source on goods and also the conclusion of a new Arrangement for the registration of appellations of origin and their international registration. Article 2 of the text states that protection of industrial property is concerned with patents, utility models, industrial designs, trademarks, service marks, trade names and indications of source or appellations of origin and the repression of unfair competition. The United States has adhered to this Lisbon Convention.

The Locarno Agreement, Establishing an International Classification for Industrial Designs of October 8, 1968. "Design Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, Vol. 2, Item A-1.

The countries to which this Agreement applies constitute a special Union and adopt a single classification for industrial designs, designated as "the international classification." Annexed to the text is a "List of Classes and Subclasses of the International Classification." The classes include, among others: (class 5) Textiles, including lace. (class 7) Household Goods, including china, glassware and knives, forks and spoons; (class 9) Packages and Containers, including bottles and pots; (class 10) Clocks and Watches; (class 11) Articles of Adornment including jewelry and artificial flowers; (class 21) Games, Toys and Sports. The United States is a member country as of October 16, 1973.

Miles, James W., "The Quest for International Uniformity in the Law of Designs and its Relation to the Law of Copyright," Copyright Society of the U.S.A., Vol. 12, No. 4, (New York, April 1965) 219-230.

The author states that "the establishment or improvement of the law of designs and international uniformity in regard to its basic principles are current problems which will come up for discussion and decision at the Conference for the Revision of the Berne Copyright



Convention at Stockholm in 1967; the conclusions that can be drawn from an examination of the discussions and results of the various international meetings and conferences dealing with the protection of industrial designs from the design law angle (including the Arrangement of the Hague) appear to be: (a) There is no simple solution to the problem of industrial designs under the design law by a system of international registration; (b) In the fast moving tempo of modern international trade a system of national protection under a sui generis design law is necessary; (c) A relaxation of the conditions and formalities to obtain protection under the design law is of primary importance; (d) International Cooperation to achieve greater uniformity in the development of the design law to meet modern conditions of trade is desirable and likely to be of value; (e) A single system for the protection of industrial designs embracing both applied art and designs and models is not a practical possibility; it appears clear that copyright law in relation to applied art and design law in respect of industrial designs are each necessary to play a separate but complementary role in meeting the needs of industry. The question whether this is cumulative or alternative must be left for decision under the national law.

Model Law for Developing Countries on Industrial Designs, World Intellectual Property Organization (WIPO) (Geneva, 1970) and United International Bureaux for the Protection of Intellectual Property (BIRPI). An English edition.

This third model law is part of a series of brochures published previously, the first of which dealt with inventions and the second with marks; tradenames and acts of unfair competition. Among the principal aspects of the model design law are: The definition of design in the Model Law on Industrial Designs is centered on appearance: "any composition of lines or colors or any three-dimensional form, whether or not associated with line or colors;" protection does not extend to anything in an industrial design which serves solely to obtain a technical result; novelty is required, defined in a way which reflects a patent approach; there is provision for registration, with indication of the class or classes in which the product is included and multiple deposit is allowed; examination as to form is provided for, but in regard to examination as to novelty or other matters of substance, the countries may choose one of three alternatives; (A) no examination, (B) publication and then opposition by interested parties, (C) full examination procedures in regard to registrability of the design, novelty and anticipation of record; protection endures for five years and may be renewed for two further consecutive



periods of five years (with fee); the right conferred is an exclusive right in reproduction of the design in manufacturing of the product and importation for trade purposes; a design may be infringed even though it is applied to a different kind of product; no marking indicating registration of the design is required. The Model Law deals in detail with licenses and their control in the interest of developing countries.

Model Law: The WIPO Design Model Law, Industrial Property, Vol. 10, No. 9, (September 1971) 249.

A comment on this subject that explains the reasons for the legal protection of designs, which apply not only to industrialized countries but also to developing countries: "Many articles which are manufactured in developing countries incorporate designs of high value, and a great number of such articles have special importance for the economy of the country because they are exported to other countries, for instance rugs and silks." The United International Bureaux for the Protection of Intellectual Property (BIRPI) and its successor, the World Intellectual Property Organization (WIPO) have prepared a Design Model Law, the third in a series of Model Laws, the first dealing with inventions and the second with marks, trade names and unfair competition.

As indicated in the Comment, the Design Model Law regulates the principal aspects of design protection, such as the definition of an industrial design and the conditions for its protection, the administrative procedure for registration of an industrial design, the scope of protection, license contracts and sanctions against infringement. "Like the other Model Laws this regulation is far from complete, and many questions will have to be considered by the legislators of the country interested in using the Model Law."

Monaco: Additional Act of Monaco, 1961. The text of this Act appears in "Design Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, Vol. 2, Item AA-1 (1965).

This additional Act of November 18, 1961, to the Agreement of the Hague Concerning the International Deposit of Industrial Designs of November 6, 1925, Revised at London on June 2, 1934. This Act refers to additional fees. States that have been bound by this Act are Belgium, France, Germany (Federal Republic), Liechtenstein, Monaco, Netherlands, Spain, Switzerland.



O.A.M.P.I.: Agreement Relating to the Creation of an African and Malagasy Industrial Property Office, September 13, 1962. "Design Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, O.A.M.P.I., Items 1-4 (1965, 1970).

The Governments of the Federal Republic of Cameroun, Central African Republic, Republic of the Congo, Republic of the Ivory Coast, Republic of Dahomey, Republic of Gabon, Republic of Upper Volta, Malagasy Republic, Islamic Republic of Mauritania, Republic of the Niger, Republic of Senegal, Republic of Chad, resolved to conclude an Agreement for the creation of an African and Malagasy Industrial Property Office. This, considering the interest in the institution of a system of single deposit of applications for patents, trademarks, and industrial designs, for obtaining the rights provided by the uniform legislations of their countries, and the creation of an organ applying the common administrative procedures prescribed by the said legislations.

Otero Lastres, Jose Manuel, "Das Mustergesetz fur Entwicklungslander zum Schutz von gewerblichen Mustern und Modellen." Gewerblicher Rechts - schutz und Urheberrecht, Int. Teil, No. 11 (November 1972) 407-413.

An introduction to, and the basic principles of the Model Law for Developing Countries on Industrial Designs, and an analysis of its principle. See Bulletin of the Copyright Society of the U.S.A., Vol. 18, 464, Item 452 (1971).

Proposed Revision of Paris Union for the Protection of Industrial Property: Industrial Property, Vol. 14, No. 3 (March 1975) 84-85.

A meeting held (First Session) by Ad Hoc group of Governmental Experts on the Revision of the Paris Convention, Geneva, February 11 to 17, 1975, pursuant to a decision taken by the competent bodies of WIPO and of the Paris Union. The task of the Ad Hoc group of Experts was to study all aspects of the question of revising the Paris Convention including, inter alia, additional provisions of special benefit to developing countries. Noting the interest that developing countries have manifested in the revision of the Paris Convention, the group of Experts agreed that at this stage of the work, several questions should be considered, including Marks and Industrial Designs. It was recommended that a study be prepared and that the Ad Hoc Group be convened as soon as possible in a second session. The United States was listed as a Participant at the First Session.



Perot - Morel, Marie-Angele, "Les Principes de Protection des Dessins et Modeles dans les Pays du Marche Commun (The Principles Governing the Protection of Industrial Designs in the Common Market Countries) Editions Mouton (Paris 1968). A review of this work (initialed L.B.) appears in Industrial Property, Vol. 8, No. 11 (November 1969) at 323.

The author of the review states (in part) that she looks into sources of industrial design protection in the Common Market countries; in addition to special legislation on industrial designs, the possibility of obtaining protection under the law of copyright also is examined, insofar as industrial designs are regarded as works of applied art. She says that here opposite solutions have been adopted, namely: The system of dual protection, which has evolved under French law through application of the unity-of-art principle; the system under German law, of partially overlapping protection, depending on the artistic level of the creation; and the system, adopted under Italian law, whereby any overlapping is barred because of the utilitarian purpose of industrial designs. To complete this account, the author (Mme. Perot-Morel) briefly discusses a few aspects of the systems for protecting industrial designs in the United States and in the United Kingdom. The various international conventions applying to industrial designs (the Paris Convention and the Hague Agreement, on the one hand, and the Berne Convention and the Universal Copyright Convention, on the other) are considered.

The second part of the book (pages 173-298) takes up a few special aspects of industrial design law. The author makes it clear that the two opposed principles of unity of art and the exclusion of industrial designs from copyright protection - both of which are being strongly defended - represent a serious obstacle to harmonization among the legislative texts of the Common Market countries.

Stockholm: Complementary Act of Stockholm, 1967, "Design Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, Vol. 2, Item C-1 (1970).

This Complementary Act of Stockholm of July 14, 1967, to the Hague Agreement Concerning the International Deposit of Industrial Designs of November 6, 1925, revised at London on June 2, 1934, and at the Hague on November 28, 1960, and completed by the Additional Act of Monaco on November 18, 1961, provides for an assembly for the Special Union established by the Hague Agreement of 1925 maintained by the 1934 and 1960 Acts, the 1961 Additional Act and this Act. The decisions of the Assembly would require 2/3 of the votes



cast. This Act is not yet in force, nor is the Hague Act (1960) yet in force (as of January 1, 1975).

Trademark Registration Treaty of Vienna, 1973, Regulations and Resolution, Industrial Property, Vol. 12, No. 8 (August 1973 )215-255. A good explanation of this Treaty appears in Ladas, "Patents, Trademarks and Related Works," Vol. 3, (Harvard University Press, Cambridge) 1492-1539, and the text of the Treaty is also set forth in that volume at 1998-2014.

The Treaty was submitted to a diplomatic conference which met in Vienna May 17-June 12, 1973. The States party to this Treaty are to constitute a Union for the international registration of marks. It has been signed by fourteen countries, including the United States. It provides for direct filing of international applications with the International Bureau; and independent filing, not based on any national application or registration. This Treaty was not yet in force as of January 1975.

Vienna Conference: "Vienna Diplomatic Conference on Industrial Property, 1973," Industrial Property, Vol. 12, No. 7 (July 1973) 187-196.

This Conference took place in Vienna May 17-June 12, 1973. The Secretariat was furnished by the staff of the International Bureau of the World Intellectual Property Organization (WIPO), led by Professor G.H.C. Bodenhausen. The Vienna Conference provided the framework within which three Diplomatic Conferences took place: one on the Trademark Registration Treaty, one on the protection of Type Faces, and one on the International Classification of the Figurative Elements of Marks. The Trademark Registration Treaty Conference adopted the Trademark Registration Treaty, the Regulations under that Treaty and a Resolution Concerning Preparatory Measures for the Entry into Force of the Trademark Registration Treaty. All instruments relating to the three Conferences were adopted unanimously.

The text of the Trademark Registration Treaty, Regulations and Resolution, appears in Industrial Property, Vol. 12, No. 8 (August 1973) 215-255.

World Intellectual Property Organization: 1970, (WIPO) "Design Laws and Treaties of the World," UNESCO and the Bureau of National Affairs, Vol. 2, Item A-1, signed at Stockholm on July 14, 1967.

The text of the Convention is given in this publication. The preamble



states in part that the Contracting Parties, desiring to modernize and render more efficient the administration of the Unions established in the fields of the protection of industrial property and the protection of literary and artistic works, while fully respecting the independence of each of the unions, agree as follows: (there follows in particular a definition of "intellectual property").

...(viii) "intellectual property" shall include the rights relating to:

- literary, artistic and scientific work,
  - performances of performing artists, phonograms, and broadcasts,
  - inventions in all fields of human endeavor,
  - scientific discoveries,
  - industrial designs,
  - trademarks, service marks, and commercial names and designations,
  - protection against unfair competition,
- and all other rights relating to intellectual activity in the industrial, scientific, literary or artistic fields.

The United States has been bound by this Convention.

The Conference shall make its decisions by 2/3 of the votes cast.

#### D. Design Protection in Other Countries

Abelman, Lawrence E., "Trademarks in Western European Countries," The Trademark Reporter, Vol. 58, No. 12 (December 1968) 879.

As the author points out, there are 26 trademark jurisdictions in Western Europe consisting of 19 commercial countries and 7 minor jurisdictions. The trademark laws of the United Kingdom and Ireland are based on common law concepts and in these jurisdictions use of a trademark is normally more significant in creating rights than the act of registration. The other jurisdictions involved are essentially "registration countries" - countries in which registration of a trademark is attributive of rights to a mark, or countries in which changes in the laws are contemplated so that rights will belong to the first party to file.

Algeria: Ordinance relating to designs (No. 66-86) (April 28, 1966)  
Industrial Property Vol. 5, No. 11 (November 1966).

A translation into English of the new Algerian design law which provides that the term of protection is ten years: the first of one



year and the second of nine years. Also, during the first period the design remains secret unless the applicant requests publication: "Only designs which are original and new may benefit from the protection accorded by the present Ordinance. A design is new if it has not been previously created." The Ordinance provides for registration by application and deposit.

According to Article I..."If an object can be simultaneously considered both as a design and as a patentable invention, and if the elements which constitute novelty are inseparable from those of the invention, the said object will be protected in accordance with Ordinance No. 66-54 of March 3, 1966, relating to inventors' certificates and patents."

Althammer, Werner, "Warenzeichengesetz" (The Trademark Law) Heymanns Taschenkommentare zum gewerblich-en Rechtsschutz, Carl Heymanns Verlag K G, Cologne, Berlin, Bonn and Munich 1973. 400 pages, Industrial Property, Vol. 12, No. 12 (December 1973) 402.

This commentary, (which G.R.W. reviews) is "primarily addressed to those who are interested in the practical working of the trademark system and in the Patent Office and Patent Court procedure. The Trademark Law and its application in practice are therefore the subject of an exhaustive analysis, which takes account of the court decisions published up to October 1, 1973. The notes and references and the index in this work are extremely detailed, enabling a particular judicial decision, for instance, to be found without difficulty. It is therefore an extremely useful and up-to-date work."

Andean Group (Bolivia, Chile, Colombia, Ecuador, Peru and Venezuela): Regulations for the Application of Rules Concerning Industrial Property (Decision No. 85 (Industrial Property) of May/June 1974 of the Commission of the Cartagena Agreement), Industrial Property, Vol. 13, No. 11 (November 1974) 437-443.

This text relates to Patents (Chapter I), Industrial Designs (Chapter II) and Marks (Chapter III). The Chapter on Industrial Designs provides that "new industrial designs may be registered," and (section 45) that--"Any composition of lines or combination of colors which is embodied in a product of industry or handicraft in order to give it a special appearance, without changing its purpose, shall be considered a design; any three-dimensional form which serves as a pattern for products of industry or handicraft which gives it a special appearance and do not imply any technical results shall be



considered a model.

Industrial designs relating to clothing shall not be registrable. Industrial designs that are contrary to public order or morality shall not be protected."

The period of protection is for five years from the date of the administrative act by which registration was effected. The Member Countries undertake to adopt, within a year from the entry into force of these Regulations, the International Classification established by the Locarno Agreement of October 8, 1968.

In relation to Chapter III (Trademarks), section 58 lists what may not be registered as marks; the most relevant here are "shapes that are usual or essential in relation to the goods, and their dimensions and colors."

Aracama Zorraquin, Ernesto D., "The Argentine System of Industrial Designs," Industrial Property, Vol. 5, No. 1, (January 1966) 12-15.

This article summarizes the Argentine Decree-Law No. 6673/65, effective August 27, 1965. Under article 28 of the decree-law, a design which complies with the conditions or requirements of the copyright law may also be protected by that law, but the protection is not cumulative.

Aracama Zorraquin, Ernesto D., "Letter from Argentina," Industrial Property, Vol. 12, No. 12 (December 1973) 391-398.

This "Letter" contains references to cases relating to Industrial Designs, Trademarks and Unfair Competition. Under the latter caption (p. 398) the author states that "judicial decisions in the field of unfair competition are rather rare in Argentina, no doubt because unfair acts are dealt with under extra-judicial procedures or through the intervention of commercial organizations, which do not publish their decisions." However, Professor Aracama Zorraquin points to a decision before the Federal Chamber of Buenos Aires, Relojes Rolex Argentina S.A. v. Orient S.A., in which the defendant was sued for material and moral damage on account of an advertisement for its "Orient" watch. The advertisement had used the name, mark, the emblem and the photograph of the "Rolex" watch, in order to divert potential purchasers to the "Orient" watch, pointing out that the watches were of same quality and that the "Orient" watch was cheaper and had a longer guarantee. The court of first instance had recognized that the advertisement, although falling outside the provisions of the trademark law, constituted an act of unfair competition contrary to Section 953 of the Civil Code.



The plaintiff had been unsuccessful, however, since it had not proved damage. The Federal Chamber stated that the launching of the publicity campaign in order to sell a make of watch by comparing it with another, well-known make without the consent of its owner was all that was required to constitute an act of unfair competition. The Federal Chamber agreed that issuing unlawful comparative advertising raised the presumption of damage due to the stealing of custom and ordered the defendant to pay damages.

Argentina: Industrial Designs Law (Decree Law No. 6 673/63 of August 9, 1963, ratified by Law No. 16, 478, promulgated by Decree No. 7578/64 of September 29, 1964), Industrial Property, Vol. 9, No. 2 (February 1970) 44-47, and "Implementing Regulations," same issue 47-49.

Article 3 of the Industrial Designs Law provides that "for the purposes of this Decree, the shapes or the appearance incorporated in or applied to an industrial product and which give it an ornamental character shall be regarded as industrial designs." Article 6 provides (in part) that industrial designs which do not have a different shape or a novel appearance of their own, as compared to prior designs shall not enjoy the benefits granted by this decree, and the same is true of industrial designs, the elements of which are necessary to the function which the product is intended to perform, and of the mere change in the color of known designs. Article 7 provides that the protection granted by this Decree shall have a duration of five years, as from the filing date, and may be extended for two consecutive periods of the same length at the owner's request. In order to enjoy the rights arising under the Decree the author shall register the design created by him in the Register of Industrial Designs kept for the purpose. The right conferred shall apply to authors of industrial designs created abroad and to their lawful successors, provided that their respective countries grant reciprocity in respect of the rights of Argentina authors or authors residing in Argentina.

Argentine Republic. Design Law; decree-law no. 6673/63, dated August 9, 1963, published in the Official Gazette of August 19, 1963. An English translation of this Argentine Design Law appears in Patent and Trade Mark Review, Vol. 62, No. 6 (March 1964) 151-157.

Beier, Friedrich-Karl, and Katzenberger, Paul, "Letter from the Federal Republic of Germany," in regard to jurisprudence-trademarks, Industrial Property, Vol. 12, No. 4 (April 1973) 125-135.

The article discusses (p. 129) "pictorial representations," citing two cases. In the "Isolated Hand" decision of April 30, 1969, 1969 GRUR 683, the Federal Supreme Court held with regard



to pictorial representations that their use in a manner calculated to catch the consumer's eye would, by itself, not be sufficient to automatically support a finding of use as a trademark. The case concerned like-like portraits of hands holding pipes and cigarettes in advertisements for tobacco, the advertising being opposed by a cigarette manufacturer for whom various drawings of human hands are protected as trademarks; the suit was unsuccessful, the Court holding that the drawings of hands did not constitute use as a trademark, hence there was no infringement of plaintiff's trademark rights, because (1) there was present sufficient indication of the manufacturing origin of the advertised tobacco, and (2) the drawings of hands had no such effect because they indicated solely the suitability of the tobacco for pipes and handrolled cigarettes.

The authors, stating that there will be no use as a trademark, and consequently no infringement of the trademark rights concerned where the pictorial representations do not serve as an identification of the goods but are present for purposes of ornamentation, turned to the second case decided February 26, 1971, 1971 GRUR 251. That case involved the representation of an antique automobile on the packagings and containers of personal hygiene products, against which the owner of the word "Oldtimer" brought suit. The court found for the plaintiff: a finding of use as a trademark, and accordingly, of infringement of plaintiff's trademark was supported by the stylized form of representation of always the same type of automobile, which is typical for identification purposes, as well as by the emphasis given to the automobile, calculated to catch the consumer's eye, in connection with the business's catchword "Avon."

Also, the authors point out that "a great number of decisions of the Federal Supreme Court concern the central question of trademark law - the risk of confusion. Seen in their entirety, these decisions have not led to any substantial changes in the principles previously recognized."

Belgium: "La législation belge sur les brevets, les marques, les modèles et le droit d'auteur." Belgium patent, trademark, design and copyright laws. Bureau Vandor Haaghen (Bruxelles: 1969).

This booklet contains the main provisions of the Belgian laws and rules (including their subsequent amendments) concerning the patents, trademarks, designs and copyright, with their English translation facing them.



Bloom, Harry, "Lost in the Bronx," Bulletin of the Copyright Society of the U.S.A., Vol. 22, No. 3 (February 1975) 199-207.

An interesting article which discusses the recent case decided in the House of Lords, George Hensher Ltd. v. Restawhile Upholstery Lances. Ltd., 1974/W.L.R. 700, of which the subject matter was a set of upholstered furniture - a sofa and two chairs - which had a distinctive "boat shape" and was called "The Bronx." The design was not registered under the Registered Designs Act of 1949, which meant that it had to fall back on protection under section 3(1)(c) of the Copyright Act of 1956. As the author explained, the difficulty in the case was, of course, to determine if "The Bronx" was a work of "artistic craftsmanship" under that provision. "Such designs must seek protection by registration under the Registered Designs Act 1949. Although there might in proper cases be dual protection for articles both useful and good-looking under the Registered Designs Act and the Copyright Act of 1956 - which protects 'works of artistic craftsmanship' as a sub-species of works of art - the latter will only be effective if the work reaches a sufficient artistic standard." The author points out that in England at present, a departmental committee under Justice Whitford is considering whether and how the laws of copyright and design need changing, so that Hensher v. Restawhile will before long become a museum piece.

Borggard, G., Director General, Patent Office, Stockholm, "the New Nordic Patent Legislation," Industrial Property, Vol. 7, No. 6, (June 1968) 189-201.

The article points out that the legislation incorporates the solutions contained in the Council of Europe Convention of 1963 on the Unification of Certain Points of Substantive Law on Patents for Invention; also that the Laws of the countries involved (Denmark, Finland, Norway and Sweden) also adhere to the principle of general or absolute novelty, that is, everything available to the public before the time of the filing of the application, or, in the case of priority, before the priority date, can be destructive of novelty, regardless of the way in which the material becomes available. The author explains, that the requirement for inventive step - in the new Laws expressed as a requirement for essential difference as compared to the known art--has often been applied more rigidly in the Courts than by the Patent Offices. The writer of the article further says in this connection: "Industry has very strongly emphasized that the patent system, in order to function properly, must be reserved for inventions that represent real contributions to industrial progress. If solutions which are more or less obvious



or are in line with what can be ordinarily expected of a person skilled in the art can be patented, the patent monopoly will be a hindrance rather than an aid to technical development."

NOTE: This requirement of non-obviousness reflects the principle expressed in Section 103, 35 U.S.C. of U.S. patent law, and explained in Graham v. John Deere Co., 383 U.S.1, 148 U.S.P.Q. 459 (1966). The application of the principle is carried over to section 171, 35 U.S.C. (design patents).

British Trade Marks, Patents and Designs Foundation, Monthly Report  
(June 1959)

The report states that the matter of design protection in Great Britain has continued to be a matter of concern even after the passage of the Designs Bill (1949) and that the President of the Board of Trade has appointed a Committee to review the law relating to the protection of industrial designs. The Committee was to consider and report whether any, and if so what, changes are desirable in the law relating to the protection of industrial designs, and in framing their recommendations the Committee was to include consideration of the desirability of enabling United Kingdom designs to receive cheap and effective protection in other countries on the basis of reciprocity.

According to the Board of Trade Journal for May 22, 1959, this was the first occasion on which a Departmental Committee had considered the subject of design protection alone; designs had previously been considered in conjunction with either Patents or Copyrights.

Carterton, Paul, "Les Confins du Modele et du Brevet d' invention,"  
Etudes sur la Propriete Industrielle Litteraire Artistique  
(Paris, Surey: 1960) 21-31.

A brief discussion (in French) of the demarcation between copyright and patent protection of designs and models with reference to the new legal situation created by the French Copyright Law of 1957. As a result of the law of 1957, the distinction is clear: only the designs admitting of a contour or outline presenting a certain ornamental character are in a position to take advantage of the law of 1957, limited by the fact that they are deservedly worded to apply only to creative works, that is, in the literary, musical and artistic domain; whereas the designs and models not containing these characteristics are regulated by



the law of 1909, still in effect, the laws of 1793 and 1902 having been repealed. The law of 1909 requires only a legal deposit, and the period of protection is twenty years.

Casalonga, Alain "Patents of Invention, Trade-Marks and Models," Librairie Generale de Droit et de Jurisprudence, R. Pichon et R. Durand-Auzias (Paris 1967) 69 pages.

This booklet, published in English, is concerned with the protection of Industrial Property in France. It contains some interesting illustrations of works involved in the cases discussed. The purpose of the booklet is to inform the (English-Speaking) reader as to "how to protect your creations in France." Chapter II discusses Models. A design or model receives protection in France, "this indifferently and cumulatively under the legislation on artistic property (Act of March 11, 1957 [copyright] replacing the Act of July 19-24 of 1793 extended in 1902 to industrial arts), and by the Act of July 14, 1909 referring specifically to industrial models." The author explains that - "This includes any new form, configuration, outward appearance, every effect such as, moire or watered effect, embossing, stripes on fabrics, etc. which, when applied on a given object or article, gives it a specific and new appearance. But the form should not have been conceived with an industrial, technical or utilitarian aim in mind such that it would become inseparable from the result sought after." There is also reference in Chapter II to protection of seasonally produced clothing and accessories (Act of March 12, 1952).

Copinger, W.A. and F.E. & E.P. Skone James, "Copinger and Skone James on Copyright," (London: Sweet and Maxwell: Tenth Edition, 1965) 1-836.

An up-to-date treatise on the subject of copyright in the United Kingdom, with particular reference to the Copyright Act of 1956. It includes, as did previous editions of the work, a part on international copyright and the protection of works originating outside the United Kingdom. It includes several sections related to "Industrial Designs with a Comparison of Copyright and Design Protection" (paragraphs No. 180-206) and to "Artistic Copyright Used for Industrial Purposes and No Design Registered" (paragraphs 207-220). A brief Summary (paragraph 216) states:

"The general effect of the foregoing provisions seems to be, therefore, as follows: unless and until an industrial design is either registered



or used, full copyright protection is preserved by the artistic work. If the copyright owner of the artistic work decides to embark upon an industrial use for his work, he is at liberty to register under the Designs Act, notwithstanding the previous copyright publication. If he registers in respect of one article, he continues to enjoy copyright protection in respect of use on other articles during the term of designs registration in the article which he has registered and during this period he can obtain additional designs registrations for other articles but only for the original period. When the original period expires, his copyright protection continues but only in respect of use which is not used for industrial purposes."

Cornish, W.R., "Cumulative Protection for Industrial Designs,"  
University of British Columbia Law Review, Vol. 8, No. 9 (1973)  
219-245.

An account of the relation between copyright and monopoly protection of industrial designs as developed in the United Kingdom, Canada, Australia and New Zealand. The author in his conclusion states that, the truth is that in all the official recommendations and legislative changes that have shaken this field in the post-war period, one Report stands out for its judicious balance of the arguments for and against the different forms of protection of industrial designs. This is the Report of the Johnston Committee in 1962. Its major proposal was for a design copyright system, in which the practical problems of discovering copyright would be reduced by the requirement of deposit in a public register, the period of protection through copyright would be fifteen years from deposit and designs dictated by function would be excluded from protection. Subsequent developments, particularly in Britain, point to the wisdom of this proposal. The question that remains is not whether it should be implemented, but whether design monopoly should remain in existence beside design copyright. The answer may best be found by experiencing a period of this form of dual protection.

Craig, W. Allan, "Copyright - infringement - three-dimensional reproduction of unregistered artistic work constitutes publication within the English Copyright Act of 1956 and entitles the equitable owner to bring an action for interlocutory injunction." Texas



International Law Journal, Vol. 7, No. 2 (Winter 1972) 263-267.

A brief note on Merchant Adventurers, Ltd. v. M. Grew & Co., [1971] 1 ALL E.R. 657 (ch.) with a conclusion that the court's holding affords owners of copyrighted industrial designs protection "parallel to the liberal protection previously [i.e., prior to the 1956 Act] afforded owners of other artistic works under the English copyright system."

The case discussed in the article involved a motion by the plaintiff for an interlocutory injunction under the Copyright Act of 1956 to restrain further distribution of electric light fittings identical to plaintiff's trimline series. Plaintiff alleged that copyright subsisted in cross-sectional drawings of its fittings by reason of publication, and that distribution of copies of its fittings was infringement of copyright. The injunction was granted; a three-dimensional reproduction of unregistered cross-sectional drawings constitutes publication under the English Copyright Act of 1956 and the equitable owner is entitled to move for injunctive relief to prevent further infringement.

Delfosse, Guy, "La Protection en Belgique des Dessins et Modeles Appartenant a des Etrangeres," Revue de Droit Intellectuel, 1'Ingenieur-Conseil, Vol. 52, No. 7 (July 1962)

A survey of developments regarding the protection of designs and utility models afforded in Belgium to foreign nationals under domestic laws and international conventions.

Desbois, Henri, "Le Droit d'Auteur en France, Mise a Jour 1973," Paris Dalloz 1973, 102 p.

This small volume brings up to 1973 comments on certain sections of Professor Desbois' earlier magnificent volume "Le Droit d'Auteur en France," published in 1966, also by Dalloz (973 pages). At pages 8-10 of this later work there is discussion of designs and models and their relation to patents (inventions); recent decisions are referred to, and it is stated that the interpretation of article 2 of the law of June 14, 1909 is reaffirmed in these cases to the effect that the expressions "patentable" and "utilitarian" are considered equivalents: "Thus a creation embodied in a form adopted with a purpose that results in its absorption of the ornamental element by the utilitarian junction of the article does not meet the criterion envisioned by the



legislator of the Act of 1909."

There is also discussion by the author of "The revision of the Convention of Berne and of the Universal Convention (Paris 1971, July 5-24)," pages 79-103, in which is included reference (p. 95) to works of applied art and their protection as artistic works in countries where no special protection is accorded (as designs and models).

Fox, Harold G., "The Canadian Law on Copyright and Industrial Designs," (2d Edition. The Carswell Company, Toronto, 1967) 691 pages, appendices.

A review of this work written by Christopher Robinson, Q.C., of Ottawa states, among some landatory comments about the author, that:

"As the title of the work indicates it deals not only with Copyright but also with Industrial Designs, which were last dealt with by the author in the first edition on Trademarks in 1940. The inclusion of Industrial Designs in a work on Copyright is logical since they are more closely related to this subject than to the subject of Trade Marks and Unfair Competition. There had been an appreciable amount of Canadian jurisprudence in this field in the past quarter century and specially important recent decisions on the basic question of the subject matter of Industrial Designs. All these are fully treated by the author."

Francon, Andre, "Letter from France," 5 Copyright No. 1 (Geneva: January 1969) 115.

Under Part (a) of the Letter, the author discusses a few decisions relating to the protection of designs. Thus, decision by the Supreme Court of Appeal (Crim., June 22, 1967, Dalloz, 1968, juris p. 241; obs. Desbois, Revue trimestrielle de droit commercial, 1968, p. 337 et seq.) reaffirms that designs are eligible for protection under the Copyright law of March 11, 1957 even if they are intended for industrial application. The case concerned sketches of coach-work for a car produced by a large automobile manufacturing firm. The Appeal Court had found that the sketch was an intellectual work because it constituted aesthetic research and, at the date of its creation, presented an original and novel character that was beyond dispute. The Supreme Court affirmed that



decision. According to the author, the reference to novelty would have been justified if the case had involved the application of the Law on Designs of July 14, 1909, for its text contains numerous references to novelty. He adds that under the Copyright Law, however, the protection of literary property derives not from novelty but from its originality; however, the novelty envisaged by the 1909 law must be of an ornamental character and independent of any industrial result.

French Patent Legislation 1968: Industrial Property, Vol. 7, No. 3  
(March 1968) 67-76.

Text in English of French legislation to Promote Inventive Activity and Revise the Patent System (No. 68-1 of January 2, 1968). Article 6 of the Act provides in part that the invention must be of an industrial character, must be new, and must involve an inventive step. Article 7 states that creations of an exclusively ornamental nature shall not be considered industrial inventions (emphasis supplied). Article 9 provides that an invention shall be considered to involve an inventive step if it is "not obvious having regard to the state of the art."

Fysh, Michael, "Russell-Clarke on Copyright in Industrial Designs,"  
Sweet & Maxwell Ltd. 1974.

Events of major importance since the last edition of Russell-Clarke was prepared, to include the Design Copyright Act of 1968 (which became effective in October 1968) and the House of Lords' decisions in Amp Inc. v. Utilux Pty. Ltd. [1972] R.P.C. 103 and G. Hensher Ltd. v. Restawhile Upholstery (Lancs.) Ltd. [1974] F.S.R. 173. The former case, according to the author in his Preface, "has opened to the highest authority the lately followed but ever important topic of exclusion from protection of designs having features which are dictated solely by function." In the latter case [discussed in an Appendix] the evidence of the witnesses established at most an "appeal to the eye" and a certain originality in design which had proved to be commercially very successful. This, it was held, fell considerably short of establishing that the prototype was "artistic" or a "work of artistic craftsmanship." The author includes a chapter devoted to industrial property rights in the EEC, "since the apparent conflict between territorial monopoly rights and the objective of unrestricted competition and the free flow of goods within a unified Common Market is clearly a factor upon which practitioners' advice is increasingly going to be sought."



Grant, Gordon (Comptroller-General of Patents, Designs and Trade Marks and Head of the Industrial Property and Copyright Department of Trade and Industry 1958-1969) "Letter from the United Kingdom," Industrial Property, Vol. 12, No. 3 (March 1973) 98-99.

The "Letter" states that the Government has at last acceded to representations about the need for a review of British trade marks legislation - the present Act dating from 1938 - and has set up a committee "to examine the British trade mark law and practice and consider whether any changes are desirable in the light of present day trading conditions and international developments." With respect to Industrial Designs it was said that some concern has been expressed in professional circles about the working of the Design Copyright Act of 1968, which was intended to enable the owner of an industrial design to take action against copying during a period of 15 years: it seemed likely that the Government would undertake a review of the copyright legislation in the fairly near future, with discussion of the relationship between copyright and industrial design protection. As to protection of functional designs, the "Letter" mentioned a case, Amp Incorporated v. Utilux Proprietary Limited [1972] R.P.C. 103, in which the House of Lords gave its decision on an appeal by defendant about an alleged infringement of two registered designs for electric terminals. The House of Lords decided that the features of the designs were dictated solely by function and that the designs were invalid.

Greece: Association Litteraire et Artistique Internationale, "Congres d'Athenes, Sept. 1959. Rapport sur le 48e Congres (Athenes, 14-19, septembre 1959)" Le Droit d'Auteur, Vol. 72, No. 10, (Oct. 1959) 176-179.

The report of the 48th Congress of the International Literary and Artistic Association (A.L.I.A.) held in Athens, Sept. 14-19, 1959. The report includes approved resolutions on revision of the Greek law, works of applied art, designs and models, cinematography and radio broadcasts, neighboring rights, and the tax statutes of authors; and a "voeu on extension of duration of protection after death of the author."

Grefe, Pierre, "Les droits des editeurs et imprimeurs publicitaires sur leur creations (la loi du 11 Mai 1957) 2. ed. Paris, Dalloz, (1960) 19.

This article contains a brief discussion of the changes brought about by the French Copyright Law of 1957 with respect to the rights of one



who creates or reproduces a work of applied art as a salaried employee or independent contractor in relation to the rights of his employer or client for whom the work is produced.

Gryse, Ludovic De, "Modellenbescherming in ontwikkeling?," Tijdschrift voor privaatrecht, Vol. 6, No. 3, (1969) 349-391.

A critical comment, with summaries in French, German and English, on the legal protection of industrial designs and utility models, with special reference to Belgian laws. Some suggestions are made for obtaining more adequate protection.

Gundrey, Walter, "The design pirates." The Director, (January, 1967) 73-75.

A brief article on design piracy in Great Britain. The protection afforded by the Registered Designs Act is declared "unsuited to industries in which fashion is of the greatest importance," but several practical steps are suggested that a company can take to "combat plagiarism without dependence on the law."

"...the best answer to imitation is to anticipate it...'It is essential to establish a new design quick and hard.' This done, its position should become so dominant that competitive imitations have no chance to make up for being late in the field, although this course is easiest to take in industries where imitations are not technically easy to produce. Action by a strong trade association, commercial aggressiveness, and the deterrently high investment in tooling...these, then, are three of the names by which the manufacturer can combat plagiarism without dependence on the law."

General Confederation of Italian Industries, "The Italian Patent System and its Legal, Fiscal and Foreign Exchange Control Aspects" Confederazione Generale Del' Industria Italiana (Rome 1960) 95 pages.

This booklet is in English. The last paragraph of the brief foreword states that "the General Confederation of Italian Industries is glad to offer this new publication to all Organizations, Companies, private individuals and experts, with a view to providing them with an up-to-date collection of laws and regulations designed to facilitate the performance of the procedures required by the present Italian system." There is reference in the booklet to the Act protecting Industrial Design Patents (law 1411 of August 25, 1940) which includes "utility design patents" and "ornamental design and model patents," valid for four years; then some specific discussion of "Utility Designs" and



briefly of "ornamental Designs and Models," with reference to application and fees, etc. Invention patents are also discussed, and trademarks. Under the latter heading there is a classification of products of commodities (42 classes). Class 42 includes "other services not elsewhere specified." There is here, as well as under the other headings, summarization of documents required for registration, fees, taxes.

Harrison, Archibald F. (Sir), "Hot Water Bottles," Copyright Society Bulletin of the U.S.A., Vol. 7, No. 6 (New York: August 1960) 274-280; reprinted from an article published in the Monthly Report, June 1960 of the British Trade Marks, Patents & Designs Federation.

The author discusses the definition in the Registered Designs Act of the expression "design" set out in sub-section (3) of section 1, and refers to the case of Cow (P.B.) Ltd. v. Cannon Rubber Manufacturers, Ltd., 9 R.P.C. 240, 14 R.P.C. 327 (1959). The author said that "it cannot be said that it propounds any new doctrine on designs law but it does throw a little more light on some of the difficulties and obscurities of that very important section."

The suit in question, affirmed by the Court of Appeal, involved, according to the author, the alleged infringement of a design for a hot water bottle, and the novelty claimed was in the shape or configuration of the article. The unusual feature of the bottle consisted of defined diagonal ribs on the front and back and extending up to the sides. There were two points made in interpreting the language of the pertinent section of the Registered Designs Act; the effect of confining the claim for novelty to "shape or configuration," and the meaning of "shape or configuration." The judges in the case refused to hold that the ribbing amounted to a method or principle of construction or that there was no infringement, despite the fact that defendant had urged that there was no valid registered design to infringe because the statement of novelty (relating to the shape or configuration of the bottle) did not include the ribbing. It was therefore found that the design was validly registered and had been infringed.

Heydt, Ludwig, "Geschmacksmuster und Werke der angewandten Kunst," Gewerblicher Rechtsschutz und Urheberrecht, Vol. 70, No. 9, (September 1968) 530-537.

This is a survey of efforts in the German Federal Republic to obtain effective domestic and international protection of designs and works of applied art, especially with respect to problems of definition.



Japan: Design Law, No. 125 of April 13, 1959, as amended, Industrial Property, Vol. 13, No. 11 (November 1974) 443-453.

The definition of "Design," section 2 (1) means the shape, pattern or color or a combination of these in an article which produces an aesthetic impression on the sense of sight.

There is provision, for example, for design registration; that the design may, upon application, be kept secret for three years; examination; a term of protection of 15 years from the date of registration; licensing.

Japan: Utility Model Law (Law No. 123 of April 13, 1959, as amended by Law No. 140 of 1962, Law No. 161 of 1962, Law No. 148 of 1964, Law No. 81 of 1965, Law No. 91 of 1970, and Law No. 96 of 1971). Industrial Property, Vol. 13, Nov. 11 (November 1974) 453.

The purpose of this Law "shall be to encourage devices by promoting the protection and utilization of devices relating to the shape or construction of articles or a combination of articles, so as to contribute to the development of industry." Registration may be made for a device which is industrially applicable except where it has been publicly known or exploited in Japan prior to the filing of the application, or described in a publication distributed in Japan or elsewhere prior to the filing, or where the device "could very easily have been made prior to the filing...", by a person with ordinary skill in the art to which the design pertains," or where the device is identical with a device or invention described in a request of another applicant and filed earlier. There is provision in the Law for request for an examination. The term of the utility model is for ten years from the date of publication or the utility model application, not to exceed 15 years from the filing date. The owner of the model has the exclusive right to exploit it except in the case of an exclusive licensee. An interesting provision is contained in Article 8 of the Law (conversion of applications). An applicant for a patent may convert his application into a utility model application, and an applicant for a design registration may convert his application into a utility model application, this under certain circumstances relating to time factors. Certain sections of the Patent Law apply to utility models, including its section 30, as to exceptions to lack of novelty of invention.

The penal provisions in the law are for fines with labor in relation to offenses of infringement, fraud, false marking, perjury, divulging secrets.



King, A.C., "Letter from Australia," Industrial Property, Vol. 12, No. 2 (February 1973) 64-67.

The author states that there has been no legislative development in Australian trade marks law in the past decade. Referring to a case decided in 1963-4, The Shell Co. of Australia Ltd. v. Esso Standard Oil -(Australia) Ltd., 109 C.L.R. 407; the Full High Court had to consider whether the appearance on television, in an animated cartoon advertising motor fuel, of a humanized figure with a head in the shape of a drop of liquid, infringed a registered trade mark comprising a similar figure standing in a fixed posture. The Court held that the only use of any mark which could constitute infringement was its use as a trade mark and that in the above case there was no infringement, because no-one would assume from the appearance and context of the above cartoon character that it was being shown to him as identifying the defendant's goods.

Knap, Karel, "Urheberrechtlicher Schutz von Kunstwerken und Geschmacksmusterschutz," Archiv fur Urheber-Film, Funk-und Theaterrecht, Vol. 61 (1971) 109-126.

The Summary in English states in part that: "Although the title of this article restricts itself to the reciprocal relation of copyright protection of works of art and designs, the author also takes a position on certain basic questions of the entire system of intellectual property rights, which are of decisive importance for the treatment of the topic. The topic is treated not only from the viewpoint of current German and foreign law, but also in view of future developments of the law." The Summary also indicates as part of further elaboration that "the policy behind design protection is to be found in the necessity of protective valid interests of businesses, which achieved and introduced into commerce through their organizational and technical effort a relatively new form of a product, which is objectively suitable to stimulate the aesthetic sense of form and color," and, "while the right to protection, through copyright is based on the creative achievement, the protection through design copyright is not based on creativity but, rather, achievement." The author adds that "the mistake which has arisen in this area lies in the fact that the concept of novelty in the law of design protection has been equated with the concept of creativity within the meaning of the copyright law."

Krieger, Albrecht, "The New German Patent and Trademark Law," Industrial Property, Vol. 7, No. 5 (May 1968) 155-162.

The article indicates that "The Law for the Amendment of the Patent Law, Trademark Law and other laws, dated September 4, 1967" (Industrial Property 1967, p. 305) introduced "The most far-reaching



changes undergone by German and Trademark law since its institution in the second half of the nineteenth century." Further comment was that "the Law of September 4, 1967, amended the German industrial property laws in so many respects that it was felt necessary to publish them in a consolidated new edition (of January 2, 1968); these new versions (of the Patent Law, the Utility Model Law, the Trademark Law and the Law on Patent Office and Patent Court fees) represent the latest consolidation of German law in the field of industrial property and also show the numerous new provisions in their relationship to the parts remaining unchanged. "They will remain the dominant legal foundation until the general reform of German law in this field ...is introduced, and that probably means until well into the 1970s... For the time being, there is no likelihood of any other substantial changes in German industrial property law."

The author then enumerates the essential changes made.

Lahore, J.C., "Industrial Designs and the Copyright Act 1968--The Problem of Dual Protection," The Australian Law Journal, Vol. 43, No. 4, (April 30, 1969) 139-148.

This article, which contains an initial outline of the background of the Copyright Act 1968 and the Design Act 1968 of Australia, explains some of the difficulties in giving adequate protection to industrial designs and in determining the respective sphere of copyright and industrial design legislation. The author in particular summarizes the situation in this area with respect to Australia and the United Kingdom, referring also to the United States:

"In the United Kingdom and Australia the Designs Act, and not the Patent Acts, provide for the protection of designs applied to articles by industrial means. But the problems as to the nature of the protection to be given to works of art and industrial designs are in many respects similar. Many difficulties have resulted from the failure of the courts and legislatures in both the United Kingdom and the United States to provide clear methods of determining the areas of operation of copyright and industrial design protection. These difficulties...are of immediate concern in Australia as a result of the passing of [the two 1968 Acts.]. These Acts introduce an approach to the relationship between copyright in artistic works and registered designs which differs from that in the Copyright Act 1911 [U.K.] and the Designs Act



1906-1967 [U.K.]. This article will consider some of the difficulties and the manner in which they have been tackled by the legislature..."

Lidle, Gunter, "Das Geschmacksmuster Zwischen den Technischen Schutzrechten und dem Urheberrecht aus der Sicht der Praxis," Gewerblicher Rechtsschutz und Urheberrecht, Vol. 67, No. 5, (May 1965) 223-227.

A discussion of the protection of designs as industrial property and as works of art, with the conclusion that, on the basis of recent decisions of West German Courts, it might be advisable to seek copyright protection even in those cases where protection is also available under the laws of patents and utility models.

Lightman, Joseph M., "Patent, Trademark, Industrial Design and Copyright Protection in Colombia" Overseas Business Reports, OBR 66-54 (August 1966) 1-7, U.S. Department of Commerce.

This Report explains the basic Colombia laws on patent, trademark and industrial design protection No. 31 of February 28, 1925, and No. 94 of June, 1931, as amended, and the supplemental decrees that have been issued. Specific attention is paid to each topic indicated with an outline of the requirements relating to each type of protection and of what constitutes infringement. As indicated, copyrights are registered and protected under the Colombian Copyright Law (n. 86 of December 26, 1946; Regulating Degree No. 1258 of 1949) administered by the National Registrar of Copyright of the Ministry of Interior (Gobierno). As indicated, Colombia is a member of the Buenos Aires Convention, but not of the Berne Union, the U.C.C. nor the Paris Union.

Mathely, Paul (Letter From France) "Trademarks, Implementation of the New Law," Industrial Property, Vol. 8, No. 7 (July 1969) 193-197.

The author states that it is perfectly clear that the new Law of December 31, 1964, and June 23, 1965, on marks is not an interpretation of the previous Law of 1857 and has no retroactive effect; under the new system it is registration that gives rise to rights in a mark. However, the effects of a mark filed under the previous law and valid on August 1, 1965, when the new law



came into operation, continue to date back to the earliest use of the mark, since this was the practice under the Law of 1857. The writer cites a case which is consistent in the definition it gives to the conditions required for trademark validity. The mark need not be original or new, but it must be distinctive with respect to the articles it identifies; and a mark only lacks distinctiveness in cases where its use, in identifying the article to which it is applied, is necessary, generic or common, or where it is no more than a straight description of the nature, material qualities or intended use of that article. Several cases were also discussed.

Miles, James W., "Copyright Legislation in New Zealand Affecting Artistic Works," Copyright Society of the U.S.A., Vol. 10, No. 4 (New York: April 1963) 209-213.

The author comments on the new Copyright law of New Zealand which came into effect April 1, 1963 [Act. No. 22 (1962), 83 p. (Wellington, R.E. Owen, Govt. Printer)], stating that "the law has particular interest for other British Commonwealth countries and the United States in regard to the protection of industrial designs and, in particular, the protection of copyright of artistic designs applied in industry." He indicates as part of his discussion that "New Zealand is the first in the British Commonwealth to adopt in its copyright law the general principle, sanctioned by the copyright law in most Berne Convention countries, that an artistic work is protected by copyright irrespective of its industrial application or utilitarian use. This principle is also in general agreement with the leading United States case of Mazer v. Stein," [347 U.S. 201 (1954)]. The author also emphasized that "the previous position in New Zealand followed the United Kingdom copyright law, which in 1911, introduced an innovation intended to exclude from the protection by copyright, artistic works in the category of industrial designs." He concludes that both copyright and design laws must be considered as complementary in regard to the necessary legal protection of industrial designs, but that to them might be added in this connection the law of trademarks and of unfair competition, which serve a separate purpose.

Nicolini, Kate, "Die Neuheit im Geschmacksmusterrecht," Gewerblicher Rechtsschutz und Urheberrecht, No. 8 (August 1963), 407-413.

This article discusses the objective, subjective, and relative novelty requirements for protection of designs and models under



West German law, and explains that whereas the legal literature appears to favor the theory of subjective novelty, the case law on the other hand appears to support the relative novelty theory. The author's conclusions are set forth, as translated from the German: (1) The text of the law does not permit a clear interpretation of the concept of novelty; (2) The legislative history of the design law indicates that a proof of subjective novelty is required; (3) Similarly the nature of the design right which can be regarded as a copyright in a broader meaning seems to favor the subjective novelty theory; (4) The subjective novelty theory would not constitute an undue complication of the proof situation; (5) Under the present legal situation, the subjective novelty theory should be given preference before the objective and relative novelty theories.

Nigeria: Patents and Designs Decree 1970 (No. 60 of 1970), Industrial Property, Vol. 12, No. 5 (May 1973) 147-155.

The part of the Decree relating to Designs defines an industrial design:

(Section 12) "any combination of lines or colours or both, and any three-dimensional form, whether or not associated with colours, is an industrial design if it is intended by the creator to be used as a model or pattern to be multiplied by industrial process and is not intended solely to obtain a technical result."

Section 13 provides that an industrial design is registrable if it is new, and is not contrary to public order or morality. The design is not new if before the date of application for registration it has been made available to the public anywhere and at any time by means of description, use or in any other way, unless it is shown to the satisfaction of the Registrar that the creator of the design could not have known that it had been made so available. Registration of an industrial design shall be effective for five years from the date of the application and may be renewed for two further consecutive periods of five years.

The last part of the Decree relates in part to contractual arrangements for licenses to exploit the design, and also to the fact that the Commissioner may, with a view to the fulfillment of a treaty, convention or other international arrangement or agreement to which Nigeria is a party, declare by Order in the Federal Gazette that any country specified in the Order is a convention country.



The Nordic Design Laws, Industrial Property, Vol. 10, No. 9 (September 1971) 223-240. These new Danish (1970), Finnish (1971), Norwegian (1970), and Swedish (1970) Design Acts are presented as a unity as was the case with the Nordic Patent Laws, published in Industrial Property 1968.

The introductory note explains that where the provisions in the four laws are identically or almost identically worded, they are set out under the heading Common in the left-hand margin of the column. In other cases the relevant country or countries have been indicated in the margin above the provision concerned. Minor differences in wording are indicated DFNS. This means that the word or words in brackets only appear in the respective Acts.

NOTE: An article on the "Swedish Design Protection Act" has been written by Claes Uggla, and appears in the same issue of Industrial Property (p. 241). The author explains that a design is defined in the Act as the prototype for the appearance of an article for an ornament, but the new Act does not limit registration and protection to ornamental designs, as did the old Act: "Thus, protection will be given to designs whose features are wholly ascribable to functional reasons", but "this does not mean that so-called utility models are registrable under the Design Protection Act", for the aim of the Act is merely to afford protection to the "outward appearance of an object, and it does not concern itself with any technical idea that might underlie that appearance".

Certain aspects of the Act are: The period of protection is five years and can be renewed twice; there is a preliminary examination system, consistent with a "patent approach", and it ends with publication for opposition; to bring the novelty requirement home to applicants, they have to sign an affidavit declaring that to the best of their knowledge the design is new; to be considered new, a design must differ substantially from a previously known design; registration is handled by the Patent Office; the decisions of the Board can only be appealed by applicants, not by opponents; the case is then taken to the Supreme Administrative Court.

Peru: General Law relating to Industry (Legislative Decree No. 18350 of July 27, 1970), Industrial Property, Vol. 12, No. 4 (April 1973) 112-118.

The Law contains a chapter XIV of Title V on Industrial Property (page 114) which provides for recognition of exclusive rights and



for registration in relation to a shape, configuration, ornament or design, applicable to an industrial article, provided that it is original or sufficiently distinctive. The ornamentation of the product may be made by any medium and may be applied to any article without distinction. It is also provided that the following may not be protected as industrial designs: (a) designs whose purpose is to give a utility, function or technical advantage to products; (b) works of art; (c) designs contrary to public order or morality; (d) foreign industrial designs, more than one year after the date on which the application for registration was filed in the first country in which application was made, and (e) designs relating to clothing. The registration of a design shall confer the exclusive right to the use thereof for a period of five years from the date of grant. The rules relating to patents (same Law) shall apply, where appropriate, to industrial designs.

As to trademarks (Chapter XVI) the following may be registered as marks: real or fanciful words, labels, envelopes, packaging, original containers, stamps, emblems, monograms, logotypes, inessential or unusual shapes of goods and, generally, any sign which is sufficiently distinctive to designate products subject to the limitations in this Law. Among the marks that may not be registered are shapes that are usual or essential in relation to their dimensions and colors.

Chapter XVIII of the Law provides for protection against unfair competition: any act contrary to good faith in trade, or to the normal development of industrial and commercial and, consequently unlawful. The acts of unfair competition are specifically enumerated and in addition "any other act contrary to good faith in economic activities which, by its nature or purpose, may be considered comparable or similar to those enumerated."

NOTE: A study of these new provisions, written by Francisco Espinosa Bellido and entitled "New Provisions on Industrial Property in Peru," appears in the same issue of Industrial Property at pages 119-122. Part II of the same study relates to "New Provisions Regarding Industrial Property under the Andean Pact," signed by Bolivia, Chile, Colombia, Ecuador and Peru on May 26, 1969, as to "common treatment" on foreign capital and on trademarks, patents, licenses and royalties.

Phillips, Jeremy, "'Artistic' Copyright," The Modern Law Review, Vol. 38, No. 1 (January 1975) 86-89.



This article discusses the decision on appeal of the House of Lords in George Hansher v. Restawhile Upholstery (Lancs.) Ltd., (2 W.L.R. 700 (1974)); 2 All. E.R. 420 (1974), in which it was decided unanimously on the facts that a workshop furniture model for a stylistically distinctive three-piece suite [sofa] was not a "work of artistic craftsmanship" within the meaning of section 3(1)(c) of the Copyright Act of 1956. The author points out that "aside from the question whether it is right and proper to protect under the Copyright Act works which it was intended should fall within the scope of the Registered Designs legislation, there was much controversy on a point of statutory interpretation, as to the meaning of the word "artistic;" moreover "nowhere is it laid down that double protection should not be granted, in fact the Design Copyright Act of 1968 makes quite clear the possibility of dual protection of the same work." The author concludes that the House of Lords' explanation in this case "gives us little or no indication as to whether a work will or will not get copyright protection... The Whitford Committee, currently looking into the prospects of copyright reform, will find it hard to avoid examining this confusing decision."

Ronga, Giulio, "La Classificazione Internazionale dei Disegni o Modelli Industriali," Diritto di Autore, Vol. 36, No. 1, (January-March, 1965) 1-13.

This article discusses an appropriate classification for the international registration of designs and industrial models, with special reference to the fact that, under the legislation of various countries, designs and models can be protected under copyright law (Belgium), under a cumulative system of protection (France), or as designs or models (Italy).

Russell-Clarke, Alan Dubeny, "Copyright in Industrial Designs," (4th edition. Sweet & Maxwell, London, 1968) 237 pages.

This is an updating of a comprehensive text on copyrights in industrial designs in the United Kingdom. The Appendices include texts of pertinent laws and regulations.

Russell-Clarke, Alan Dubeny. "Russell-Clarke on Copyright in Industrial Designs," (5th edition by Michael Fysh). Sweet & Maxwell, London 1974. 314 pages.

An updating of a comprehensive text on industrial designs in the United Kingdom, the first in which the original author has had no part. Appendices include texts of pertinent laws and regulations.



Samson, Benevito, "Die Moderne Kunst, die Computer--"kunst" und das Urheberrecht. Zugliech kritisehe Notizen za Max Kummers Buch uber 'Das urheberrechtlich geschutzte Werk'" Archiv fur Urheber-Film-, Funk-und Theaterrecht, No. 56 (1970) 117-148.

This article is a survey of copyright problems connected with the development of modern art: modern painting being characterized by a departure from concrete expression, an evolution that may also be characterized as a revolution whereby the traditional concepts of art and aesthetics may require a new interpretation. The author discusses Max Kummer's work "Das urheberrechtlich geschutzte Werk" (The Copyrightable Work) in which it is proposed to extend copyrightability to anything that contains visible and audible expression, if it possesses: individuality (statistical uniqueness) as opposed to the execution of a given instruction; purpose in itself; and, is presented as a "work of art or literature." The author raises the question whether the programming of a computer (program analysis) may or may not be considered a scientific work or a work of art--a question answered in the affirmative. Summary in English.

Savignon, Francois (Director, French National Institute for Industrial Property), "On the French Law No. 68-1 of January 2, 1968, to Promote Inventive Activity and Revise the Patent System" Industrial Property, Vol. 7 No. 3 (March 1968) 76-79.

The author in his conclusion states that "... The Law of January 2, 1968 follows the general direction of the evolution of the previous French legislation. It can be maintained that it respects the concept of the legislator of 1791 by granting only limited powers to the executive branch of Government as regards judging patent ability... Finally the Law was conceived and prepared with international solutions in mind and takes into account the current efforts being made to harmonize legislations."

Secretan, Hubert, "La Protection des Dessins et Modeles Industriels et des Oeuvres d'Art Applique aux Etats-Unis et en Suisse: Etude de Droit-Compare." Editions Medecine et Hygiene, (Geneve 1964) 184. Thesis-Lausanne.

This thesis compares the legal protection of industrial designs and models and works of applied art in the United States with that of Switzerland, and makes reference to the United States design bills, particularly S. 1884 (87th Congress, 1st session, 1961). The conclusion is that Switzerland could benefit from



certain solutions offered by the American legislative proposals by adaption of them to its domestic legislation.

Shah, S.B., "Letter from India", Industrial Property, Vol. 9, No. 5 (May 1970) 151, 153.

This comment discusses Industrial Designs, stating that a new and original design applied to an article by an industrial process or means is protected in India by registration under the provisions of Part II of the Indian Patents and Designs Act, 1911. Registration is effected in respect of articles falling under one of the several classes set forth in the Fourth Schedule to the Indian Patents and Design Rules, 1933. Under the Copyright Act, 1957, a design registrable under the provisions of the Indian Patents and Designs Act is not protected as an artistic work. The author remarks also that "industrial development after Independence has provided an impetus to the manufacturers to seek protection of their designs by registrations under the Act." and "a majority of applications for registration relate to textile designs."

South Africa. [Republic of], "An Act to Consolidate and Amend the Law Relating to Designs (No. 57, 1967)." Industrial Property, Vol. 7, No. 8 (August 1968) 256-264.

Article 1 contains "definitions" and in subparagraph (vi) defines "design" as meaning - "any design applied to any article, whether for the pattern, for the shape or configuration or for the ornamentation thereof or for any two or more of such purposes, and by whatever means it is applied, insofar as such features appeal to and are judged solely by the eye: Provided that any feature of an article insofar as such feature is dictated solely by the function which the article is intended to perform and any method or principle of construction shall be excluded from the rights afforded by this Act." The Act provides for registration of designs, and states the conditions under which a design shall be deemed to be new or original (where previously used, described, or registered etc.); it also provides that designs for articles not intended to be multiplied by an industrial process shall not be registrable, and that "where copyright subsists in an artistic work in terms of the Copyright Act, 1965 (No. 63) the State President may by regulation exclude a corresponding design from registration under this Act...." Article 8 of the Designs Act provides for a compulsory license in relation to a registered design by anyone who has been unable



to obtain a design. Article 14 provides for a period of 5 years with the possibility of a 5 year extension period.

Strunkmann-Meister, Karl E., "Leistungsschutz und Industrieform", Archiv. fur Urheber, -Film-, Funk und Theaterrecht, Vol. 66 (1973) 63-74.

The Summary in English of this article explains that "there is a need for a new and modern Design Patent Act [German Federal Republic] for which the author makes detailed proposals. One of his aims is to avoid a confusion between the realms of design patent law and copyright law in the future. Instead of acknowledging a 'small coin' of the copyright there should be a neighboring right for all designs and models following the protection of photographs in the new Copyright Act."

Strunkmann-Meister, Karl E., "Systematische Betrachtungen zum Neuheitsbegriff und Geschmacksmusterrecht," Archiv fur Urheber-, Film-, Funk- und Theaterrecht, Vol. 58 (October 15, 1970) 13-42.

A study of the question of novelty in design protection under the Design Protection Act of the German Federal Republic. The author among other comments states that the term "novelty" in the Germany Design Protection Act is to be interpreted as requiring individual, material, and relative novelty. Individual novelty means that the object is not an imitation, material novelty means it is sufficiently distinctive as an object of protection, relative novelty means that the design was not known before among the relevant trade. Summary in English.

Ulmer, Eugen, "Letter from Germany: The New German Copyright Act," 1 Copyright, No. 12 (United International Bureaux for the Protection of Intellectual Property (BIRPI) Geneva: December 1965) 275-286.

This commentary summarizes the content of the new copyright statute of the Federal Republic of Germany of September 9, 1965. In regard to designs, Professor Ulmer says that:

"...the new Copyright Act too adheres to the idea of applied art, though there has been no lack of comment--especially from industrial quarters--urging that protection of craft and industrial forms be left entirely to design law, and that copyright and design law be separated by a



method similar to that adopted in the 1956 British Copyright Act. Such an arrangement would admittedly avoid the demarcation, difficult in individual cases, between creations which are eligible only for design protection and those which qualify for the more comprehensive copyright protection, but this could be done only if design law were revised. In its present form, especially in view of the limitations of the term of protection to a term of fifteen years, design law cannot ensure adequate protection for creations of an artistic level."

United Kingdom Board of Trade, Departmental Committee on Industrial Designs. Report. London, H.M. Stationery Office, 1962. 143 p. ([Great Britain Parliament, Papers by Command] cmd. 1808).

The U.K. Board of Trade recommends reform of design legislation. On May 11, 1959, the Board appointed an eight-member committee, chaired by Kenneth Johnston to report on what changes, if any, would be desirable in the law concerning industrial designs. The only directive the Committee was given consisted in calling to its attention the possible need for U.K. designs "to receive cheap and effective protection in other countries on the basis of reciprocity."

The Johnston Committee recommended that the present Registered Design Act, 1949, be maintained with certain modifications, but that the second, new, Act also dealing with designs be adopted. Protection under the former would be called "design monopoly," and protection under the latter would be called "design copyright." Both laws would relate to designs and designs would be defined in both laws as: "Design shall mean features of shape, configuration, pattern or ornament of an article, or features of pattern or ornament applicable to articles, in so far as such features appeal to and are judged solely by the eye." Protection under both laws would be for 15 years.

The Johnston Committee, whose report is dated May 14, 1962, recommended that adherence by the U.K. to the Hague Arrangement of 1960 on the international registration of designs should be sympathetically considered.

NOTE: Further discussion of this material appears in the Copyright Society Bulletin of the U.S.A, Vol. 9, No. 6 (New York: August 1962) 485-487.



"United Kingdom Committee to Study Copyright," News Brief, Bulletin of the Copyright Society of the U.S.A., Vol. 22, No. 1 (October 1974) 76.

The Minister for Trade and Consumer Affairs of England has set up a departmental committee to inquire into the law of copyright in that country. The committee will consider and report on whether changes are desirable in the Copyright Act of 1956 and the Design Copyright Act of 1968. Mr. Justice Whitford will chair the committee, whose other members are: Mr. G.V.K. Burton, C.B.E., Mr. G.H. Doughty, Mr. D. Fiske, Ms. Rosina Harris, Ms. Jacqueline Inchbald, Mr. E.P. Skone-James, Mr. W. Wallace, C.M.G., and Mr. W. Weston.

United Kingdom Design Copyright Act 1968 (of October 25, 1968), See 4 Copyright, No. 11 (United International Bureaux for the Protection of Intellectual Property (BIRPI) Geneva: November 1968) 234.

Section 10 of the Copyright Act of 1956 (special exception in respect of industrial designs) is amended. Section 10 prior to the amendment took away from the copyright owner all protection under that Act when he applied his artistic work to articles of commerce and put those articles on the market. The amendment postponed this loss of protection for 15 years; the copyright owner retained his power to sue under the Copyright Act anyone who copied his work and this power continued for 15 years from the date he himself marketed goods to which the work had been applied; and this was the case whether or not the design was registered.

Wallace, William (Assistant Comptroller, Board of Trade, London) "The United Kingdom protects works of applied art," Copyright, 4. No. 11 (United International Bureaux for the Protection of Intellectual Property (BIRPI) Geneva: November 1968) 235-236.

This comment discusses the Design Copyright Act of 1968. The author explains that "without any opposition from Parliament or elsewhere, 1968 is an important change in the British law for the protection of 'industrial designs', the expression used in the United Kingdom to cover both 'works of applied art' and 'industrial designs and models' within the meaning of the Berne Copyright Convention." [See also reference to United Kingdom Design Copyright Act of 1968 supra]. Mr. Wallace explains with respect to the international aspects of the Act of 1968:

"The new Act therefore protects copyright owners of all works of applied art for 15 years, and this applies



equally whether they are British or nationals of countries which are members of the Berne or international Conventions....

From now on it is no longer true that British designs are protected in Britain 'solely as designs and models.' The necessary reciprocity under the Berne Convention is present and British works of applied art are therefore entitled to the national treatment given in countries of the Berne Union to their domestic works of applied art."

Wallace, William, "Protection for Designs in the United Kingdom." IIC, International Review of Industrial Property and Copyright Law, Vol. 5, No. 4, Max-Planck-Institute (Munich 1974).

The author first discusses the Registered Designs Act 1949 of the United Kingdom, which, although the Act speaks of "the copyright in the design" has for the criterion for protection novelty rather originality; the owner of a valid registration enjoys, like the patentee, a monopoly and protection which depends on registration, lasts for 15 years (3 renewable 5-year periods). This registration system, according to the author, entails facing "the problem of the artistic work protected by copyright, which subsequently is applied to mass-produced articles of commerce, and marketing," and the question whether the article is a "work of applied art," that is, "artistic" as distinct from merely utilitarian." Mr. Wallace also refers to the Design Protection Act of 1968 whereby all original artistic works are now protected, even when mass-produced, against copying for 15 years under the copyright law, and this protection is given to all Berne and Universal Copyright Convention nationals as well as to Britons. The writer comments that "the acceptance of simultaneous design and copyright protection was a big step towards the systems operating in Continental Europe." The author explains the criticisms leveled at the 1968 Act, but points to the advantage of no requirement of registration and no formality in regard to protection by copyright of works of applied art in Berne Convention countries.

Finally, Mr. Wallace points out that one of the tasks of the Committee (of which he is a member), recently appointed to look into our law of copyright, under the chairmanship of Mr. Justice Whitford, will be to hear evidence and make recommendations over the whole field of protection for designs.



West - Walker, F.N. "Letter from New Zealand," Industrial Property, Vol. 12, No. 6 (June 1973) 174-176.

The author in discussing legislation states that the relevant legislation for trademark in New Zealand is the Patents Act 1953 and the Trade Marks Act, 1953, both of which correspond very closely to the United Kingdom Acts of 1949 and 1938; that industrial designs are governed by the Designs Act, 1953, which again corresponds to the British Act of 1949, although copyright protection is also available for designs under the Copyright Act, 1962. The author explains that under the previous law industrial designs which also constituted artistic works were excluded from the benefit of the Copyright Act, but such works now enjoy unqualified protection for the normal term under the 1962 Act (during the author's life and for fifty years after his death); hence industrial designs may be registered under the Designs Act for a maximum term of fifteen years but simultaneously and thereafter obtain protection under the Copyright Act, the protection being dual or cumulative. The author emphasizes that "thus the New Zealand law in this respect differs from that of the United Kingdom, notwithstanding the British Design Copyright Act, 1968." New Zealand is a party to the London Acts of the Paris Convention for the Protection of Industrial Property and of the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods. It is also a party to the 1947 Neufchatel Agreement concerning the restoration of industrial property rights affected by the Second World War.

White, Thomas A. Blanco, "Patents for Inventions and the Registrations of Industrial Designs," (3d ed. London, Stevens, 1962) 640 p.

A new edition of a British textbook on patent and design laws with a special section on industrial designs in relation to copyright under the U.K. Copyright Act of 1956. The author states in his Preface, that section 10 of the Copyright Act, 1956, is more complex than he appreciated when he prepared pages 276-78 of his book, hence more complex than those pages might suggest. As an example, he says, it might seem that, with designs derived from copyright works, the issue of infringement takes on an entirely different shape, since use or registration of the work as an industrial design leaves noninfringing variants of the design bills still covered by copyright. He adds: "So far so good: but what of the position after fifteen years? Only further legislation can really clarify the law, that is something legislation seldom does."



Uruguay: Decree on Industrial Designs. (No. 362/972 of May 25, 1972), Industrial Property, Vol. 12, No. 6 (June 1973) 172.

The Decree provides (section 2) that "Industrial designs of an industrial product that are novel, original and ornamental may be protected by design patents. By design is meant the shape or appearance, incorporated in an industrial product or applied thereto, which gives the product an original ornamental character or a specific characteristic." Not the subject of a patent are designs already the subject of an earlier application published in the country and designs publicly exploited there or published anywhere prior to the date of publication in books, reviews or pamphlets in such a way as to permit their implementation; industrial designs which entail solely a change in color of designs already known; industrial designs which embody works of art, and, industrial designs contrary to public order or morality.

The term of validity shall be five years, which may be renewed for five years. Applications may be the subject of opposition if the non-patentability of their subject matter can be proved. Law No. 10089 of December 12, 1941, and its implementing decrees are hereby declared applicable insofar as they are relevant to industrial designs.

Ze'ev Sher (Deputy Attorney General, Israel), "New Patent Legislation in Israel, the Patent Law, 5727-1967", Industrial Property, Vol. 8, No. 4 (April 1969) 96-100.

According to the author, this Law is not the end of the road but rather the beginning of a new era: what is considered are not such anticipated changes as the Patent Cooperation Treaty, which will aid in carrying out the administrative tasks under the Law, but rather what the nature of patent law will be in the next half century, when we will be faced with a new form of economy in which international corporations each concentrate on certain lines of production and competition takes on a different shape. At present, the author states it seems as if a distinction will be made between the rights of the inventor and the rights of the owner of the invention. The question is whether this Law will be adaptable to future conditions. Particular emphasis is placed by the author on the problem of compulsory licensing under the Law, it being one of the most controversial issues of the patent system. The writer believes that, on balance, it is the interest of the patentee that has been preferred. Also indicated is the fact that universal







II. Design Copyright Bills Introduced in Congress -  
1959 - 1975.

S. 2075, 86th Congress, 1st Session (1959)

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. O'Mahoney (for himself, Mr. Wiley, and Mr. Hart) and referred to the Committee on the Judiciary.

This bill was based upon, and is similar to the Willis design protection bill, H.R. 8873, of the Eighty-fifth Congress, but had been revised to some extent in language and content. among the more important changes were: (1) the requirement that a design be both published and embodied in an article before becoming eligible for protection, (2) the reduction of the duration of protection to a single five-year term, and (3) a new provision on administrative examination, which would permit the filing of "objections" to registration.

H.R. 9525, 86th Congress, 2d Session (1960).

A Bill to encourage the creation of original designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Ford and referred to the Committee on the Judiciary.

Identical with the O'Mahoney-Wiley-Hart Bill (S. 2075), introduced in the first session, except for some typographical revisions.

No further action.

S. 2852, 86th Congress, 2d Session (1960).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying and to preserve copyright protection for creators of artistic works in which copyright subsists. Introduced by Mr. Talmadge and referred to the Committee on the Judiciary.



A new design protection bill similar to the O'Mahoney-Wiley-Hart bill (S.2075) introduced in the First Session, but with two notable exceptions. First, the instant bill proposed a five-year term of protection plus the right to two renewal terms of five years each, whereas S. 2075 provided for a non-renewable, five-year term.

Second, the instant bill offered a choice between copyright protection for an ornamental design when embodied in a useful article, or the lesser protection and term afforded by voluntary registration under the proposed bill. Under S. 2075, however, copyright protection was not available for ornamental design as embodied in a useful article, and protection for such design, limited to a five-year term, was to be secured only by compliance with the provisions of the bill.

No further action.

H.R. 9870, 86th Congress, 2d Session (1960).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying and to preserve copyright protection for creators of artistic works in which copyright subsists. Introduced by Mr. Flynt and referred to the Committee on the Judiciary. Companion bill to S. 2852, supra.

No further action.

S. 2075, 86th Congress, 2d Session (1960).

Hearing before the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate, Eighty-sixth Congress, Second Session pursuant to S. Res. 240 on S. 2075 and S. 2852 to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs.

No further action.

H.R. 6776, 87th Congress, 1st Session (1961).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for



a limited time against unauthorized copying. Introduced by Mr. Flynt and referred to the Committee on the Judiciary.

Similar in most respects, but containing several important differences from bills on the same subject introduced in the Eighty-sixth Congress.

No further action.

H.R. 6777, 87th Congress, 1st Session (1961).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Ford, and referred to the Committee on the Judiciary. Identical with H.R. 6776, supra.

No further action.

S. 1884, 87th Congress, 1st Session (1961).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Hart (for himself, Mr. Wiley, and Mr. Talmadge) and referred to the Committee on the Judiciary. Companion bill to H.R. 6776 and H.R. 6777, supra.

S. 1884, 87th Congress, 1st Session (1961).

Hearings before the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate, Eighty-seventh Congress, First Session pursuant to S. Res. 55 on S. 1884. August 15, 16 and 17, 1961.

S. Rept. No. 1725, 87th Congress, 2d Session (1962).

Report, together with individual views, to accompany S. 1884 submitted by Mr. Hart, from the Committee on the Judiciary.

The amendments included, inter alia, numerous changes in language, a fee schedule, and a limitation on the amount of damages to be awarded for infringements. Senator Kefauver opposed enactment in a brief statement of "Individual views"



on grounds of his agreement with a statement of the Deputy Attorney General "that the bill raises serious constitutional and policy problems."

Passed Senate, July 23, 1962.

No further action.

S. 1884, 87th Congress, 2d Session (1962).

An Act to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Referred to the Committee on the Judiciary.

No further action.

H.R. 323, 88th Congress, 1st Session (1963).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Flynt and referred to the Committee on the Judiciary.

A reintroduction of H.R. 6776, 87th Congress, 1st Session with changes which, for the most part, consisted of refinements in language.

No further action.

H.R. 769, 88th Congress, 1st Session (1963).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Ford and referred to the Committee on the Judiciary. Identical with H.R. 323, supra.

No further action.

S. 776, 88th Congress, 1st Session (1963).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by



Mr. Hart and referred to the Committee on the Judiciary.  
A companion bill to H.R. 323 and H.R. 769, supra.

S. Rept. No. 686, 88th Congress, 1st Session (1963).

Design protection act of 1963. Report, without amendment, to accompany S. 776, submitted by Mr. Hart, from the Committee on the Judiciary.

S. 776 passed Senate, December 6, 1963.

No further action.

S. 776, 88th Congress, 1st Session (1963).

An Act to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Referred to the Committee on the Judiciary.

No further action.

H.R. 5523, 88th Congress, 1st Session (1963).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Libonati and referred to the Committee on the Judiciary. Identical with H.R. 323, H.R. 769 and S. 776, supra.

No further action.

H.R. 323, 769 5523 [and S. 776], 88th Congress, 1st Session (1963).

Hearing before Subcommittee on Patents, Trademarks and Copyrights of House Judiciary Committee on these bills, December 12, 1963.

Transcript never printed.

House Subcommittee reported bill out with amendments on August 12, 1964 - no report printed.

H.R. 450, 89th Congress, 1st Session (1965).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for



a limited time against unauthorized copying. Introduced by Mr. Gerald R. Ford and referred to the Committee on the Judiciary. A reintroduction of H.R. 769, 88th Congress, 1st Session, which was also introduced by Mr. Ford.

No further action.

H.R. 3366, 89th Congress, 1st Session (1965).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Flynt and referred to the Committee on the Judiciary. Identical with H.R. 450, supra.

No further action.

S. 1237, 89th Congress, 1st Session (1965).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Talmadge (for himself and Mr. Hart) and referred to the Committee on the Judiciary. A companion bill to H.R. 450, supra.

S. 1237, 89th Congress, 1st Session (1965).

Hearing before the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, United States Senate, Eighty-ninth Congress, First Session, pursuant to S. Res. 48, on S. 1237.

S. Rept. No. 1404, 89th Congress, 2d Session (1966).

Design protection act of 1966. Report, with amendments, to accompany S. 1237, submitted by Mr. Hart, from the Committee on the Judiciary.

The amendment excluded designs for wearing apparel from protection.

Passed the Senate July 27, 1966.

No further action.



S. 1237, 89th Congress, 2d Session (1966).

An Act to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying.

No further action.

H.R. 2886, 90th Congress, 1st Session (1967).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Gerald R. Ford and referred to the Committee on the Judiciary. Derived from S. 1237, 89th Congress 1st Session, as amended by the Senate on July 27, 1966.

No further action.

H.R. 3542, 90th Congress, 1st Session (1967).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Flynt and referred to the Committee on the Judiciary. Identical with the bills introduced by Mr. Flynt and others in previous Congresses, but not including an amendment approved by the Senate during the previous session excluding designs for wearing apparel from protection. See H.R. 2886 supra and S. Rept. No. 1404.

No further action.

H.R. 6124, 90th Congress, 1st Session (1967).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. St. Onge and referred to the Committee on the Judiciary. Substantially similar to H.R. 2886, supra.

No further action.



H.R. 7870, 90th Congress, 1st Session (1967).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Tenzer and referred to the Committee on the Judiciary. Identical with H.R. 6124, supra.

No further action.

H.R. 3089, 91st Congress, 1st Session (1969).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Gerald R. Ford and referred to the Committee on the Judiciary. Identical with H.R. 2886, 90th Cong., 1st Sess. (1967), also introduced by Mr. Ford.

No further action.

H.R. 4209, 91st Congress, 1st Session (1969).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. St. Onge and referred to the Committee on the Judiciary. Identical with H.R. 6124, 90th Cong., 1st Sess. (1967), also introduced by Mr. St. Onge.

No further action.

S. 1774, 91st Congress, 1st Session (1969).

A Bill to encourage the creation of original ornamental designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying. Introduced by Mr. Hart and referred to the Committee on the Judiciary. Identical with H.R. 3089 introduced by Mr. Ford and H.R. 4209, introduced by Mr. St. Onge.

No further action.



S. 543, 91st Congress, 1st Session (1969).

A Bill for the general revision of the copyright law, title 17 of the United States Code, and for other purposes. Introduced by Mr. McClellan, January 22 (legislative day, January 10), 1969 and referred to the Committee on the Judiciary. Committee Print.

The bill as approved by the Subcommittee contained a number of important amendments and additions. These included provisions dealing with cable antenna television (CATV), the granting of a limited performers' right, the establishment of a Copyright Royalty Tribunal. A provision to create a National Commission on New Technological Uses of Copyrighted Works, originally a separate bill, was made Title II of the general revision bill, and provisions for the protection of ornamental designs of useful articles, also previously a separate bill, was added as Title III.

No further action.

S. 644, 92nd Congress, 1st Session (1971).

A Bill for the General Revision of the Copyright Law, Title 17 of the United States Code, and for other purposes, introduced by Mr. McClellan on February 8, 1971, and referred to the Committee on the Judiciary. Except for certain technical and perfecting amendments, identical to S. 543, including Title III, as reported favorably during the 91st Congress, 1st Session, by the Senate Subcommittee on Patents, Trademarks, and Copyrights. One further change was that subsection (e) of section 113, scope of exclusive rights in pictorial, graphic, and sculptural works (which subsection occurred in S. 543), was deleted and put in section 101 (definitions).

S. 1361, 93d Congress, 1st Session (1973).

A Bill for the General Revision of the Copyright Law, Title 17 of the United State Code, and for other purposes, introduced by Mr. McClellan on March 26, 1973 and referred to the Committee on the Judiciary. Except for technical changes relating to the effective dates of various provisions, this bill was identical to S. 644 (92nd Congress, 1st Sess.).

H.R. 8186, 93d Congress, 1st Session (1973).

A Bill for the General Revision of the Copyright Law, Title 17, United States Code, and for other purposes, introduced by



Mr. Podell on May 29, 1973 and referred to the Committee on the Judiciary.

A companion bill to S. 1361 introduced by Mr. McClellan (93d Congress).

H.R. 14922, 93d Congress, 2d Session (1974).

A Bill for the general revision of the Copyright Law, Title 17 of the United States Code and for other purposes.

Introduced by Mr. Maraziti on March 21, 1974 and identical to S. 1361 as originally introduced by Mr. McClellan on March 26, 1973. Referred to the Committee on the Judiciary.

No further action.

S. 1361, 93d Congress, 2d Session (1974).

A Bill for the General Revision of the Copyright Law, Title 17 of the United States Code, and for other purposes.

The entire bill as originally introduced, which included Title III, was rewritten with a number of changes principally in form. Among significant changes which might be relevant is the addition of a provision [sec. 104 (c)] nullifying the effect of expropriation of a copyright by a governmental organization of a foreign country, the right to secure a copyright, and any right comprised in a copyright. There were no changes in section 113 of the Bill (scope of exclusive rights in pictorial, graphic, and sculptural works).

The bill was debated on the floor of the Senate, Sept. 5-9, 1974 and finally passed as amended, Sept. 9, 1974.

H.R. 15522, 93d Congress, 2d Session (1974).

A Bill for the general revision of the Copyright Law, Title 17 of the United States Code and for other purposes. Introduced by Mr. Waldie on June 20, 1974, and identical to S. 1361 as originally introduced by Mr. McClellan on March 26, 1973. Referred to the Committee on the Judiciary.

No further action.

S. Rept. No. 93-983, 93d Congress, 2d Session (1974).

Copyright Law Revision: together with additional and minority views to accompany S. 1361, submitted by Mr. McClellan from the



Committee on the Judiciary on July 3, 1974. This Report was superseded by another Report on the same date, with the same number, S. Rept. No. 93-983.

There is discussion (pages 106, 138-139) of sections 101 and 113 of the Bill in relation to pictorial, graphic and sculptural works. Attention is called to the fact that subsections (b), (c), and (d) were inserted in section 113 because of the incorporation in this legislation of Title III relating to protection of ornamental designs of useful articles.

S. Rept. No. 93-1035, 93d Congress, 2d Session (1974).

Report on S. 1361 as amended [Committee Print] by Mr. Pastore from the Committee on Commerce, with additional amendments, on July 29, 1974.

No change was suggested for section 113 of the Bill.

S. 22, 94th Congress, 1st Session (1975).

A Bill for General Revision of the Copyright Law, Title 17 of the United States Code, and for other purposes, introduced by Mr. McClellan on January 15, 1975. An identical bill, H.R. 2223, (94th Congress, 1st Sess.) was introduced by Mr. Kastenmeier on January 28, 1975. Title II of the bill, which is entitled "Protection of Ornamental Designs of Useful Articles," or in shorter form as "The Design Protection Act of 1975" (pp. 64-77) is reflected in H.R. 2223. These two bills in section 113 (pictorial, graphic and sculptural works) refer to Title II as Title III, although Title III has become Title II of both bills. S. 22 in general is essentially the same as S. 1361 which the Senate approved on September 9, 1974.

NOTE: S. 22 was passed by unanimous vote of 97-0 on February 19, 1976. The bill was amended in some particulars on the floor before passage. The 1976 Act contains a provision (section 118) for the compulsory licensing by noncommercial educational broadcast of nondramatic, literary, musical, pictorial, graphic, or sculptural works, at royalty fees established by the Copyright Royalty Tribunal.

H.R. 2223, 94th Congress, 1st Session (1975).

A Bill for the General Revision of the Copyright Law, Title 17 of the United States Code, and for other purposes. Introduced by



Mr. Kastenmeier, January 28, 1975. In this bill, Title III (Protection of Ornamental Designs of Useful Articles) becomes Title II of the bill. However, the provisions of sections 101, 102, and 106 of the bill were not affected. The provisions of section 113 (scope of exclusive rights in pictorial, graphic, and sculptural works) remain the same as in S. 1361 introduced by Mr. McClellan in the 93d Congress. This is a companion bill to S. 22 introduced by Mr. McClellan in the 94th Congress, 1st Session on January 15, 1975.

H.R. 2223, 94th Congress, 1st Session (1975).

Copyright Hearing: Copyright Law Revision before the Subcommittee on Courts, Civil Liberties and Administration of Justice of the House Judiciary Committee. Hearings were held on the general revision of the copyright law H.R. 2223, May 7, 1975 -- et seq. The Hearings on Design Legislation, Title II of the Bill, were held July 17, 1975.

Mr. Alan Latman, who had served as Counsel to the National Committee for Design Legislation, testified on Title II of H.R. 2223. Mr. Latman summarized the provisions of Title II of H.R. 2223, the "Design Protection Act of 1975," known as "the design bill," pointing out that: (1) An original design can be protected if it is the original creation of its author, an original design being one that has not been copied; it may not meet any test of obviousness or inventiveness as required by the patent law, but it cannot be staple or commonplace nor dictated by function; (2) The original designer is protected only against unauthorized copying of the protected design; (3) Duration is for 5 years with an optional second 5 year term; (4) Protection begins upon public exhibition, sale or offering of an actual article embodying the design -- "making public" of the design; (5) Registration within 6 months after the design is made known. An Administrator is to be designated by the President. There is no requirement of a search or comparison with earlier designs, but a proper party may petition the Administrator for cancellation of registration of a design not subject to protection; (6) Notice or marking: requirements as to form and position are flexible and protection is not forever forfeited if notice is omitted, although omission may limit the design owner's remedies against infringers; (7) Infringement: recovery from anyone who, without authority, purposely makes or imports articles embodying a copy of the protected design, and copyright proprietors cannot recover from sellers, assemblers, processors or innocent parties generally; (8) Remedies: injunction; damages which can be increased to \$1.00



per copy or \$5000, whichever is greater; possible forfeiture or destruction of all infringing articles, plates, molds, etc; recovery of costs and possible attorneys' fees; (9) Interrelation with Design Patent and Copyright: The new design protection does not affect availability of design patents, but protection would terminate as soon as the design patent is issued.

Mr. Latman is in favor of the design bill as embodied in Title II of the Copyright Bill, H.R. 2223, saying that "it seeks to afford moderate protection to original, commercially valuable designs which may, not be considered 'inventions' or 'works of art,' such protection [being] available without undue expense for the smaller manufacturer."

H.R. 2223, 94th Congress, 1st Session (1975).

Hearings: Copyright Revision Bill, Title II -- Design Protection (94th Congress, 1st Sess.). On Thursday, May 8, 1965, the Commerce Department testified before the House Judiciary Subcommittee on Title II, Copyright Revision Bill H.R. 2223. The Commerce Department, in commenting on Title II, recognized that the proposed protection for industrial design was "copyright type" of protection and could logically be passed as part of the omnibus copyright revision. The Department also recognized that there has always been a borderline between copyright and design patent protection, and if Title II were enacted there would be some borderline decisions as to whether a work is entitled to copyright or industrial design protection.

H.R. 2223, 94th Congress, 1st Session (1975).

Hearings May 7 - December 4, 1975. Statement of Barbara Ringer, Register of Copyrights on H.R. 2223, a Bill for General Revision of the Copyright Law. Before the Subcommittee on Courts, Civil Liberties, and Administration of Justice Committee on the Judiciary House of Representatives.

Ms. Ringer stated that she was returning on the fourteenth day of these hearings in response to the letter of the subcommittee of September 9, 1975 "to make the final presentation of testimony reflecting your views with respect to what the hearings reveal and what changes in the bill seem indicated." Ms. Ringer mentioned in this statement that she was preparing a Second Supplementary Report of the Register of Copyrights on General Revision which in its final form will consist of about 15 chapters organized by



subject matter, The draft text of the Supplementary Report was attached to the statement.

Chapter VII of her draft Report, entitled "Works of Art and Designs," considered sections 101, 102 106, 113 of H.R. 2223 as well as Title II, "Protection of Ornamental Designs of Useful Articles."



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The symbols opposite each case indicates the type of protection sought or discussed in the case.

C - Copyright  
U - Unfair competition or other common law relief  
DP - Design patent  
P - Patent  
T - Trademark

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### III. Court Decisions on Designs

#### A. Copyright Cases

##### Alva Studios Inc. v. Winninger

177 F. Supp. 265, 123 U.S.P.Q. 487 (S.D.N.Y. 1959)

Suit for copyright infringement; plaintiff's motion for injunction pendente lite granted.

Plaintiff had created a reproduction of a certain three-dimensional work of art designated as the "Hand of God," which was not an exact replica of the original Rodin by that name, since it had been reduced in size. A certificate of registration of copyright claim in a reproduction of Rodin's sculpture "Hand of God" was issued to plaintiff in 1959, the reproduction being based upon the Rodin sculpture in bronze, owned by the Department of Fine Arts of the Carnegie Institute. Rodin's work had been in the public domain some time prior to plaintiff's copyright.

The court said that plaintiffs' copyrighted work embodied and resulted from its skill in producing an accurate scale reduction of the original. "In a work of sculpture, this reduction requires far more than an abridgement of a written classic; great skill and originality is called for when one seeks to produce a scale reduction of a great work with exactitude."

The court, in addition to sustaining plaintiff's copyright, found that its reproduction of Rodin's "Hand of God" had been infringed by defendant's copy of plaintiff's reproduction, since it had been copied by sandpapering and smoothing down many of the surfaces, a reduction in height, and etching in several features which had been rendered indistinct because of the sanding and smoothing. The court also found, that "unless relief is granted plaintiff until final judgment, it will sustain irreparable harm and damage," and concluded that plaintiff was entitled to injunctive relief.

##### Amplex Mfg. Co. v. A.B.C. Plastic Fabricators, Inc.

184 F. Supp. 285, U.S.P.Q. 648 (E.D. Pa. 1960)

Action for copyright infringement. The plaintiff sought to enjoin defendant from distributing its sales catalog because of alleged infringing matter. Judgment for plaintiff.

Both parties produced component parts for sign makers, and made



plexiglass letters, numbers and figures which are used in various signs "from the huge supermarket sign to the small insert signs in the marquee of a neighborhood theatre." Plaintiff copyrighted a catalog of its products, as did defendant, although it did not copyright it. The letters were known in the lettering business as Egyptian Standard style lettering. Another illustration was similar except that the letters were Condensed Egyptian style.

The court discussed the sole issue: Where a particular work as a composite whole is copyrightable -- the catalog-- must a component part of that work, in order to be protected also be copyrightable? The court responded to this question by saying that the language of the Copyright Act, as well as several cases, would appear to call for an affirmative answer. The court went on to say that although the Egyptian lettering might be but an arrangement of letters which themselves were undoubtedly part of the public domain, the distinguishable variation in the arrangement and manner of presentation --"the dark background, the particular size of the letters, their spacing, their arrangement into three rows"--all combined to give the product independent authorship worthy of protection against copying.

The court added that defendants would be held liable to an injunction, to deliver up for destruction all infringing catalogs, molds, matrices, or other means for making such catalogs, and to pay damages.

Arnold (Ted) Ltd. v. Silvercraft  
259 F. Supp. 733, 151 U.S.P.Q. 286 (S.D.N.Y. 1966)

Action for copyright infringement. Plaintiff's motion for preliminary injunction was granted.

Plaintiff was a manufacturer of gifts and novelties and owned a copyright on a simulation of an antique telephone which it used as a casing for a pencil sharpener. Defendant sold a substantially similar product which it had ordered from a Japanese manufacturer; the details were virtually identical. Defendant interposed two defenses to infringement; one that the copyright notice affixed to plaintiff's product was illegible, the other that the copyright was invalid because it was obtained on a work of utility, not on a work of art.

The court found that the notice was discernible to the unaided eye, although it took scrutiny to locate it and it was in small



type, and held the notice satisfied the statutory requirements; citing Coventry Ware, Inc. v. Reliance Picture Frame Co., 288 F. 2d 193 (2d Cir. 1961); Nimmer on Copyright, section 88 (1964).

As to defendant's contention that this copyrighted article was not a work of art because it was utilitarian and that the casing could not be considered apart from the pencil sharpener, the court referred to the Copyright Regulations (37 C.F.R. section 202.10(c) to support its argument that the telephone casing could be separated physically from the pencil sharpener and could still exist independently as a work of art. The court cited as a case in point, Mazer v. Stein, 347 U.S. 201 (1954).

The court responded to defendant's argument that even the telephone casing by itself was not a work of art, since such a work must embody some creative authorship in its delineation or form (37 C.F.R. section 202.10 (b)), by saying that the telephone casing satisfied this requirement: "It is not a copy of any real telephone. It is a composite creation, the result of library research and sketches of different types of early telephones. It is irrelevant that early telephones were strictly utilitarian. Plaintiff's version was not designed for the same use."

Arrow Novelty Co. v. ENCO National Corp.  
393 F. Supp. 157, (S.D.N.Y. 1974), aff'd without opinion.  
515 F. 2d 504 (2d Cir., April 1, 1975)

Action for copyright infringement of a decorative tray and/or wall hanging, depicting on its surface in raised sculpture form various scenes of New York City in a collage setting. Judgment for plaintiff.

The trays of plaintiff and defendant were identical in color, nearly identical in size, and similar in shape. The lettered caption, "New York City" was positioned in the top center of both trays and the letters were approximately the same size on both. Both trays had raised background clouds of similar appearance and both had a rose in the upper right side. The trays were not identical but strikingly similar according to "visual inspection."

The court found defendant's contention of independent creation not credible; access and substantial similarity established; and infringement.



Charter Fabrics, Inc. v. Hale Fabrics Corp.  
171 U.S.P.Q. 190 (S.D.N.Y. 1971)

Action for copyright infringement of a textile design for which copyright registration had been made in Class H, (reproduction of a work of art). Plaintiff sought a preliminary injunction; its motion was denied.

Defendant opposed on the grounds that it had not copied plaintiff's design; its design was not substantially similar to plaintiff's; plaintiff's design was not original. As explained in part by the court in relation to the facts, plaintiff was a "style-leader" converter selling its products to manufacturers of "better women's apparel." The pattern of the design was structured on a series of parallel large, sharp and bold chevrons of brown and black. The interstices were filled by what can best be described as a maze-like or Chinese key pattern, printed in black in one row and in brown in the succeeding row. Defendant's fabric was also structured on a series of large, bold chevrons printed in two colors, filled with interstitial pattern, printed alternately in the same two colors as those of the chevrons; but the similarity between plaintiff's and defendant's patterns was restricted to those elements.

The court stated that the plaintiff had not established the burden of copying. The court also stated that there did not appear to be the "substantial similarity" between the designs necessary to support the grant of an injunction.

"Important as the common chevron element may be, the interstitial material dominates each fabric and distinguishes each from the other. Even the less important chevron theme is not identically pursued in the respective fabrics, the angles of one differing from the other....The fact that one version of defendant's fabric is printed in black and brown as is plaintiff's fabric...does not overcome the distinction between the fabrics."

The court concluded that, in the light of the considerations expressed, it was unnecessary to make any finding as to whether plaintiff's design was of such originality as to be entitled to copyright protection.

Couleur International Ltd. v. Opulent Fabrics, Inc.  
330 F. Supp. 152, 169 U.S.P.Q. 294 (S.D.N.Y. 1971)

In this action for copyright infringement, plaintiff moved for a preliminary injunction, which was granted by the district court.

Both plaintiff and defendant were converters of uncolored and unpatented textiles, and both claimed that they were "style leaders" producing novel designs and material "in harmony with currently fashionable garment styles." It was not disputed that one of the defendants, (Fanfare) had "used" plaintiff's design to "create" its accused patterns: both plaintiff's and defendant's designs as they appeared on the fabric samples were based upon a repetition of six stripes. There were, according to the court, clear, pervasive and decisive similarities: corresponding stripes were of identical widths and contained only slightly different figures and patterns. One of defendant's samples was printed in colors which were identical to those in one of plaintiff's fabrics.

The court indicated with respect to use of color in the designs, that the appearance in one of defendant's fabrics of colors identical to plaintiff's was additional evidence of actual copying, as well as another factor leading to the conclusion that the aesthetic appeal of the fabrics was the same; and given the essential similarity of the designs, defendant's use, in one of the samples, of a color scheme somewhat different from plaintiff's could not hide the fact that the overall appearance and aesthetic appeal of defendant's fabrics were the same as plaintiff's. The court added that "in any event, in the case before us, there is sufficient basis for a finding that although plaintiff has contracted to sell most of its production of fabric with the copyrighted design, there is substantial danger of a loss of good will and future sales."

Creative Arts, Inc. v. Abady & Sultan, Inc.  
134 U.S.P.Q. 388 (S.D. Fla. 1962)

An action for copyright infringement; judgment for plaintiff, the court granting an injunction and statutory damages.

Plaintiff had created several three-dimensional works of art which portrayed religious scenes, each of, which, as the court



pointed out, was familiar in the field of religion and was in the public domain. Artists on plaintiff's staff had embodied in the works of art, original, three-dimensional interpretations of each of the scenes and plaintiff had published the works of art and received certificates of copyright relating to the classification "works of art," (17 U.S.C. section 5(g)). The defendant had had in his employ a sculptor to whom he had provided copies of plaintiff's work of art, and who had achieved copies, in substantially the same colors, name, slogans and phrases, and used the same trademark registered by plaintiff.

The court held that each of plaintiff's copyrighted works of art were "new versions" of works in the public domain within the meaning of 17 U.S.C. section 7, and were original within the meaning of the copyright law. It also held that the copyrights, as evidenced by the certificates, were good and valid at law (17 U.S.C. section 209) and that defendant's unauthorized copies were substantially similar to plaintiff's copyrighted works.

Deering Milliken Inc. v. Quaker Fabric Corp., (S.D.N.Y. July 10, 1975) summarized in BNA, Bureau of National Affairs Journal, No. 244 (Sept. 11, 1975) A-23.

The court in this [unreported] case refused to grant a preliminary injunction barring infringement of a copyrighted rendition of the design "Tree of Life," since the idea of the familiar "Tree of Life" is in the public domain. The court stated that proof of access would not suffice to prove copying in this case, because the alleged infringer (Milliken) could just as easily have created its design independently from ideas in the public domain. In view of this possibility the court could not find that the copyright owner had "a reasonable probability of succeeding in this action on the merits." In denying the motion for a preliminary injunction the court stated: "Although in a 'well-ploughed field,' such as this, little in the way of distinguishable variation is needed to claim originality and thereby obtain a copyright, correspondingly little is gained from such a copyright."

Drop Dead Co. v. S.C. Johnson & Son, Inc.  
326 F. 2d 87, 139 U.S.P.Q. 465 (9th Cir. 1963), aff'g 210 F. Supp. 816, 135 U.S.P.Q. 292 (S.D. Cal. 1962), cert. denied, 377 U.S. 907 (1964)



An appeal from the District Court for the Southern District of California (J. Yankwich). The action was for copyright and trademark infringement and unfair competition, but it is the copyright aspect that is emphasized. Judgment for plaintiff affirmed.

The plaintiff produces "Johnson's Wax," including a furniture wax named "Pledge;" it registered its trademark and also secured a copyright certificate. Defendant produced a furniture wax known as "Promise".

The appellate court (Circuit Judge Barnes writing the opinion) stated that defendants copied the laudatory and instructional words of Pledge label as well as the design. As to the validity of the plaintiff's copyright, defendants - appellants said that the copyright material was not copyrightable because the language used on the label was textual and "used solely to laud the product and instruct in its use." They asserted that the courts have been uniformly wrong in referring to Justice Holmes' opinion in Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) as establishing a "new and liberal standard." This court, after some discussion of the Bleistein case, and quoting with approval the comment that "no matter how poor artistically the author's addition, it is enough if it be his own," referred to the Copyright Act itself (17 U.S.C. section 5) as contemplating as copyrightable "prints and pictorial illustrations, including prints or labels used for an article of merchandise." The court agreed with plaintiff's assertion, that its label was original and concluded that the "liberal" rather than the "strict" rule of what constitutes copyrightable matter has been followed in the Ninth Circuit, and "this case seems to us clearly one where the same result should follow."

First American Artificial Flowers, Inc. v. Joseph Markovits, Inc.  
342 F. Supp. 178, 175 U.S.P.Q. 201 (S.D.N.Y. 1972)

A suit for copyright infringement in which plaintiff moved for a preliminary injunction. The motion was denied.

Defendant opposed on two grounds: invalidity of plaintiff's copyright - that the rose in question was not created by the skill of the plaintiff but by the Hong Kong Manufacturer - and independent creation of the uncopyrighted accused work. The works involved were artificial flowers, that is, wire and polyethylene plastic sculptured reproductions of tea roses



which sold for about 15 cents each.

The district court, citing several cases, stated that "the copyrightability of 'three-dimensional' works such as these cannot be challenged," but that "the effect of the present availability of this protection to such a wide range of 'works of art' has been to make each case depend more than ever on its own facts." The court was of the opinion that while the copyright did appear valid, plaintiff had not made out a sufficient showing of infringement. As to validity, the court found that defendant had not yet overcome the presumption of authorship from proper filing of the registration application. Another challenge to validity was that subsequent utilization of elements of the protected rose published by plaintiff resulted in abandonment of its copyright on the entire rose. The court, in response, stated that plaintiff's later rose was not uncopyrightable because it included elements of an earlier, copyrighted work and decided that final determination of whether the later rose was actually a "version" of the former rose should safely be left for trial. As to the issue of infringement, the court felt that since there was absolutely no evidence of actual copying, the only possible conclusion must be that plaintiff had failed to carry its burden with respect to proof of infringement.

Fisher-Price Toys v. My-Toy Co.

385 F. Supp. 218, 184 U.S.P.Q. 376 (S.D.N.Y. 1974)

Action by plaintiff for copyright infringement and violation of section 43 of the Lanham Act, 15 U.S.C. Sec. 1125(a).

Plaintiff had obtained copyright registration for four dolls as works of art, and claimed that defendant was selling dolls which infringed its copyrights.

The court found that defendant had not sustained its burden of overcoming the presumption of the validity of plaintiff's copyrights to which the copyright notice and certificates gave rise. In response to defendant's assertion that plaintiff's dolls were not novel, referring to their "soft cuddly bodies; floppy arms and legs; dress; hands; feet and certain facial features", the court explained that "the test of copyrightability, however, is originality, which refers to individuality of expression or independent creation and not to novelty in the subject matter."

As to infringement and the familiar test to be applied, whether an average lay observer would find a substantial similarity between the copyrighted work and the alleged copy, the court said that: "we do not examine the dolls detail by detail, counting those details which, upon close inspection appear similar. Rather, we look to the overall appearance of the dolls." The court permanently enjoined defendant from further infringement and ordered the destruction of any infringing dolls in defendant's possession. Damages as to infringement were to be considered later after appointment of a Special Master. The court did not consider the Lanham Act at this point, saying that the propriety of the other relief sought by plaintiff would be determined in subsequent proceedings.

Florabelle Flowers, Inc. v. Joseph Markowits, Inc.  
296 F. Supp. 304, 160 U.S.P.W. 611 (S.D.N.Y. 1968)

Action for copyright infringement and unfair competition; plaintiff's motion for preliminary injunction was denied.

The article in question was described as an original sculptured work of art, an artificial flower model known as "Flowers in Flower Pot." Two long-lashed "eyes" and a piece that simulates lips provided a "face" for the flower; the stem also contained beneath the flower, two leaves and a bow. The ensemble was described in the complaint as being "wholly original with the plaintiff." Certain Hong Kong manufacturers had been producing and shipping substantially identical objects, not copyrighted, to others.

The court found it most probable that plaintiff's employee had a general idea, "as merchandisers frequently do," that the work was not a revolutionary leap from things long familiar in the trade. As to "originality" the court said that:

"Whoever created it, the flower in issue seems to lack even the 'faint trace' of originality required for a copyright. Dan Kasoff, Inc. v. Novelty Jewelry Co., 309 F. 2d 745, . . . (2d Cir. 1962): Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F. 2d 99, . . . (2d Cir. 1951). . . . There is a strong likelihood that plaintiff cannot show more than the aggregation of well known components to comprise an unoriginal whole -- the result falling short of the easy standard of originality required for a copyright.... The case is not one for a preliminary injunction."



In relation to plaintiff's claim for "unfair competition," based upon the assertion that defendant had used an "advertising sheet" -- simply a photograph -- to mislead its customers and create the impression that the work of art shown thereon was the product of the plaintiff, when in fact it was the inferior product of the defendant, the court stated that the record exposed these assertions as "frivolous," without basis either in fact or in law.

Grossman (Dave) Designs, Inc. v. Bortin  
347 F. Supp. 1150, 174 U.S.P.Q. 217 (N.D. Ill. 1972)

In this case plaintiff sued for copyright and trademark infringement and unfair competition. Defendant moved for summary judgment and the motion was denied.

Plaintiff's attack was against defendant's manufacture of certain statues of children alleged to be copies of statues owned by plaintiff, who alleged: infringement of several copyrights; manufacture and distribution of items in violation of the Lanham Trademark Act, 15 U.S.C. section 1125(a) in that defendant had adopted in its statuary the same types of styles, coloring, packaging and distribution as utilized by plaintiff; and that these actions in adopting such a trade dress violated the Uniform-Deceptive Trade Practices Act of the State of Illinois, Ill. Rev. Stat., ch. 121 1/2, sections 311 et seq. The defendant urged as one of the grounds for summary judgment "originality re invalidity," stating that prior to the first publication of plaintiff's copyrighted statuary, a sculptress, Ann Entis, had authorized several articles to be printed in the magazine "Ceramics Monthly" in which she had explained how to "sculpt" children's faces in a certain style, which style was alleged to contain the dominant features of all her statues of children, and in which there were photographs of children's statuary she had done, but without a copyright notice. Defendant had urged that for this reason the works of the sculptress were in the public domain and also for the reason that the dominant facial features used by her were in the public domain.

The court considered this argument specious; plaintiff did not have a coyright on the "dominant features" utilized by her in her sculpture, but on the specific individual expressions of her motif which appeared in ten different statues. The court cited Puddu v. Buonamici Statuary, Inc., 450 F. 2d 401 (2d Cir. 1971). As to another argument by defendant requesting



summary judgment, that relating to infringement, the court could not determine as a matter of law that the accused statues were not substantially similar to those copyrighted by the plaintiff; and as to plaintiff's Lanham Act claim the court said that it could not be dismissed on its face, and that its claim under the Illinois Deceptive Practices Act stated a claim for which relief could be granted. As to possible confusion as to source of the goods because of similarity of trade dress under those two Acts, the court felt that the evidence at hand was insufficient. Thus, defendant's motion for summary judgment on that ground was also denied.

Key West Hand Print Fabrics, Inc. v. Serbin, Inc.  
244 F. Supp. 287, 147 U.S.P.Q. 138 (S.D. Fla. 1965)

Action brought by plaintiff for copyright infringement of fabric designs, and unfair competition under Title 28, U.S.C. sec. 1338(b). Judgment in part for plaintiff for copyright infringement and for defendant in regard to unfair competition.

As to the techniques of plaintiff's designs, they were created by an artist drawing a pen and ink rendering of a part of a design, and ultimately transferring it by a photographic and chemical process to silk screens held in large wooden frames and used to print the cloth. Each frame contained a complete repeat of the design and each repeat had a copyright notice.

The court stated that "when...composite designs were hand printed on the fabric, they were sufficiently original in creation and arrangement for copyright protection within the purview of Title 17 U.S.C., Sec. 7"; and "the placing of the copyright on the selvage had been repeatedly approved. Peter Pan Fabrics, Inc. v. Martin Weiner Corp. 274 F. 2d 487 (2d Cir. 1960)." It was also explained by the court that showing the original drawing of the design of a work which was ultimately copyrighted to a prospective customer, was not a publication and a notice was not required. As to defendant's reference to the court's proficiency in buying women's dresses, since it had refused to permit experts to lend their advice, the court's comment was, that "the test is that of an ordinary observer, not an expert." The court added that the differences between the designs were purely incidental; that there had been infringement. As to plaintiff's claim for unfair competition, the court held that there had been no showing that defendant



had "palmed off" its dresses as the product of plaintiff or misrepresented to the public that it manufactured plaintiff's fabrics which were sold to its customer, Lilly Pulitzer, for dresses. On the contrary, each dress had a Serbin tag sewed into the garment, a hand tag affixed indicating manufacture by Serbin and on the Serbin hanger.

Klauber Brothers, Inc. v. Lady Marlene Brassiere Corp.  
285 F. Supp. 806, 157 U.S.P.Q. 338 (S.D.N.Y. (1968))

Suit by plaintiff was for both copyright and patent infringement. Plaintiff's motion for preliminary injunction was denied.

Plaintiff, a converter of laces, claimed infringement of three copyrighted designs by defendants and, in addition, infringement of a design patent by defendant Acme Laces. It appeared that "until recently" defendant Marlene, a customer of Acme, was a valued customer of plaintiff, and that Acme, like plaintiff was a converter of laces dealing with lower priced merchandise. Defendant Marlene was a long established manufacturer of foundation garments, including brassieres, corselettes and girdles. The laces in this suit were incorporated in these garments and illustrated in Marlene's catalogs, and at least two of them were similar in appearance to certain of the laces previously purchased from plaintiff by Marlene.

In summarizing the issues, Judge Palmieri stated that there were factual issues that needed thorough explanation only by the trial court, and it followed that plaintiff had not demonstrated the clear showing of probable success upon the trial which the grant of requested relief required. Judge Palmieri went on to say:

"Other considerations also militate against the plaintiff's position on this motion. Lace designs, unlike some of the cloth or textile fabric designs used only for one season, appear to have more stable marketability and are not so hurriedly swept away from the market by sudden changes of taste and style. Lace designs appear to have a longer commercial life. The plaintiff does not therefore appear before the Court as a litigant faced with the risk of forfeiting his rights through delay in the resolution of his lawsuit."



The court further remarked that it appeared that damages would be an adequate remedy in the event plaintiff recovered, and that defendants were able to respond to a judgment for money damages.

NOTE: The comment of Judge Palmieri quoted above is also repeated in a later case involving lace designs and the possibility of "irreparable injury": Irving J. Dorfman Co. Inc. v. Borlan Industries Inc., 309 F. Supp. 21 (S.D.N.Y. 1969). In that case the chief contention by defendant was that copyright notice was not affixed pursuant to 17 U.S.C. Sec. 10, a sufficient reason under the facts for denying the severe remedy of a preliminary injunction. Another comment in that case was that "it is now settled that a textile design is a proper subject for copyright protection," thereby of course classifying laces as textiles, which are somewhat differentiated by Judge Palmieri in the instant Klauber case, at least in reference to the more stable marketability of laces vis-a-vis textiles or "cloth" fabrics.

Klauber Bros. Inc. v. Westchester Lace Works Inc.  
181 U.S.P.Q. 523 (S.D.N.Y. 1974)

This suit involved copyright infringement of six different designs in lace, all copyrighted by plaintiffs and alleged by defendant to be invalid and not infringed. Plaintiffs had moved for a preliminary injunction to enjoin infringement which was denied.

Plaintiffs were converters of lace prepared and produced for sale to the garment trade. Raval with Klauber, also a plaintiff, had registered one of the designs on behalf of Scanlace of Denmark pursuant to a license agreement. Raval had been publishing the Scanlace design since September 1972 with a copyright notice indicating Raval as the copyright proprietor.

The court remarked that "this it had no right to do as a mere licensee." The court then explained that again, defendant had attacked the validity of plaintiffs' copyrights, this with respect to failure to put copyright notices on their laces (17 U.S.C. Sec. 10); when they did so it was only at the beginning of each spool containing from 100 to 500 yards of lace, the notice consisting of two gummed labels affixed to the lace back to back. The court referred to another factor, that the plaintiffs sell their copyrighted laces to jobbers who insist



that all markings indicating the source of the lace be removed so that those to whom they sell will not be able to go directly to the lace converter. "If plaintiffs had done this here," said the court, "they will not prevail at trial." Finally, the court, although holding that the motion for preliminary injunction must be denied, commented:

"It appears that an average lay observer could find a substantial similarity in the designs, recognizing the copy as an appropriation of the copyrighted work. Therefore, were it not for the substantial questions raised by defendant as to plaintiffs' ability to prevail at a trial on the merits, an injunction might well issue here."

Kuddle Toy, Inc. v. Pussycat-Toy Co.  
183 U.S.P.Q. 642 (E.D.N.Y. 1974)

Action for copyright infringement in which defendant counter-claimed for declaratory judgment of copyright invalidity and noninfringement, for violation of 15 U.S.C. 1125(a) and for unfair competition. Plaintiff sought an injunction and dismissal of counter claims. The motion for injunction was denied, the motion to dismiss counter-claims granted.

Plaintiff had sued for infringement of its copyright as a work of art on a fully jointed "Teddy Bear," published in 1968.

As the court said, neither party could claim authorship in the bears it sold; both were distributors of Japanese bears of indeterminate manufacture. To show copying by or on behalf of defendant, much emphasis was placed on what could be called "pattern evidence" to show that defendant's bears were derived from patterns identical with patterns from which plaintiff's bears were made. But the court replied to this "pattern comparison," that although it produced some evidence that the bears came from a common source, the patterns did not explain their own authorship nor did they explain whether they are common to many bears that were arguably "like" one another. The court felt that the dominant and identifying characteristics of all the bears in question were those that they shared with countless toy bears of tradition, nothing here being shown in component and in aggregate to represent copyrightable material owning its authorship to either plaintiff, rather than to custom and tradition.



As to defendant's counterclaim based on 15 U.S.C. Sec. 1125 (Trademark Act), which gives a civil action to anyone who believes he is likely to be damaged by any false description or representation affixed to or used in connection with any goods which the falsifier causes to enter commerce, the court said that there was no allegation by defendant nor any evidence of any damaging reliance.

L & L White Metal Casting Corp. v. Joseph  
387 F. Supp. 1349, 185 U.S.P.Q. 269 (E.D.N.Y. 1975)

An action for copyright infringement and unfair competition in which plaintiff claimed that eleven of defendant's metal castings and twenty-four photographs of the plaintiff's products appearing in defendant's trade catalog infringed plaintiff's copyright, and that defendant had used the photographs of plaintiff's product in violation of 15 U.S.C., Sec. 1125 for the purpose of selling defendant's products.

An injunction was granted, statutory damages for infringement, but claim of unfair competition denied.

Plaintiff designed, manufactured and sold metal castings used in the manufacture of lamps and lighting fixtures.

The court found that as to two of the castings in issue the changes in design made by defendant were substantial enough that an average observer would not conclude that defendant's products were copied from plaintiff's castings; but as to a third mentioned, despite defendant's attempts at alteration of the design, the court concluded that the latter's casting was substantially similar to plaintiff's, the court emphasizing that "in fact, the large central fleur-de-lis of plaintiff's casting has been retained without change."

As to the issue of defendant's copying photographs contained in plaintiff's original catalog and the supplements, and defendant's challenge to the validity of these copyrights on the ground of defective notice of copyright, in that initials were used in violation of 17 U.S.C. Sec. 19 and that the notice did not appear on the title page as required by Sec. 20: the court decided that the notice provisions had been fulfilled so that plaintiff was protected by the copyrights on its supplements.

With respect to plaintiff's claim of unfair competition in violation of 15 U.S.C. Sec. 1125(a) by reason of defendant's use of photographs of plaintiff's castings, the court explained that there was no evidence that the castings depicted were



generally recognized in the trade as plaintiff's castings, or that the fact that some of the castings depicted in the photographs were copyrighted established a general association of the castings with the plaintiff in the minds of consumers.

Lauratex Textile Corp. v. Citation Fabrics Corp.  
328 F. Supp. 554, 171 U.S.P.Q. 42 (S.D.N.Y. (1971))

An action for copyright infringement, plaintiff seeking a preliminary injunction which was denied.

Plaintiff and defendant were both in the business of converting textiles. Plaintiff published a design ("Intrigue Pattern") which, as it was admitted, was a near copy of a design originated by "Gucci," a widely known Italian style originator and manufacturer of women's garments. It was also admitted that the Gucci design is in the public domain, but plaintiff claimed to have added new features to the Gucci design including a new lay-out, a double border, and new color combinations. Defendant was offered a similar fabric for sale at a lower price; plaintiff brought suit, and defendant responded that its own design was also based on the Gucci pattern. Defendant challenged the validity of plaintiff's copyright and in the alternative argued that plaintiff's copyright covered only so much of the "Intrigue Pattern" as was added to the Gucci pattern, and that its own variations differed sufficiently from plaintiff's so as to be harmonious with plaintiff's copyright rights.

The court apparently agreed: Thus, plaintiff was entitled to copyright protection for what it had added to the work but its protection was limited to those additions. The court continued: "And, if plaintiff can get a valid copyright by making a few minor variations, then defendant too can get a valid copyright by making a few more variations on the pattern."

Letter Edged in Black Press Inc. v. Public Bldg. Comm'n of Chicago  
320 F. Supp. 1303, 168 U.S.P.Q. 559 (N.D. Ill. 1970)

This was an action by the Letter Edged in Black Press against the Public Building Commission of Chicago for declaratory judgment invalidating copyright. Plaintiff's motion for summary judgment was granted.



The work involved was Pablo Picasso's sculpture entitled "The Chicago Picasso." Plaintiff was a publisher who wished to market a copy of the sculpture, and maintained that the defendant Commission's copyright was invalid because the sculpture was in the public domain, a fact denied by defendant. The facts explained in the opinion of the court were that in 1963 certain civic center architects, representing the Commission, asked Picasso to design a monumental sculpture for the plaza in front of the proposed Chicago Civic Center. By May 1965 Picasso had completed the maquette (model) of the sculpture. An aluminum model of the design with slight revisions was prepared as a guide to the construction of the model. Refusing to accept any payment for his work, Picasso on August 21, 1966 signed a "Deed of Gift," in which he gave his (finished) work and the right to reproduce it to the Public Building Commission, and the maquette to the Art Institute, "desiring that these gifts, shall through them belong to the people of Chicago."

The maquette, as well as a 12-foot wooden model, were placed on public exhibition without copyright notice by the Art Institute and the United States Steel Corporation respectively in 1966, and the maquette by the Tate Gallery in London, also without notice. Pictures of the Picasso design appeared without notice in well-known magazines, catalogs, booklets and postcards. All these acts took place before the dedication, on August 15, 1967 at the Chicago Civic Center Plaza, of the monumental sculpture, which bore a notice of copyright in the name of the Commission, with a 1967 year date. The notice had been affixed to the structure on August 4, 1967. On January 2, 1968 the Commission finally filed its application with the Copyright Office asking a copyright in the monumental sculpture and a certificate was issued. The defendant argued that attaching notice and the later registration were sufficient to obtain statutory copyright.

As the court pointed out, the copyright would not be valid if the Chicago Picasso was in the public domain prior to August 4, 1967. The court discussed the law applicable to the facts including the doctrine that common law copyright is terminated upon first publication, stating that the court was persuaded that the copyright to the work of art known as the "Chicago Picasso" is invalid, since publication occurred without the requisite notice; accordingly the common law protection was lost upon protection and the work was thrust into the public domain. The court also expressed the view that "the broadest



and most uninhibited reproduction and copying of a provocative piece of public sculpture can only have the end result of benefiting society."

Loomskill, Inc. v. Puritan Dress Co.

134 U.S.P.Q. 20 (S.D.N.Y. 1962)

A suit for copyright infringement. Plaintiff's motion for a preliminary injunction was granted. Plaintiff was owner of the copyrights of two reproductions of a work of art covering designs on textile fabrics and defendant had copied them by manufacturing and selling garments made from textiles bearing a reproduction of the designs for which plaintiff had secured copyrights.

The court, in granting a preliminary injunction said:

"Plaintiff's business is that of selling a so-called style-leader line for customers willing to pay for distinctive patterns, and the offering of the same patterns in garments at lower and therefore at more popular prices than similar garments made by plaintiff's customers from plaintiff's copyrighted reproductions, robs plaintiff's copyrighted goods of their distinctive appeal. The life of a design is a short one, and unless a preliminary injunction is issued, plaintiff will suffer substantial and irreparable injury from defendant's competition during a significant part of the period during which the designs will have value."

The court also stated that the term "work of art" used in section 5(h) of the Copyright Act (17 U.S.C.) included an "applied design."

Monogram Models Inc. v. Industro Motive Corp.

492 F. 2d 1281, 181 U.S.P.Q. 425 (6th Cir. 1974). See also 448 F. 2d 284, 171 U.S.P.Q. 266 (6th Cir. 1971).

This was an action for copyright infringement. From judgment for plaintiff, defendants appealed; the court affirmed.

The work involved was a copyrighted scale model airplane kit, "Thunderchief," registered in the Copyright Office under Class G (works of art). The District Court had granted plaintiff's



motion for summary judgment. On the first appeal, this court had held that the plastic scale model airplane kits were proper subject for copyright protection, but reversed as to summary judgment, remanding for trial of certain factual disputes. On remand the District Court held that the copyright was effective as to the plastic scale model parts, the container boxes and the instruction sheets for each of plaintiff's kits; also the the copyrights on the two kits were properly protected by the copyright notices that appeared on the container boxes and instruction sheets of each kit. (It also appeared that there was a notice on the inside of one wing part.)

This appellate court affirmed, repeating, in response to one of defendant's contentions, what had been held in the earlier appeal in this action that Congress has the power to provide for copyrights on things not strictly termed "author's writing," and that the term should be given a broad construction. 448 F. 2d 284 at 287.....The court indicated also that it had further held that "it is neither the assembled plane, as a structure, nor the individual pieces of the unassembled plane, that are the proper subject for copyright protection. It is the scale model airplane kit, as a kit, that is copyrightable."

Mura v. Columbia Broadcasting System, Inc.  
245 F. Supp. 587, 147 U.S.P.Q. 38 (S.D.N.Y. 1965)

An action for coyright infringement; judgment was for defend-  
ants.

The copyright in question covered three hand puppets in the form of a mouse, a pig and a rooster, which had been displayed by defendant (CBS) on its "Captain Kangaroo Show." All of the puppets bore a notice of copyright. Any use of plaintiff's puppets on the Captain Kangaroo program was only to portray music in an incidental manner or tell a story within the program; moreover, the electronic image produced in live television broadcasting, such as that concerned here, is not permanent. The court said that it was clear that defendants had not manufactured, sold or even used an article simulating any one of the plaintiff's copyrighted puppets -- rather, the defendants used genuine puppets in a television show, which plaintiff claimed to be an infringement of her copyright. As the court put it, the specific question was whether that use of the puppets consituted a copying; certainly no three dimensional objects were reproduced. The court arrived at the conclusion



that:

"The evanescent reproduction of a hand puppet on a television screen or on the projected kinescope recording of it is so different in nature from the copyrighted hand puppet that I conclude it is not a copy. I find no violation of plaintiff's copyright here under the circumstances of this case. There was no copying of the copyrighted puppets. Nevertheless, even if we were to assume that the projection on television of the hand puppets was an infringement, the defense of fair use is applicable."

Pantone, Inc. v. A.I. Friedman, Inc.  
294 F. Supp. 565, 160 U.S.P.Q. 530 (S.D.N.Y. 1968)

Action for copyright infringement and unfair competition in violation of the United States Trademark Act, 15 U.S.C. § 1125 (a). Plaintiff's motion for preliminary injunction was granted.

Plaintiff had published in 1963 a booklet called "The Pantone Matching System," the result of plaintiff's efforts in the color matching field; it consisted of 72 pages each bearing a series of bands of carefully selected colors which were arranged in a fashion or plan designed, through variation of certain basic colors, to provide an extensive range of selection derived from use of eight basic colors plus black and transparent white.

The court pointed out there was nothing novel or original about the concept or use of publications designed for selection or matching of colors, explaining further:

"After careful examination of plaintiff's mode of expression, combination and arrangement of colors in its booklet...and comparison with pre-existing color charts and exhibits shown to the Court, plaintiff's booklet appears to possess sufficient originality and uniqueness in its embodiment of its mode of expression to qualify it for copyrightability. Although the mere portrayal of a series of gradations of color shades, standing alone, would present a doubtful case for copyright protection, the arrangement here possessed the



already described unique quality which apparently gained ready recognition on the part of artists in a critical profession...."

The court found that an overall comparison of plaintiff's publication with that of the defendant constituted a substantial copying of the essential features of plaintiff's arrangement.

As to violation by defendant of the U.S. Trademark Act, 15 U.S.C. section 1125(a), which forbids use of false designations or representations in connection with goods or services, the court said that defendant's distribution of its offending sheet and leaflet violated the statute: "An artist, designer, ink manufacturer or innocent purchaser of color sheets, could be misled by the defendant's works into believing that the two color systems were substantially the same."

Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.  
295 F. Supp. 1366, 161 U.S.P.Q. 119 (S.D.N.Y.), aff'd per curiam,  
415 F. 2d 1007, 163 U.S.P.Q. 670 (2d Cir. 1969)

Action for copyright infringement of plaintiffs' design, "Daisies." Plaintiffs moved for summary judgment to enjoin defendant from further infringing their copyright, destruction of the accused fabric, and damages. Defendant cross-moved for summary judgment dismissing the complaint on the ground that plaintiffs' copyright was invalid.

Plaintiffs had purchased the "Daisies" design from Rampelberg Designs; it had not been copyrighted. Defendant argued that this sale placed the design in the public domain, and that plaintiffs had added nothing to the design.

The court stated that defendant was wrong on two critical factors: The sale of the design by the designer to plaintiffs in confidence did not put the work in the public domain, and plaintiffs did add something original to the work of art. The court stated further that "the testimony [however] shows that the design as purchased had be embellished and expanded before it could be engraved on the rollers. This slight addition is a very modest grade of originality. Nonetheless, it is sufficient." As to copying of plaintiffs' design by defendant, the court held that the similarities were so obvious that there could be no genuine issue of fact that defendant's design was copied from plaintiffs', and that the similarities were so great that an ordinary observer would easily detect them.



Peter Pan Fabrics, Inc. v. Martin Weiner Corp.  
274 F. 2d 487, 124 U.S.P.Q. 154 (2d Cir. 1960), aff'g  
Peter Pan Fabrics, Inc. v. Acadia Co., 173 F. Supp. 292, 121  
U.S.P.Q. 81 (S.D.N.Y. 1959)

An action for copyright infringement. From an order granting plaintiffs' motion for preliminary injunction, defendant appealed. Affirmed, Judge Friendly dissenting.

Both parties were "converters" of textiles used in the manufacture of women's dresses. The plaintiffs had bought from a Parisian designer a design know as "Byzantium" which it registered in the Copyright Office as a "reproduction of a work of art." They printed the design upon uncolored cloth sold in bolts to dressmakers. The cloth bore upon its edge at each repetition of the design printed notices of copyright, but the buyers cut the cloth to make dresses and in doing so either cut off the selvage bearing the notice or sewed the edges together at the seams so that the notices were not visible. The appeal raised two questions: (1) infringement and (2) possible dedication to the public because it was sold without adequate notice as required by 17 U.S.C. section 10.

The court, in answer to the first question, said that "in the case at bar we must try to estimate how far its overall appearance will determine its aesthetic appeal when the cloth is made into a garment...however, the ordinary observer, unless he sets out to detect the disparities, would be disposed to overlook them, and regard the aesthetic appeal [of both designs] as the same."

As to the second question the court stated:

"...we do not hold that in no circumstances will it be possible to 'affix notice' upon a 'design' which will be still visible when the cloth has been made up into a garment. We do hold that at least in the case of a deliberate copyist, as in the case at bar, the absence of 'notice' is a defense that the copyist must prove, and that the burden is on him to show that 'notice' could have been embodied in the design without impairing its market value. The defendant asserts that this can be done but it has offered no evidence that it can be. Whatever may be shown at the trial, upon this record we hold that the 'design' should be protected, pendente lite."



PPS, Inc. v. Jewelry Sales Representatives, Inc.  
392 F. Supp. 375, 185 U.S.P.Q. 374 (S.D.N.Y. 1975)

Suit for copyright and trademark infringement and unfair competition, plaintiff seeking a preliminary injunction and defendant seeking to dismiss the action or transfer it to another district. Plaintiff's motion was granted in part, defendant's was denied.

Plaintiff's claims related to a line of "X Like You" products manufactured and sold by its licensee; the products included costume jewelry in the shape of an apple bearing the mark "I Like You", and other products containing the apple and the "I Like You" design; and plaintiff alleged that defendant had engaged and intended to engage in the manufacture and sale of a line of costume jewelry copied from its "I Like You Line." The defendant claimed that the copyrights were invalid because plaintiff's design lacked creativity, but as the court pointed out in response to that claim, the required level of creativity is minimal. However, the court stressed that plaintiff was entitled to the injunction only if defendant had appropriated those characteristics of plaintiff's design that are entitled to copyright protection, and that copyright protects only the expressions of an idea, not the idea itself; in determining whether one expression of an idea is a copy of another, the test had been stated generally to be "whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work." With respect to the trademark and unfair competition claims, the plaintiff asserting use of its unique dress of goods, and palming off, the court stated that "a potential buyer of one of plaintiff's or defendant's items may be more motivated by the item's design and aesthetic features than by its source. And if this is so, those aesthetic features would be functional elements and could therefore be appropriated." Plaintiff's showing in this regard was held insufficient to warrant preliminary injunctive relief.

Primcot Fabrics v. Kleinfab Corp.  
368 F. Supp. 482, U.S.P.Q. 443 (S.D.N.Y. 1974)

An action for copyright infringement. Plaintiff's motion for a preliminary injunction was granted.

The plaintiff sought a preliminary injunction to restrain



defendant from printing and selling copies of a printed textile fabric in several colors known as "Romeo," which the district court judge described as a "design copyright," for which a certificate of copyright registration No. H 51204 was owned by the plaintiff. The print was a patch plaid design composed of eight squares with so-called "calico colors," and defendant's print, according to the court, gave the impression of being plaintiff's print.

The district court judge, Judge Gurfein, after listening to various witnesses, concluded that he was compelled to find that the almost identical color scheme applied in similar hue to the same design squares, plus the existence of an additional design square on both exhibits made a strong case for finding of copying.

As to the validity of plaintiff's copyright, the court held that the arrangement of known designs in a pleasing pattern with a particular juxta-position of colors may be deemed "the reproduction[s] of a work of art," Section 5(h) of the Copyright Act, 17 U.S.C. Sec. 5. The court also held that defendant had infringed the copyright.

Rosenthal (Herbert) Jewelry Corp. v. Honora Jewelry Co.  
509 F. 2d 64, 184 U.S.P.Q. 264 (2d Cir.), aff'g 378 F. Supp. 485,  
183 U.S.P.Q. 97 (S.D.N.Y. 1974)

As explained by the court in a Per Curiam decision, the sole issue on this appeal was whether plaintiff-appellant's copyright of a design for a gold jeweled pin in the shape of a turtle was infringed by a similar-appearing pin made and sold by defendants. The court agreed with the district court's holding that it was not infringed and affirmed its order granting summary judgment dismissing the complaint, which sought damages, an accounting, injunctive and other relief, Herbert Rosenthal Jewelry Corp. v. Honora Jewelry Co. 183 USPQ 97 (S.D.N.Y. 1974).

After comparison of the two pins, which contained numerous differences but both conformed generally to the shape of a turtle, the court pointed to the threshold question: what characteristics of appellant's design have gained protection. The court commented that "since all turtles are created more or less along the same lines, appellant cannot, by obtaining a copyright upon one design of a turtle pin, exclude all others from manufacturing gold turtle pins on the ground that they are substantially similar in appearance." The court quoted from



Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F. 2d 738 742, 170 USPQ 557 (9th Cir. 1971), a case involving a claimed infringement of a jeweled bee pin produced by these same defendants:

"We think the production of jeweled bee pins is a larger preserve than Congress intended to be set aside in the public market without a patent. A jeweled bee pin is therefore an 'idea' that defendants were free to copy."

Rosenthal (Herbert) Jewelry Corp. v. Kalpakian  
446 F 2d 738, 170 U.S.P.Q. 557 (9th Cir. 1971)

This action was for copyright infringement. Plaintiff moved for an order to hold defendants in contempt of a consent decree, and it was denied. Plaintiff appealed; affirmed.

Plaintiff had charged defendants with infringing plaintiff's registration of a pin in the shape of a bee made of gold and encrusted with jewels. A consent decree had provided that plaintiff's copyright of the jeweled bee was "good and valid in law," that defendants had made a jeweled bee alleged to be similar, and that defendants were enjoined from manufacturing or selling copies of plaintiff's jeweled pin. After filing of plaintiff's motion to hold defendants in contempt on the consent decree, the district court, as a result of a hearing, found that defendants had designed their pins themselves "after a study of bees in nature" and in published works, but had not copied plaintiff's copyrighted bee. The district court also found that the jeweled bees were "not substantially similar," except that both "do look like bees." The district court concluded that defendants had not infringed plaintiff's copyright, and had not violated the consent decree, and entered a judgment order denying plaintiff's motion.

The appellate court agreed, expressly saving the question whether defendants were bound by their concession of the validity of plaintiff's consent decree. As this court explained, plaintiff contended that its copyright registration of a jeweled bee entitled it to protection from the manufacture and sale by others of any object that to the ordinary observer was substantially similar in appearance. The court, commenting that "the breadth of that claim was evident," said: "If plaintiff's understanding of its rights



were correct, its copyright would effectively prevent others from engaging in the business of manufacturing and selling bees. We think plaintiff confuses the balance Congress struck between protection and competition under the Patent Act and the Copyright Act."

Roth Greeting Cards v. United Card Co.  
429 F. 2d 1106, 166 U.S.P.Q. 291 (9th Cir. 1970)

Action for copyright infringement. From judgment for defendant, plaintiff appeals. Reversed, Judge Kilkenney dissenting.

Both plaintiff and defendant were in the greeting card business. Roth's claim involved the production and distribution by defendant of seven cards which bore a "remarkable resemblance" to seven of Roth's cards on which copyrights had been granted. On the merits, the trial court had found that the art work on Roth's cards was copyrightable but not infringed, and that, although copied by defendant, the textual matter or wording on plaintiff's cards consisted of common and ordinary English words and phrases in the public domain. Roth contended that this did not end inquiry into the copyrightability of the entire card. The appellate court stated on this latter point that it concluded that "each of Roth's cards, considered as a whole, represent a tangible expression of an idea and that such expression was, in totality, created by Roth."

As to infringement, the court said that in total concept and feel the cards of defendant were the same as the copyrighted cards of Roth; the characters depicted in the art work, and in several instances the lettering were also very similar. The court referred in its opinion to the fact that greeting cards are protected under the Copyright Act under 17 U.S.C. Sec. 5(a) or (k) as a book or as a print as proper subjects of copyright and susceptible to infringement in violation of the Act, Detective Comics, Inc. v. Bruns Publications, Inc., 111 F. 2d 432 (2d Cir. 1940).

Royalty Designs, Inc. v. Thrifticheck Service Corp.  
204 F. Supp. 702, 133 U.S.P.Q. 148 (S.D.N.Y. 1962)

Action for copyright infringement. Plaintiff's motion for preliminary injunction was granted.

Plaintiff owned two copyright registrations for plastic molded toy coin banks in the shape of dogs, one a Boxer, the other a Cocker Spaniel. The copyright notice was stamped on a metal



plug which fitted securely into an opening on the bottom of the banks. Apart from certain insignificant differences, the only other difference was in the finish used by defendant: plaintiff's dogs were coated with a tan colored substance which resembled dog hair, whereas defendant's dogs were bare plastic but painted or tinted a tannish color.

The court, after pointing out that in every important respect defendant's banks were a direct verisimilitude of plaintiff's designs, and that the variations in the finish, nose and eyes and any slight differences in size were all totally insignificant, said:

"There is no doubt that copyright protection extends to Royalty's designs as productions of originality and novelty. See Royalty v. Vitale [218 F. 2d 434 (2d Cir. 1955)]. Royalty does not claim rights to all toy banks in the form of Boxer and Cocker Spaniel dogs. Its copyrights are for the particular novel and original renditions created and designed by it, which are legitimate subjects of copyright registration. Royalty by its treatment of the subjects has contributed something recognizably its own which is by no means trivial."

Defendant had raised the question that the copyrights were invalid because the notice of copyright had not been properly affixed to the product. The court replied that though the discs themselves were not copyrighted they were an integral part of the banks; they were firmly attached and each was an essential part of the bank, and without it the product would not serve its purpose.

The court found the copyrights for its Boxer and Cocker Spaniel dog toy banks were valid and that plaintiff had made out a prima facie case of infringement.

Samet & Wells, Inc. v. Shalom Toy Co.  
185 U.S.P.Q. 36 (E.D.N.Y. 1975)

Suit for copyright infringement. Plaintiff's motion for preliminary injunction was granted.

At the beginning of the litigation the court had issued a temporary restraining order against defendant's selling stuffed turtles with the same fabric as plaintiff's turtle, but did



not restrain the sale of other turtles which plaintiff had claimed also infringed. Plaintiff's turtle had a predominantly yellow background with a Tam-O-Shanter hat, a curled up tail and a fabric on the back made of pastel print divided into squares with distinctive patterns. One of Shalom's turtles was almost exactly like plaintiff's including the pattern of the fabric, with only a slight difference in the hat. This was the design which was the subject of the restraining order. As the court explained, Shalom's other turtles had different fabric and hat, and the court had examined defendant's earlier turtle designs and found that they were all distinctively different from both plaintiff's and defendant's turtles; however, "to a layman it would appear that plaintiff's turtles and defendant's turtles come from a common source."

In this case, however, the court found that even in the light of the prior art made known here, the differences between plaintiff's copyrighted versions and defendant's versions were not sufficiently significant to make the average layman believe that the turtles came from different manufacturers. The court concluded: "Defendant may not be a conscious infringer, but that is a factor to be considered in connection with the issue of damages and attorney fees, not a reason for denying a preliminary injunction."

Scarves by Vera, Inc. v. Fabrex Corp.  
129 U.S.P.Q. 395 (S.D.N.Y. 1961)

Suit was brought for copyright infringement and plaintiff's motion for preliminary injunction was granted.

Vera is a large manufacturer of ladies' scarves, a leader in the field. The copyrighted design in issue was a silk screen print, here referred to as "Vera's Vegetable Design," which was registered as a "work of art" by the Copyright Office. Defendant, in collaboration with an art studio, was responsible for the production of a design from a common garden vegetable theme. This design was registered with the Design Registration Bureau, whereupon defendant started selling piece goods containing the design. Defendant did not contest the validity of the copyright but contended that Vera had failed to comply with the statutory copyright notice requirements of Section 19, 17 U.S.C. Vera used two copyright notices, one printed on the scarves, the other upon a woven label sewn to the fabric. The notice on the fabric consisted of the name "Vera" with the symbol ©; that on the label consisted of the same



notice with the name "Scarves by Vera."

The court held that Vera's copyright notices constituted good and sufficient notice to the public; no innocent person could have been misled, and the notices disclosed the identity of the proprietor. Scarves by Vera, Inc. v. United Merchants and Manufacturers, Inc., 173 F. Supp. 625 (S.D.N.Y. 1959).

It had been argued by defendant that the only similarity between its design and that of plaintiff, if any, was in the vegetable silhouettes or shapes, which is inevitable if any vegetable outline of this type is to be used; in fact the court found that Vera's vegetable design was sufficiently original to warrant copyright protection and that the charge of copying could not convincingly be denied. As to registration with the Design Registration Bureau, the court said that "the Bureau cannot be permitted to preempt the jurisdiction, powers and functions of this court."

The court held that Vera had not only made out a prima facie showing of ownership and validity of her copyright as well as infringement by defendant, but also that Vera was entitled to a preliminary injunction.

Scherr v. Universal Match Corp.

417 F. 2d 497, 164 U.S.P.Q. 225 (2d Cir. 1969), aff'g 297 Supp. 107, 160 U.S.P.Q. 225 (S.D.N.Y. 1967), cert. denied, 397 U.S. 936 (1970)

This action involved copyright infringement; from summary judgment for defendants, (one of which was the United States) plaintiffs appealed. Affirmed, with dissent by Judge Friendly.

Two ex-service men brought suit against defendants as a result of their manufacture and sale of match books bearing a picture of a statue entitled "The Ultimate Weapon," created by plaintiffs while they were in military service. Their claim to infringement rested upon a statue, 25 feet high consisting of a 12 foot figure of a charging infantryman in full battle dress standing upon a pile of rocks about 3 feet high which, in turn, was set upon a 12 foot base. On the base were two plaques, with inscriptions, but neither plaque bore any copyright notice. The plaintiffs had, however, before the unveiling, placed a notice where it would not be readily seen--about twenty-two feet above the ground. Plaintiffs registered a copyright in the "Ultimate Weapon." Defendants raised three defenses: that the statue was a publication of the United States Government within the meaning of 17 U.S.C. section 8



and therefore not copyrightable; that the notice of copyright was inadequate; that all copyright interest belonged to the U.S. Government because the statue was constructed during the course of employment by the U.S. Army, (17 U.S.C. section 26).

The appellate court held:

"We agree that if any coyright interest exists, it is the exclusive property of the United States Govern-ment, and on this basis we affirm the judgment below, accordingly we do not have to decide whether the district court was correct in ruling that the statue was not a 'Government publication' and that the notice of copyright was inadequate."

In differentiating this case from the Rickover case, (Public Affairs, Inc. v. Rickover, 284 F. 2d 262, vacated on other grounds, 369 U.S. 111, on remand 268 F. Supp. 444) which involved a project undertaken at almost complete government expense during regular duty hours, the court said that plaintiffs here were not required to engage in the work they did in order to fulfill their military obligations; they did so voluntarily. "We must conclude that the Government did not violate any right of the plaintiffs when it agreed that defendant Universal could depict 'The Ultimate Weapon' upon its match book covers."

Soptra Fabrics Corp. v. Stafford Knitting Mills, Inc.  
490 F. 2d 1092, 180 U.S.P.Q. 545 (2d Cir. 1974), rev'g 365 F. Supp. 1199, 180 U.S.P.Q. 362 (S.D.N.Y. 1973)

Suit was brought by plaintiff Soptra for copyright infringement. The district court rendered judgment for defendant, from which plaintiff appealed. The appellate court, per curiam, reversed. district court judge, Judge Duffy, had found no infringement and did not reach the question of validity. The appellate court disagreed, found infringement as a matter of law, determined the copyright valid, and remanded with directions for an injunction and for an assessment of damages.

Plaintiff had purchased its original design in Paris at the Rampelberg Studios, in the form of a sketch or painting. At first two colors were used (in addition to the impervious white portion); finally three colors were used, and a copyright was secured.



The appellate court found very little difference between Soptra's design and that of Stafford; one of the difficulties to which it referred was that it was not easy in the two-dimensional, black and white print of a judicial opinion to compare two dress designs based upon black and white photographic reproductions of the designs submitted to the court. The district court had relied primarily on these black and white photographs, and had concluded that the designs in issue were different. The appellate court, in commenting on the factor of color in relation to the designs, said that by looking only to the black and white reproductions, the district court had missed the point: "certainly the color schemes were not to be entirely overlooked." Couleur International Ltd. v. Opulent Fabrics, Inc., 330 F. Supp. 152 (S.D.N.Y. 1971). This court then stated: "Here the designs were to be used in dresses, and although small differences between the designs might be found to exist under courtroom scrutiny, those differences fade away within a few feet or absent sharp scrutiny."

Sunset House Distributing Corp. v. Doran  
134 U.S.P.Q. 4 (9th Cir. 1962), aff'd 197 F. Supp. 940, 131 U.S.P.Q. 94 (S.D. Cal. 1961)

Action for copyright action and unfair competition. From judgment for plaintiffs, defendants appealed. Affirmed.

As the appellate court put it: "This is a contest between two rumpled Santa Clauses," which began their inanimate life as red flat plastic bags with some decoration and faces thereon. They were sold to purchasers who stuffed them with crumpled newspapers. The result was a "fat life-sized dummy Santa Claus." Only the face on each, which is a happy one, "contradicts the otherwise disheveled appearance of both." At the Christmas season, they are marketed for decorative purposes. Sunset House copied the product. The court remarked further that "obviously, Santa Claus belongs to the whole world, and next he may be exported to outer space -- he belongs to none of the parties," and added: "But defendants' trouble is that their Santa Claus was just a lazy copy of the Doran Santa Claus."

The appellate court held that although the court below could not enjoin defendants from the whole field of manufacturing Santa Claus, it could enjoin defendants from copying plaintiffs' copyrighted Santa Claus; accordingly it affirmed since there was substantial merit to the appeal.



Tennessee Fabricating Co., d.b.a. TFC Co. v. Moultrie Mfg. Co.  
421 F. 2d 279, 164 U.S.P.Q. 481 (5th Cir. 1970), rev'g 159 U.S.  
P.Q. 363 (M.D. Ga. 1968), cert. denied, 398 U.S. 928 (1970)

An appeal from a judgment for defendants in an action in the district court for copyright infringement. Reversed in favor of plaintiff-appellant.

The subject matter was an architectural metal casting unit intended for use in combination or singly for a decorative screen. The filigree pattern was formed entirely of intercepting straight lines and arc lines, and was original with the artist employed by plaintiff. The defendants came into possession of a copy of the unit on which the copyright notice had been obscured by paint, used it as a mold, made a pattern from the design and marketed it. They also made a catalog and advertising mat of the design and distributed them. After a protest by plaintiff, defendants redesigned the unit by adding four intercepting straight lines in the form of a diamond to the filigree pattern, but continued to distribute the catalog. The appellate court did not agree with the district court on any of the grounds stated, reversed, and remanded for determination of damages and entry of judgment, enjoining further infringement and awarding damages to plaintiff. Referring to both Bleistein and Catalda (Bleistein v. Donaldson Lithographic Co., 188 U.S. 239 (1903) and Alfred Bell & Co. v. Catalda Fine Arts, 191 2d 99 (2d Cir. 1951)), the appellate court held that plaintiff's architectural unit possessed at least the minimal degree of creativity required for copyright.

As to subsequent copyright notices, the court held that plaintiff did not have the heavy burden of proving that all publications were with copyright notice; the burden was on the defendants to establish the invalidity of the copyright. The court also held that the use of plaintiff's initials in the copyright notice was adequate in this case since a name with which it is identified is used and no innocent persons are misled. As to the contention in regard to use of photographs of plaintiff's design as "fair use," the court stated that "the doctrine of fair use has no application to the conduct of the defendants."

In answer to the district court's finding that defendants' redesigning of its unit by adding additional intercepting straight lines to the filigree pattern was sufficient compliance with plaintiff's request to cease manufacturing its unit, this court held that there had been infringement: "Infringement is not confined to exact reproduction but includes colorable alterations made to disguise the piracy."



Uneeda Doll Co. v. Regent Baby Products Corp.  
355 F. Supp. 438, 176 U.S.P.Q. 73 (E.D.N.Y. 1972)

Action for copyright infringement, plaintiff seeking a preliminary injunction. The motion was granted.

Plaintiff was a doll manufacturer and had a copyright on a rubber squeeze-toy doll, or a model or design for a "work of art" registered under 17 U.S.C. Sec. 5(g). The doll had been created by an artist, who had conceived a doll that would nearly approach a ball, in keeping with a concept of rotundity. The finished dolls (9 inches tall) were known as "Plumpees". Plaintiff then decided to produce a smaller (6 inch) version of its "Plumpee" doll, which contained a later date of publication in the application for copyright registration and in the copyright notice. The court (Judge Dooling) held on that point that republication of the same doll, if it was the same doll, with the circled "c" neither extended the copyright, nor was it of itself invalid, nor did it forfeit the earlier copyright. Moreover, the court pointed to the fact that the year date is not required for works of art publications (17 U.S.C. Sec. 19).

Turning to the question of infringement, Judge Dooling discussed the differences between the two dolls, plaintiff's and defendant's, the defendant's having been designed and manufactured in Japan by one Iwai: defendant's doll was not a mold copy of plaintiff's, on the contrary, every detail indicated that Iwai's doll maker worked from plaintiff's doll and made the doll Iwai's own by modifying the plaintiff's doll. The second difference of moment was in the overall appearance of the doll; the sense of a distended figure was all but completely absent from defendant's doll.

Judge Dooling, in discussing several cases in the Second Circuit relating to the criterion of infringement, with respect to works of art, referred specifically to Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F. 2d 787 (2d Cir. 1960), and commented that the test of more recent cases had greatly shifted from the Peter Pan view, which had seemed to require something approaching "identity." For example, Couleur International Ltd. v. Opulent Fabrics, Inc. 330 F. Supp. 152 (S.D.N.Y. 1971).

Judge Dooling, after comparing the Peter Pan case with other cases which applied less severe tests, found that defendant's Iwai doll maker was an infringer even though he had not copied the whole of plaintiff's doll, had not copied it slavishly and had not sought by his differences to disguise or hide the fact of copying; the fact of copying was plain.



Walco Products, Inc. v. Kitlay & Blitz, Inc.  
354 F. Supp. 121, 175 U.S.P.Q. 471 (S.D.N.Y. 1972)

An action for copyright infringement and unfair competition, in which plaintiff moved for a preliminary injunction. The motion was granted.

Plaintiff sought the injunction to enjoin defendants from "manufacturing, selling, publishing, distributing, offering for sale and otherwise marketing" etc. certain Christmas tree ornament kits and related photographs, catalogues and books copied from plaintiff's copyrighted work of art, photograph, kit package, book and catalogue. Plaintiff's "Sequin Facets Kit" bore the proper copyright notice on each header, but no other ornament or kit involved carried a notice. Defendants distributed to the trade a "1972 Holiday Ornament Kits" catalogue showing ornaments which were obvious "knock-offs" of plaintiff's designs.

The court pointed out that not only was defendants' product inferior, but also that in this action there was a substantial danger of a loss of good will and future sales "in this seasonal market for Christmas ornaments which is likely to be exhausted within weeks." Judge Brieant said that there likewise appeared the strong possibility that defendants had infringed plaintiff's catalogue by substantially copying in three dimensional form the two dimensional illustrations of the ornaments contained in plaintiff's catalogue. The court added that the Copyright Act, 17 U.S.C. section 3 protects each of the component portions of a catalogue. Also, the fact that there were no copyright notices on plaintiff's other ornaments was "of no moment" in this action, since the infringement concerned copying not from the ornaments themselves but from the copyrighted catalogues: The substance of a design produced through a different medium is likewise prohibited. King Features Syndicate v. Fleisher, 299 F. 533 (2d Cir. 1924). Finally, the court also held that "plaintiff should not be forced to rely on the voluntary undertaking of the defendant not to resume infringement."



B. Common Law and Unfair Competition

Alexander (Vic) & Associates v. Cheyenne Neon Sign Co.  
417 P. 2d 921, 151 U.S.P.Q. 438 (Wyo. Sup. Ct. 1966)

Action for violation of literary property rights. From judgment for plaintiff, defendant appealed. Affirmed.

Plaintiff (Cheyenne) had sued Alexander (defendant) in connection with the design of a store sign for defendant's jewelry store in Cheyenne. The designing started out for a sign at defendant's store in Laramie, but defendant had decided on signs at both locations, the one at Cheyenne being constructed first. Plexiglass was to be used, and the sign was to have an awning-appearing design, with bright blue and white vertical stripes, running from the top of the store to a marquee over the entrance. Defendant sought to cancel its contract for the Laramie store and it was rescinded. Soon thereafter, Alexander entered into a contract with another sign company for a sign at Laramie; it was essentially a duplicate of the one designed by plaintiff. Blueprints for the Laramie sign had been left with Alexander by plaintiff, and counsel for Alexander had argued that the leaving of these drawings in the Cheyenne store and also construction of the Cheyenne sign, constituted a publication of plaintiff's work, barring a right to recover on the basis of a common law copyright.

The appellate court commented that it could not say the mere leaving of drawings in defendant's store and the construction of its Cheyenne sign would, as a matter of law, evidence an intention on the part of plaintiff to dedicate its work to the public generally. After further discussion in relation to the assessment of damages under circumstances indicating that compensation was expected if the novel idea in question should be used, the court stated that the originator may recover from the appropriator. The court concluded that "the value of the service to the appropriator was the basis for fixing the amount of compensation."

Allen's Products Co. v. Glover  
18 Utah 2d 9, 414 P. 2d 93, 149 U.S.P.Q. 795 (1966)

Suit for unfair competition. Plaintiff sought injunctive relief and damages. From summary judgment for defendants, plaintiff appealed. Affirmed. Chief Justice Henriod dissented.



Plaintiff was the operator of drive-in restaurants and employed architects to draw a plan for a building of unique design. One of plaintiff's employees gave a copy of the building plans to defendant, who followed the plans most exactly. Plaintiff claimed that defendant in his drive-in in "Midvale" copied the unique appearance of plaintiff's drive-ins to pirate the good will and reputation plaintiff had established with the public, resulting in unfair competition.

The court referring to the Utah state statutes, which provides for protection in the use of trademarks and trade names and also deals with trade practices, said that a portion of common law relating to unfair competition enacted into statute was not necessarily all inclusive as to what rights might be protected, and agreed with the trial court's dismissal of the plaintiff's complaint, even though in this case the buildings of the parties were so similar in appearance that it was easy to believe that they were constructed from the same plans. The court pointed out that the number of geometric designs in which buildings might be constructed were comparatively few; that the figure of the diamond was a very common one and a court should be reluctant to permit one to appropriate such a common figure exclusively to his own use, a situation different from one in which a party by some ingenuity and art had created a design which is unique or unusual. The court also pointed to the fact that defendant's building bore a large sign and that the businesses were some distance apart.

Chief Justice Henriod dissented, saying that the fallacy of the main opinion was in implying that a diamond shape could not be appropriated if used in a unique way with new or different applications to which it might be combined.

Bailey v. Logan Square Typographers, Inc.  
441 F. 2d 47, 169 U.S.P.Q. 322 (7th Cir. 1971)

An action for misappropriation of intellectual property. The complaint had been filed in the state court and removed on the ground that it raised questions under the federal Copyright Act. From orders allowing defendants' petition for removal from the state court and dismissing the complaint, plaintiff appealed. Reversed.

As the appellate court stated, there were two separate interests which plaintiff sought to protect: (1) the design of individual characters in his alphabets, and (2) the aggregate value of his inventory of alphabets, including physical properties such as



negatives used in the photo process printing business. Plaintiff, a resident of California, had designed certain alphabet styles different from familiar types and had supplied them to other printers who had executed license agreements with plaintiff. The individual characters were contained in printed materials which photo processors sold to the public without restriction. Plaintiff alleged that defendants wrongfully appropriated a substantial portion of his properties in the possession of his New Orleans licensees, and asserted a right to prevent defendants from copying any part of his alphabets. As to this assertion the court said in part:

"Since no federal copyright has been obtained, such copying of published matter may not be prohibited....

The decisions in Sears and Compco...support the district court's rejection of plaintiff's claimed monopoly interest in the design of individual letters which have been published. Different questions are raised, however, by his claim that his interest in the aggregate value of his compilation of alphabets has been invaded."

The court added that it was satisfied that the complaint contained allegations which might support a common law claim that would not be barred by federal law.

In remanding the case to the state court, this court concluded its discussion of the issue by saying:

"Although the rationale of Sears and Compco requires state courts to respect the supremacy of defendants' federal right to copy material in the public domain, nothing in those opinions requires that federal right to be vindicated exclusively by federal courts. The state courts can be safely trusted to respect 'the Supreme Law of the Land', U.S. Const., Art. VI."

Baut v. Petchick Const. Co.  
262 F. Supp. 350, 152 U.S.P.Q. 212 (M.D. Pa. 1966)

Suit for patent infringement and unfair competition, and wrong-



ful appropriation of property rights in connection with a stained glass window which was installed in a Presbyterian Church in Pennsylvania. Judgment was for plaintiffs.

Plaintiffs' design had been submitted to the church board and turned over to another contractor, a defendant. Defendants had urged that the design used for them was not identical to plaintiffs' and was not novel, certain symbols that appeared therein having been in use for years in many designs.

As to the appropriation of the design, the court stated that plaintiffs had no protection under the copyright laws, so "resort must be had to the common law: Pennsylvania recognizes a common law right in an artistic production." William A. Meier Glass Co. v. Anchor Hocking Glass Corp., 95 F. Supp. 264 (W.D. Pa. 1951). The court took the view that although plaintiffs' design embodied elements long in use, this did not itself negate originality or novelty: "Rather, the requirements of originality and novelty should be viewed in the entire context in which the elements are used," citing Waring v. WDAS Broadcasting Station, Inc. 327 Pa. 433 (1937). A comparison showed that defendants' design had the same theme, a cross, a sunburst scene, and various symbols; in fact plaintiffs' design was substantially copied, and the differences were insignificant. Defendants had produced no evidence of other window designs similar to plaintiffs'. The court, therefore, held that defendants had wrongfully appropriated plaintiffs' design, in which the latter had a common law property right. An accounting for damages pursuant to this and other findings were to await either appellate review or expiration of the time for taking an appeal.

Beconta, Inc. v. Larson Industries, Inc.  
330 F. Supp. 116, 169 U.S.P.Q. 465 (N.D. Ill. 1971)

Action for trademark infringement and unfair competition. Plaintiff's motion for preliminary injunction was granted. The court had jurisdiction over the parties by virtue of diversity of citizenship.

The goods involved in this case were skis. Plaintiff's ski, known as the Zebra, and manufactured in 1968, was distinguished by "an unusual and striking pattern" of transverse stripes of varying widths in a chevron-type configuration covering most of the top surface of the ski. Defendant had introduced into the



market in 1970 a ski in external appearance markedly similar to the design and appearance of plaintiff's ski.

The court stated that this similarity was likely to confuse the buying public: The federal trademark laws were not involved but the court found applicable the Illinois statute-(Smith-Hurd Annotated, ch. 142, sec. 22) which provides for the remedy of injunction to prevent the use by another of a similar mark or label if there exists the likelihood of dilution of the distinctive quality of the mark. However, the court indicated that it could not provide equitable relief to the plaintiff in this case without reference to the decision of the United States Supreme Court in Sears, Roebuck & Co. v. Stiffel, 376 U.S. 225 (1964) and Compco Corporation v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964). The court, in considering these two cases said the suggestion emerged there that remained in this court some power in equity and law to enforce the principles of the common law of unfair competition. Hence the court temporarily enjoined defendant from offering for sale, selling or distributing to the ski-buying public defendant's ski "unless and until some modification of the cosmetic design of that ski or some label or other legend affixed to it clearly indicates to prospective purchasers that the defendant's ski is not the same as the Zebra ski and not a product distributed by Beconta."

Clairol Inc. v. Andrea Dumon, Inc.

14 Ill. App. 3d 641, 303 N.E. 2d 177, 179 U.S.P.Q. 119 (1973),  
aff'g 163 U.S.P.Q. 245 (Ill. Cir. Ct. 1969), cert. denied, 419  
U.S. 873 (1974)

Action for unfair competition. From judgment for plaintiff, defendants appealed. Affirmed.

Plaintiff charged that the graphics or "trade dress" on the defendants' bottle so closely imitated the graphics of plaintiff's "Pure White Creme Developer" that consumers would mistakenly purchase defendants' product in the belief it was plaintiff's. Defendants' bottle differed in some detail; at the top of the graphics on the bottle face was an artistic drawing of the Golden Gate Bridge (in mustard gold) a design reproduced in a size approximating that of Clairol's crown device. A visual comparison of the parties' 16 ounce bottles revealed a positive, striking likeness.

The appellate court held first that the Illinois Uniform Deceptive Trade Practices Act was applicable here even though not pleaded; the



statute deals with false, concealing, or deceptive trade identification, and false, confusing, or deceptive representations as to the source or origin of goods.

"Armed with a knowledge of Illinois' common law tradition in the area of unfair competition, and with a history of the legislative intent underlying the Act's drafting and adoption, it is our view that the Act clearly seeks to provide a remedy for those subjected to the type of activity the defendants have engaged in here."

The court dealt with another argument of defendants that the law of unfair competition, as it pertains to trade dress simulation, is no longer viable in light of the Supreme Court's decision in Sears, Roebuck & Co., 376 U.S. 225 (1964) and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964); this court agreed that Sears and Compco involved the copying of articles or products and not the simulation of trade dress, thus following the trial court's ruling that defendants' interpretation of those cases as mistaken was eminently correct. In conclusion the court said that it had "examined the actual containers and trade dress," and found there is "substantial evidence to support the trial court's findings and the injunctive order issued."

Compco Corp. v. Day-Brite Lighting, Inc.  
376 U.S. 234, 140 U.S.P.Q. 528 (1964) rev'g 311 F. 2d 26, 136 U.S.P.  
Q. 17 (7th Cir. 1962)

Like the Sears, case, Sears, Roebuck & Co. v. Stiffel Co. 376 U.S. 225 (1964), decided the same day, this was an action for unfair competition; on writ for certiorari to Court of Appeals for the Seventh Circuit to review judgment for plaintiff, reversed by the Supreme Court.

As in Sears, Mr. Justice Black delivered the opinion of the Court; again, as in Sears, the question was whether the use of state unfair competition law to give relief against copying of an unpatented industrial design conflicted with the federal patent laws. Both Compco and Day-Brite were manufacturers of fluorescent lighting fixtures of a kind used in offices and stores. Day-Brite had secured a design patent on one aspect of its fixtures and had been refused a mechanical patent on the same device. The district court had held the design patent invalid but it did hold that Compco had been guilty of unfair



competition under Illinois law. The Court of Appeals for the Seventh Circuit affirmed.

The Supreme Court referred to its decision in Sears:

"Today we have held in Sears, Roebuck & Co. v. Stiffel Co. supra, that when an article is unprotected by a patent or a copyright, state law may not prohibit others to copy that article. To forbid copying would interfere with the federal policy, found in Article I, Section 8, Cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain."

The court, as in Sears, referred to the powers of the State to impose liability upon those who deceive the public by palming off their copies as the original: evidence as to such and other relevant factors is also to be considered in applying State law requiring such precautions as labeling. Finding it unnecessary to determine whether there was error in any findings of the trial court relating to confusion, this Court held that the judgment below could not stand.

Etienne Aigner, Inc. v. Becho  
127 U.S.P.Q. 100 (N.Y. Sup. Ct. 1960)

Action for unfair competition; on plaintiff's motion for a temporary injunction, granted in part.

Plaintiff sought to restrain defendants from manufacturing "sport type" ladies' handbags and purses. Defendants' handbags and purses were so similar to plaintiff's "as to compel the inference that piracy occurred," according to the court. It appeared that an employee of defendants (Nicolos) claimed to have designed some of the handbags and testified that the designs had originated with other manufacturers, "and many others." Moreover, such or similar bags had been sold by other manufacturers and former employees of plaintiff, according to Nicolos. Thus defendant contended that "all the alleged secret process...has been in the public domain". The court concluded that:

"Whether defendants used any of plaintiff's trade secrets which were not disclosed and published



presents issues which should be disposed of at a plenary trial. . . .

The plaintiff will be amply protected by restraining the defendants from manufacturing, selling or offering for sale, sport type ladies' handbags and purses which are in any way similar to the type or kind used by plaintiff, unless the handbags and purses shall be clearly and indelibly stamped so as to indicate that they are manufactured or produced by defendants; from advertising such handbags or purses, without a clear designation that they are manufactured or produced by defendants. . . . The order may provide for an early trial."

Fiske v. American Character, Inc.  
259 F. Supp. 766, 152 U.S.P.Q. 100 (E.D.N.Y. 1966)

An action for breach of confidential disclosure. Judgment for defendant.

Plaintiff had designed a doll in which was placed a diminutive transistorized tape recorder which could record and repeat a short human speech. Plaintiff's "echo doll" was so wired that a single on and off switch controlled its operation. Quite independently, another doll maker, De Luxe Reading, devised an echo doll that also involved use of an endless belt of tape in a tape recorder. There were some differences in this De Luxe doll, "Little Miss Echo," which distinguished the details of operation from those of plaintiff's doll. Plaintiff argued that it was a breach of trust and a violation of confidence for defendant to proceed as it did to market the De Luxe doll, arguing that to do so represented a use, a misappropriation of plaintiff's echo doll.

The court commented that "there is no doubt that plaintiff disclosed his doll completely to defendant," and after some discussion of the "difficulty" of the fact that the two dolls were as different as their common use of an endless belt of tape would permit, concluded that there had been no disclosure of anything that plaintiff could or did claim as peculiarly his, and that there was not in the case any breach of confidence. "Disclosure alone is not enough to make out a confidential relationship when the parties are prospective vendor and vendee and dealing in terms of a device believed to be patentable, and from the obviousness of its structure without total disclosure



of its elements." In fact, explained the court, plaintiff needed to show that defendant was, because of its dealings with plaintiff, debarred from using the non-infringing De Luxe doll; also that it had lost its right to take an interest in a directly competitive product: "But such a drastic consequence cannot follow from so light a relation as here presented." Finally the court said that Speedry Chemical Products, Inc. v. Carter's Ink Co., 306 F 2d 328, was "depositive of the present case."

Fitzgerald v. Hopkins

70 Wash. 2d 924, 425 P.2d 920 (1967), modifying 144 U.S.P.Q. 771 (Wash. Super. Ct. 1965)

An action by a sculptor, James H. Fitzgerald, for infringement of common law copyright in which defendant counterclaimed for slander. Judgment by the trial court had been for defendant, with damages assessed at \$15,000. The appellate court affirmed but would have assessed damages at \$7500; Judge Hunter would have allowed the amount of \$15,000 to stand.

The evidence at the trial court had shown that plaintiff was one of the outstanding professional sculptors of the Northwest and by reputation had achieved a position of stature in that community probably not matched by many other sculptors in the area. He sculptured three versions of what he called "Rock Totem." The final version was exhibited during the last two or three months of the World's Fair in Seattle in 1962, in the exhibition of "Northwest Art Today" at the Fine Arts Pavilion. The defendant was a student at the University of Washington with a bachelor of fine arts degree; plaintiff alleged that while defendant was in the graduate school of sculpture at the University, he sculptured a copy of plaintiff's "Rock Totem" on commission from a bank and called it "Transcending." Plaintiff had argued that the copying of his sculpture amounted to the taking of plaintiff's property by unfair competition in violation of the common law, and that defendant had thereby enriched himself at plaintiff's expense. But it was the opinion of the trial court that the plaintiff had failed to sustain the burden of proving that there was any copying done by the defendant in this case. Turning to the question of slander, the trial court had found the defendant had been damaged, and should recover damages in the sum of \$15,000 and his costs.

On this appeal it was emphasized that statements made by



plaintiff, that defendant was a "thief" in copying plaintiff's work, were imputations "affecting the [defendant] in his business, trade, office or calling" (Prosser, Law of Torts (3d ed.) Sec. 107, p. 772) and are actionable. However, the appellate court was concerned with the amount of damages allowed by the trial court; the court affirmed the dismissal of plaintiff's action but thought that \$7,500 judgment would be fair.

Hearst Corp. v. Shopping Center Network, Inc.  
307 F. Supp. 551, 165 U.S.P.Q. 51 (S.D.N.Y. 1969)

Action for invasion of rights of literary property in certain original art work used in the production of the animated motion picture "Yellow Submarine" of which plaintiff was the producer. Plaintiff's motion to remand the action to the state court was granted (28 U.S.C. 1447(c)).

The case had been started in New York State Supreme Court, but was moved at the behest of the defendants to this court, the latter asserting that the cause of action was founded upon a right arising under the federal copyright laws. United Artists Corporation, another defendant, for plaintiff's benefit, had agreed with defendant Shopping Center to permit it to use the material, but according to plaintiff, the defendants, instead of providing the promotional services, breached the conditions of the agreement and sold the cells and art work owned by plaintiff to other retail establishments, which in turn sold them to the public. Plaintiff in its causes of action charged defendants with unlawful conversion and deceit; also that defendants had received large sums of money without paying royalties or other compensation, plaintiff's cells and art work "never having been published" and remaining "the exclusive property of plaintiff." Plaintiff also charged defendants with adopting and using the designation "Yellow Submarine", and argued that its cause of action fell clearly under the state common law of unfair competition and "passing off".

The court explained that in its complaint plaintiff clearly made no claim to have copyrighted either the animation cells or any of the other art works: "therefore, if plaintiff's cause of action does in fact, as defendants contend, spell out a claim for copyright infringement, it can only be one for common law, and not statutory copyright."



Pointing out that there was no showing that plaintiff had lost its common law rights by publication, the court believed that plaintiff had also stated a claim for common law unfair competition, and added that "an action for unfair competition unrelated to any claim for statutory copyright infringement lies clearly within the province of the state courts."

Huschle, III v. Battelle

37 C.O. Bull. 329, N.Y.L.J., Apr. 9, 1969, p. 16, cols. 7-8 (Sup. Ct. 1969)

Plaintiff's complaint in this case alleged the appropriation by defendant of the idea and concept of plaintiff's three-dimensional unique perfume bottle. Plaintiff sought and recovered damages, including punitive damages.

Plaintiff conceived a three-dimensional bottle of original and unique design to be used as a container for perfume. An employee (Bailiff) of defendant searching for a bottle of original and unique design for a new perfume, sought plaintiff out and the latter showed Miss Bailiff a three-dimensional solid replica of the unique bottle in question, which was made of lucite. Miss Bailiff told plaintiff the bottle was satisfactory and plaintiff entrusted it to her in confidence so that she could show it to defendant, and plaintiff told her the cost would be \$3,000. The bottle was rejected and returned. Plaintiff then saw in the New York Times an advertisement of a new perfume "Ramu" by defendant; the bottle pictured was a copy of plaintiff's bottle. The special referee concluded:

..."defendant deliberately and wrongfully appropriated the idea and concept of plaintiff's three-dimensional unique perfume bottle, the like of which in design, shape, and general makeup was not on the market at that time, and that the bottle was entrusted to Miss Bailiff with the understanding that plaintiff be compensated for the bottle if used by defendant...."  
(Cole, Inc. v. Manhattan Modes, 2 A.D. 2d 593)  
(citing cases.).

Kewanee Oil Co. v. Bicron Corp.

416 U.S. 470, 181 U.S.P.Q. 673 (1974) rev'g 478 F.2d 1074, 178 U.S.P.Q. 3 (6th Cir. 1973)

Action for misappropriation of trade secrets. On writ of certiorari to review judgment for defendants, reversed. Mr.



Justice Douglas, with whom Mr. Justice Brennan concurred, dissented.

Mr. Chief Justice Burger delivered the opinion of the Court. Certiorari was granted to resolve a question on which there was a conflict in Courts of Appeals: whether state trade secret protection is pre-empted by operation of the federal patent law. In the instant case the Sixth Circuit Court of Appeals had held that there was pre-emption (478 F. 2d 107 (1973)). In this case, Harshaw Chemical Company, a division of petitioners, had succeeded in growing a 17-inch crystal. Harshaw considered the process a trade secret. The respondents had been former employees of Harshaw. Bicron was formed to compete with Harshaw in the production of the crystals. The Court of Appeals for the Sixth Circuit held that the Ohio law of trade secrets, applied by the district court, was in conflict with the patent laws of the United States, reasoning that Ohio could not grant monopoly protection to manufacturing techniques that were appropriate subjects for consideration under 35 U.S.C. section 101 for a federal patent, but which had been in commercial use for over one year and so were no longer eligible for patent protection under 35 U.S.C., section 102(b).

The Supreme Court held here that Ohio's law of trade secrets was not pre-empted by the patent laws of the United States, and, accordingly, it reversed. In its opinion it pointed out that Ohio has adopted the widely relied-upon definition of a trade secret found in 4 Restatement of Torts section 757, Comment b(1939) and explained that novelty in the patent sense is not required for a trade secret. "Congress, by its silence over these many years, has seen the wisdom of allowing the states to enforce trade secret protection. Until Congress takes affirmative action to the contrary, states should be free to grant protection to trade secrets." The case was remanded to the Court of Appeals with directions to reinstate the judgment of the district court.

Mr. Justice Douglas, with whom Mr. Justice Brennan concurred, dissented.

NOTE: Mr. Justice Douglas in his dissent, refers to the fact that this decision is at war with Sears and Compco, in which cases the Supreme Court had held that the states may not "under some other law, such as that forbidding unfair competition,



give protection of a kind that clashes with the objective of federal patent laws." (Sears at page 231. Justice Douglas also commented that "the Court's opinion reflects a vigorous activist antipatent philosophy." In a more recent case than Kewanee, i.e. Sinclair v. Aquarius Electronics, Inc., 184 USPQ 682 (1974), it was said that Sears and Compco were now considered open to question, and cited the present case, Kewanee. That case (Sinclair) is referred to at page 174 of this bibliography.

The Painton case, Painton & Co. v. Bourns, Inc., 442 F. 2d (2d Cir. 1971), approved in Kewanee, is referred to at page 168 of this bibliography. Also referred to in Kewanee by the majority are (briefly) not only Sears and Compco, but also (more fully) Goldstein v. California 412 U.S. 546 (1973); in the latter case the Supreme Court had held that the clause 8 grant of power to Congress was not exclusive and that, at least in the case of writings, the states were not forbidden from encouraging and protecting the efforts within their borders by appropriate legislation. Here, in Kewanee, the Supreme Court, after citing Goldstein, said that "just as the states may exercise regularity power over writings so may states regulate with respect to discoveries."

Lipton (Thomas J.) Inc. v. Borden, Inc.  
72 Misc. 2d 757, 340 N.Y.S. 2d 328, 176 U.S.P.Q. 129 (Sup. Ct. 1972)

Action for unfair competition. Plaintiff's motion for preliminary injunction was denied. The injunction sought was to enjoin Borden from simulating the elements of plaintiff's package in any combination that might confuse the public.

The product involved was an instant soup packaged for single servings, plaintiff's as Lipton Cup-a-Soup, defendant's as Wyler's Cup of Soup. Both products were sold in packages identical in size (3 5/8 by 5 inches). The packages contained a photograph on their faces of a clear glass cup into which water was being poured from a kettle.

The court stated that similarity as to name and packaging did not by itself necessarily establish palming off. Ralston Purina Company v. Thomas J. Lipton, Inc., 341 F. Supp. 129 (S.D.N.Y. 1972). "The photograph of a cup being filled with hot water which dehydrates the soup mix in the cup to become instant soup cannot be the exclusive property of one company." The court stated also with respect to the term "Cup of Soup," that this is the normal, common phrase for describing a quantity of that



liquid refreshment normally consumed by an individual at a single sitting; it is in no way unique or fanciful. The court said further that "in the instant case, defendant has placed the Wyler mark in a prominent place in large print on the face of the package and on all sides, clearly indicating the source of the product." The court concluded: "Each case in this area of unfair competition must be decided on its own facts and the cases relied upon by plaintiff are factually distinguishable.... Even an unthinking customer desiring to purchase Lipton's soup can see by a glance at defendant's package that she has the 'wrong thing'"

Lozier v. Kline

40 Ohio App. 2d 277, 319 N.E. 2d 204, 184 U.S.P.Q. 369 (1973)

An action for unfair competition; from judgment for plaintiff in part and for defendant in part, both parties appealed. Modified.

According to plaintiff's allegations, he manufactured and sold caps and covers for the rear bed of a platform of vehicles such as pickup trucks. He considered these products to be of "unique construction, shape, design, nonfunctional trim and color, so as to present a physical appearance to the ordinary purchaser essential to commercial success, and that the physical appearance had acquired a secondary meaning." The defendant had obtained one of Lozier's caps or covers, known as the "Trimline Series" for use as a model, and had manufactured and offered for sale an article which was a copy of plaintiff's product. Plaintiff asserted that defendant's acts constituted unfair competition, and unlawful appropriation of his property rights, a deceptive trade practice (within R.C. 4165.02).

The appellate court concluded that there was no evidence in the record that defendant had "passed off" his caps and covers as Lozier's products when he consigned, for sale to customers, to a motors company two caps and covers which he (Kline) had manufactured, and which in general appearance looked like plaintiff's product. The court referred to the 1964 decisions of Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, since which it is clear that the public policy which encourages free competition, "permits the design of the unpatented article to be copied, and the copied article sold, even though the copy is identical to the original." The court added, however, that the Supreme Court had indicated that state law might require



that those who made and sold copies take whatever precautions were necessary to identify their products as their own. In conclusion the court stressed that for articles manufactured by defendant in the future, "fair competition requires that in order to avoid any likelihood of confusion, they be labeled in some way to show that they are the goods of Kline and not those of Lozier." For this reason, the case was remanded to the trial court.

Mastro Plastics Corp. v. Emenee Industries, Inc.

16 App. Div. 2d 240, 228 N.Y.S.2d 514, 133 U.S.P.Q. 664, rev'g 32 Misc. 2d 801, 223 N.Y.S.2d 940, 132 U.S.P.Q. 413; aff'd per curiam, 12 N.Y.2d 826, 236 N.Y.S.2d 347, 136 U.S.P.Q. 144 (1962). See also 136 U.S.P.Q. 671 (N.Y. Sup. Ct. 1963) (defendant's motion to dismiss amended complaint for legal insufficiency denied)

Action for trademark infringement and unfair competition. Defendant appealed from an order denying its motion to dismiss the plaintiff's complaint. Reversed.

Plaintiff and defendant were competing corporations engaged in manufacturing and marketing musical instruments, both making and selling "bongo drums"; defendant making them to sell for less. Defendant had bought from one of plaintiff's distributors 180 of plaintiff's drums, removed plaintiff's trademark, substituting its own, and used these drums as samples upon which it would sell to the trade its own product. Also, defendant had used photographs of plaintiff's drums, retouched so as not to show plaintiff's trademark, for the purpose of advertising and promoting its drums. Plaintiff sought an injunction and accounting, asserting unfair competition. The court, at Special Term, had denied a motion to dismiss the complaint, but this court was of the opinion that the complaint did not show a good case for the relief sought.

The appellate court explained that plaintiff did not invent the plastic bongo drum, it did not add to it any character special to its own manufacture; nor was it suggested that it was in possession of patent or property rights in the drum which it had manufactured. "When plaintiff placed its plastic drum in the public domain by selling it, anyone who saw one or bought one was free to copy it exactly; and to market the reproduction." The court added that if defendant had the right to reproduce and sell reproductions of plaintiff's drums it had the correlative right to put its trademark on the chattel it proffered to the public. The court suggested, however, that



the complaint perhaps spelled out a violation by defendant of the Penal Law but that this action for injunction was based on a remediable harm to plaintiff and not a penal prosecution, a question not reached here. The court referred to several cases to support its position that the process of copying and selling was itself not actionable: Hebrew Publishing Co. v. Scharfstein, 288 N.Y. 374 (1942); Airolite Co. v. Fiedler, 147 F.2d 496 (2d Cir. 1945); Cheney Bros. v. Doris Silk Corp., 35 F.2d 279 (2d Cir. 1929).

New York World's Fair v. Colourpicture Publishers, Inc.  
21 App. Div. 2d 896, 251 N.Y.S.2d 885, 142 U.S.P.Q. 237, aff'g  
mem. 141 U.S.P.Q. 939, (N.Y. Sup. Ct. 1964)

Action for unfair competition. From an order granting plaintiff's motion for preliminary injunction, defendants appealed. Affirmed.

Specifically, the suit was "to permanently restrain defendants from manufacturing and selling post cards, albums and allied items containing photographs and other reproductions of the buildings, exhibits, and any other activity of the New York World's Fair 1964-1965 Corporation."

This court--per curiam--in affirming the order of the Supreme Court, Queen's County, and stating that "a photograph of a unique building, structure or object situated within the World's Fair grounds, to which an admission fee is charged, is a photograph of a show in which plaintiff has a property right," held that defendants may not photograph that building, structure, or object without the plaintiff's permission. The court cited Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp., 199 Misc. 786, aff'd 279 App. Div. 632; see also 279 App. Div. 646; and 279 App. Div. 790 (lv. appeal to Court of Appeals denied.)

Two justices dissented commenting that "in our view, a photograph of a building cannot be deemed the equivalent of a 'performance' or 'show' in which a party may have a legally recognized property right." The justices considered the Metropolitan Opera case distinguishable, and in turn referred to the holding of the Supreme Court of the United States that when an article is unprotected by a patent or a copyright, state law may not prohibit others from copying that article. Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) and Compco Corporation v. Day-Brite Lighting, 376 U.S. 234 (1964).



The two justices thus argued that if the buildings and exhibits, the designs of which had not been patented, could themselves have been copied by others, it would appear the photographic reproductions of the buildings and exhibits for the purpose of sale could not be enjoined.

Nucor Corp. v. Tennessee Forging Steel Service, Inc.  
476 F.2d 386, 177 U.S.P.Q. 353 (8th Cir. 1973), modifying 339 F. Supp. 1305, 173 U.S.P.Q. 374 (W.D. Ark. 1972)

Suit for infringement of common law copyright and misappropriation of trade secrets. The plaintiff's complaint was dismissed by the District Court for the Western District of Arkansas, except that it required that certain property be returned to plaintiff. Reversed; except as to the latter issue, affirmed.

The plaintiff was a producer of steel joists and housed its process in buildings referred to as "Tin Can Buildings." The district court had taken the position that there was nothing strange, new, unique or secret about the buildings; that they were used for the purpose of shelters and had nothing to do with the fabrication of the joists; that when the joists were built and ready to deliver, they were not protected from observation by all; that there had been a general publication by Nucor as a result of its activities and had thus lost its common law copyright in the detailed plans of the building. Nucor had built a joist plant in Texas, having used plans drafted by its engineers, for the design of the building. The plans were delivered to the plaintiff's construction manager (White). After White, plaintiff's employee, had left plaintiff's employ he staffed his own company and asked the defendant to make some plans for the construction of a bar joint plant of the same general type as plaintiff's Texas plant, but with certain differences, particularly in reference to dimensions of the building. White had a copy of the Nucor plans and they were used as a guide.

The appellate court took a different view, from that of the trial court, stating that although the matter was tried below on the theory that Arkansas law controls, and it accepted that approach nonetheless it concluded that the trial court had erred and that the plaintiff was entitled to relief from the defendant's inequitable conduct. This court also rejected the trial court's holding that Nucor had lost its common law copyright protection through general publication, citing the case of Read v. Turner, 48 Cal. Rptr. 919, 40 A.L.R. 3d 237 (Dist. Ct. Appeal



1966) [see page 169 of this bibliography for a summary of the Read case]. The injunction permitted Nucor to amend its complaint to claim damages from defendants for the value of those plans, and to prove its damages in an appropriate proceeding. The case was remanded to the district court.

NOTE: This case came up again on appeal with respect to damages, 185 USPQ 332, 8th Circuit 1975, and it was held that the "fair value" of architectural plans protected by common law copyright is the market value of the plans, and that the owner is not entitled to that portion of market value normally allocable to architectural supervision during construction. The court explained that "because the proceedings on remand were not in conformity with our prior decision, we must again remand the case to the district court"; that on remand Nucor should be allowed to prove the fair value of the Nucor plans and the liability of one of the defendants. The judgment of the district court was therefore affirmed in part, reversed in part, and remanded to the district court for further proceedings consistent with the decision of the appellate court.

Painton & Co., Ltd. v. Bourns, Inc.  
442 F.2d 216, 169 U.S.P.Q. 528 (2d Cir. 1971), rev'g 309 F. Supp. 271, 164 U.S.P.Q. 595 (S.D.N.Y. 1970)

An action by Painton, a British corporation, for declaratory judgment as to rights under contract in which defendant counter-claimed for declaratory judgment as to such rights and for an injunction. From summary judgment for plaintiff, both parties appealed. Reversed.

The controversy concerned Painton's continued right to use information, relating to electronic circuit components known as potentiometers, which were supplied to Bourns under confidential agreements made in 1958 and in 1960.

In 1962 Bourns sought to terminate the 1960 agreement for failure to make payments; the controversy resulted in a 1962 agreement which was to terminate in 1968, and which extended to still other territories. During the life of that agreement Bourns obtained a British patent; four models manufactured by Painton were said to have embodied features covered by it. In 1968 Bourns wrote Painton that since the 1962 agreement was to terminate in 1968 Bourns did not intend to renew it; and requested the return to it of any drawings and any other related written matter received by Painton as a result of the agreement.



Painton then filed its complaint and Bourns counterclaimed. The district judge had decided (309 F. Supp. 271) that the Supreme Court's decision in Lear, Inc. v. Adkins, 395 U.S. 653 (1969) prevented judicial enforcement of Bourn's claims for trade secrets with respect to any models covered by the British patent, presumably unless and until the validity of the patent should be upheld. The district judge had also held that even as to models for which Bourns had made no patent application, Painton was not required "to make any future payments," including those under a four-year clause which it did not contest.

The appellate court (Judge Friendly) stated:

"Whatever the impact of Lear may be with respect to agreements governing inventions for which patent applications have been filed, we find no suggestion in the opinion that the Court intended to cast doubt on the longstanding principle that an inventor who chooses to exploit his invention by private arrangements is entirely free to do so, though in so doing he may forfeit his right to a patent....

The validity of agreements for the sale or license of trade secrets has been upheld for generations...."

In turning to the difficult question as to whether the agreements between the parties would have encompassed a promise to return the drawings etc. at the termination of the license, or to use all information provided by Bourns after that time, the court felt that the evidence had not clarified the issue, and wondered why under such circumstances summary judgment could have been thought appropriate. The court therefore reversed the paragraph in the order of the district court in so far as it declared the entire agreement invalid, and directed a trial of contract interpretation.

Read v. Turner

239 Cal. app. 2d 504, 48 Cal. Rptr. 919, 148 U.S.P.Q. 453 (1966)

Action for infringement of common law copyright. From judgment for plaintiffs in part and defendants in part, both parties appealed. Reversed.

Plaintiffs conceived a plan for a split-level, four bedroom residence and caused their plan to be expressed in a drawing. Defendants were contractors and in preparing a bid on the work



for the proposed residence, obtained from plaintiffs a copy of their plans, which included a copy of the floor plans. Plaintiffs had told defendants that the plans were to be returned and were under plaintiffs' control, but did not say that the floor plan was not to be copied. Defendants were awarded the subcontract for the work, but using plaintiffs' plans made ten drawings used in the construction of ten houses, of which the floor plans were substantially similar. Plaintiffs in the meantime had sold their house and gave a copy of the floor plan to the purchaser to allow him to make rug measurements, but did not forbid copying of the plans. Moreover, real estate listings prior to the sale of plaintiffs' house had permitted access to it by brokers and salesmen, and there was no restriction on showing the house. Plaintiffs contended that construction of a house incorporating a design subject to copyright does not constitute a publication of that design.

The appellate court, after referring to the provisions of the California Civil Code Secs. 980(b) and 983(b), said that they adopted, in general, the common law copyright rule which confers a copyright upon the designer of a house plan and terminates the copyright upon publication when control by the owner over the subject ceases. The court stated that the uncontradicted evidence dictated the conclusion that plaintiffs, through their multiple listing and open house exhibitions, invited the general public to review the floor plans of the house they subsequently sold, and that these facts in toto established as a matter of law a general publication of the floor plans that terminated plaintiffs' copyright: "It is our conclusion a design may be expressed by incorporating it in a structure as well as by incorporating it in a drawing."

However, as the court went on to say, the general publication by plaintiffs of their floor plan would not foreclose their right to recover for the previous infringement, which occurred when defendant Fulmer copied plaintiffs' plan from their drawing in executing designs to be used in the construction of ten residences. "The publication of the floor plan thus effected was limited and,...did not terminate their copyright."

Samson Cordage Works v. Puritan Cordage Mills  
243 F. Supp. 1, 145 U.S.P.Q. 602 (W.D. Ky., 1964)

Suit for unfair competition. On defendant's motion to set aside contempt judgment, motion overruled. Defendant asked



this court to reconsider the conclusions of law entered January 7, 1964 (140 USPQ 119).

In support of its motion, defendant cited Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964), to the effect that the mere inability of the public to tell two identical articles apart was not enough to support an injunction against copying, or an award of damages for copying, that which the federal patent laws permit to be copied. The court here remarked that the holding [quoted at some length from Sears] did not change the law applicable to the present suit. The court explained:

"Injunctive relief was granted originally because it was shown that the spiral pattern of spots embedded in the surface of the sash cord had been adopted by the complainant as a distinctive trade dress to indicate source, and that such spot pattern had acquired a secondary meaning. Having established the fact that a secondary meaning attached to a spiral spot pattern when it appeared on the sash cord, the complainant was entitled to protection in the exclusive use of its trade dress."

In conclusion, the court explained that what defendant could not do under the injunction was to decorate its cord with a spiral spot pattern in imitation of the markings on complainant's product; hence, having considered the holding and the language of the opinions of the Supreme Court in the Sears and Compco cases, the court held that defendant's motion should be denied.

Sandy (A.J.) Inc. v. Junior City, Inc.

17 App. Div.2d 407, 234 N.Y.S.2d 508, 136 U.S.P.Q. 144 (1962),  
modifying 36 Misc.2d 138, 232 N.Y.S.2d 9 (Sup. Ct. 1962)

Action for infringement of common law copyright and unfair competition. This appeal was from so much of an order as denied defendants' motion to make the complaint more definite and to dismiss the causes of action alleged by plaintiff. Modified to dismiss first four causes of action with leave to replead, otherwise affirmed.

According to the allegations plaintiff had created and designed a checked solid-material dress, the design of which was based



upon a detachable skirt, marketed by plaintiff under the name of "Zip-Around." Defendants had been employed by plaintiff and had had access to the dress designs, photographs, artwork and literary material (termed "copyrightable materials") created by plaintiff; thereafter they had established the defendants infringed upon the "copyrightable materials," which were protected by common law copyright. The plaintiff also alleged conversion by defendants as to each design, and unfair trade practices. The court pointed out in reference to plaintiff's specific allegations that the causes of action inseparably linked dress design, artwork, photographs and literary material under the broad heading "copyrightable materials," adding that "in the absence of copyright or design patent, dress designs are clearly not protected by so-called common law copyright for design copyrights do not exist at common law.... And there is no protection against what has come to be known as style piracy..." However, as to the allegations by plaintiff in regard to unfair competition or unfair trade, the court said that they were sufficient to state a cause of action:

"Here there is an allegation of secondary meaning, confusion in the minds of the purchasing public, and damage, all because of defendants' wrongful acts. It may be noted that the scope of liability in this field is constantly expanding and goes beyond the restricted concept of palming off....It should be remembered also that there is an allegation of a prior-employee relationship."

Justice McNally dissented, saying that "although there may not be any common law copyright of a design, where, as here, in violation of a contract, designs and advertising material incident thereto are appropriated and published without the owner's consent, there is a wrongful interference with property rights." Dior v. Milton, 9 Misc. 2d 425, aff'd, 2 App. Div. 2d 878.

NOTE: Professor Nimmer comments that it has been stated that designs although protected by statutory copyright, are unprotected under common law copyright, citing the above case, A.J. Sandy, Inc. v. Junior City Inc.; he says that this statement appears to be doubtful, citing Dior v. Milton, cited supra by Justice McNally in his dissent to the Sandy case. Nimmer on Copyright, section 11.2 n. 54 (1963).



Sears, Roebuck & Co. v. Stiffel Co.

376 U.S. 225, 140 U.S.P.Q. 524 (1964), rev'g 313 F.2d 115, 136 U.S.P.Q. 292 (7th Cir. 1963)

Action by Stiffel Company for unfair competition; on writ of certiorari to Court of Appeals for the Seventh Circuit to review judgment for plaintiff, reversed by the Supreme Court.

Stiffel had secured design and mechanical patents on a "pole lamp," which was a vertical tube having lamp fixtures along the outside, the tube being made so that it would stand upright between the floor and ceiling of a room. Sears introduced an almost identical lamp for less cost. Stiffel brought suit in the United States District Court for the Northern District of Illinois claiming that Sears had by copying its design infringed Stiffel's patents and had caused confusion in the trade as to the source of the lamps, thereby engaging in unfair competition under Illinois law. The District Court had found the patents invalid for want of invention, but had held Sears guilty of unfair competition, enjoined Sears from unfairly competing by selling pole lamps identical to or confusingly similar to Stiffel's lamp, and ordered an accounting to fix profits and damages. The Court of Appeals affirmed, 313 F. 2d 115 (7th Cir. (1963)).

Mr. Justice Black delivered the opinion of the Court. The question was whether a State's unfair competition law can, consistently with the federal patent laws, impose liability for or prohibit the copying of an article which is protected by neither a federal patent nor a copyright. Justice Black, in referring to the patent and copyright laws enacted by Congress pursuant to Article I Section 8, Cl. 8 of the Constitution, affirmed that these laws are the supreme law of the land: "Just as a State cannot encroach upon the federal patent laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal patent laws." Justice Black made it clear that the lamp was in the public domain and could be made and sold by whoever chose to do so. The Supreme Court did leave an opening, a possible qualification: "Doubtless a State may, in appropriate circumstances, require that goods, whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to the source." The Court emphasized that "because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying." The result of this decision



was that there had been error in the judgment below and that Sears was entitled to a judgment in its favor.

Seeko Promotions, Ltd. v. Minnesota Mining & Mfg. Co.  
185 U.S.P.Q. 454 (S.D.N.Y. 1975)

Action by Seeko for breach of contract in which defendant Tropix Togs counterclaimed for unfair competition. Motion by Tropix for summary judgment on counterclaim granted.

Plaintiff and defendant IDA had purchased 3M microfragrances for use in production of so-called scented tee shirts, currently a popular novelty item. Defendant Tropix, a manufacturer of tee shirts, had purchased supplies of the 3M fragrances from IDA and had sold scented tee shirts to the trade. Plaintiff claimed that it had an agreement with 3M for the exclusive distribution of the fragrances for fabric applications, although 3M denied this. Plaintiff also claimed that Tropix and IDA had knowingly induced a breach of its exclusive distributorship agreement with 3M. Plaintiff sent to certain customers of Tropix letters falsely claiming that plaintiff had proprietary rights in and to scented tee shirts, which would be violated if the retailer sold such products without its approval, the letters threatening legal action if the admonitions were disregarded. The letters had their effect; retailers have refused to buy scented tee shirts from Tropix. The findings also showed that plaintiff's actions were causing irreparable harm to Tropix, since tee shirts were a novelty item with a short duration of popularity. The court found that it was apparent that plaintiff had no valid claim but had instituted the action in bad faith to secure publicity, to threaten and harrass the trade, and to secure an unfair business advantage over its competitor Tropix.

In its conclusions of law the court held that defendant Tropix was entitled to summary judgment on its counterclaim and affirmative defense. Moreover, plaintiff had no basis whatsoever, in law or in equity, for any claim of any kind against any customer or potential customer of Tropix out of or relating to the subject matter of this litigation; Tropix was entitled to an injunction.

Sinclair v. Aquarius Electronics, Inc.  
42 Cal. App. 3d 216, 116 Cal. Rptr. 654, 184 U.S.P.Q. 682 (1974)

Action for breach of contract. Defendant appealed from a judg-



ment obligating it to make payments under a royalty agreement with plaintiff. Judgment for plaintiff affirmed.

Bakerich, the majority shareholder of defendant Aquarius, had approached plaintiff because he had heard that plaintiff, an electronics researcher and consultant, was working with brain waves and wanted to exploit his experiment. Plaintiff demonstrated the workability of the idea on a large device which converted brain waves into audible form. The parties entered into an agreement which provided that the subject matter of the agreement constituted a confidential disclosure. Aquarius agreed to pay the inventor a royalty. Aquarius up to time of trial, had sold 50,000 devices, but had paid plaintiff only \$36 in royalties and \$604.05 for his engineering services. Aquarius had filed a design patent application...for the basically same device incorporating plaintiff's idea. On appeal, appellant attacked the judgment of the trial court (which had provided for an award of royalties to plaintiff) on three grounds: (1) the disclosure of plaintiff's idea did not constitute a trade secret within the meaning of the law; (2) the devices produced by Aquarius did not directly conform to plaintiff's invention and therefore the royalty provisions of the contract were inoperative; and (3) the agreement was not enforceable under prevailing federal law, citing Sears, Roebuck & Co. v. Stiffel Co. 376 U.S. 225 (1964); Compco Corp. v. Day-Brite Lighting, 376 U.S. 234 (1964) and Lear, Inc. v. Adkins, 396 U.S. 653 (1969).

In response to these contentions the court said with respect to the first, that the cases emphasize that although a trade secret may be a device or process which is patentable, patentability is not a condition precedent to the classification of a trade secret, citing Painton & Company v. Bourns, Inc. 442 F.2d 216 (2d Cir. 1971). The court concluded on this point that plaintiff's idea clearly qualified as a trade secret. The court also found, as to the second point (i.e., that the devices produced by defendant displayed minor variations) that defendant's argument was likewise ill-founded. On the other hand, defendant's third assertion required "detailed attention and analysis." The court held that neither the general considerations of public policy nor the dictates of federal patent law constituted sufficient basis for declining to enforce the royalty provisions of the trade secret agreement in question. The court added that it was reinforced in its view by the holding and rationale of Kewanee Oil Co. v. Bicron Corp. 416 U.S. 470 (1974), a case recently decided by the Supreme Court, which held that the Ohio trade secret law was not preempted by the federal patent law. The court stated also that appellant's



position could not be justified by reliance on the Sears, Compco and Lear cases which it distinguished. Moreover, and most significantly, the court made the statement that "in light of Kewanee, the continued validity of Sears and Compco is highly questionable."

NOTE: In view of the recent and far reaching impact of Kewanee and Lear cited supra and elsewhere they are included here (pages 161, 227) even though the subject matter is not directed to design aspect. In Kewanee the product, sodium iodide synthetic crystals, could have been patented but was not. In Lear the product was a gyroscope, a component of the navigational system in all aircraft, and the action was for royalties under a patent license. The Painton case is also included because of its comments on Lear. In Painton the controversy concerned Painton's right to use information relating to electronic circuit components known as patentio-meters, which was supplied by Bourns under an agreement that had expired.

Stevens v. Continental Can Co.  
308 F.2d 100, 135 U.S.P.Q. 111 (6th Cir. 1962)

Suit by plaintiff for breach of confidential disclosure. From judgment for plaintiff, defendant appealed. Reversed.

Plaintiff had claimed that defendant had appropriated and used, in the sale of picnic type paper plates and cups, a decorative scheme originated by her and communicated in confidence to one of defendant's employees; she relied upon an implied agreement by defendant to compensate for her "original idea" should defendant elect to use it. Plaintiff's idea consisted of a design with a simulated wood grain background upon which were superimposed "log-marks." Defendant, after the negotiations with plaintiff, had marketed its "Chuckwagon" series of paper plates and cups. The court remarked:

"We find no case...where anything as simple as combining into a decorative scheme for picnic cups and plates, a wood grain background (already in use and well known) with cattle brands (long in use as a decoration on packages for merchandising) was held to be an original artistic scheme, work of art or a work of such novelty as to vest in its author a common law or statutory



copyright or property right. Assuming, however, that such a decorative design creates a property right, it will not be accorded protection against use by other if it is not original with the person asserting the right to such protection or if such design is already in use and within public knowledge."

The court finally held, as a matter of law, that an idea of using such a known decorative design upon paper cups and plates did not amount to such an original intellectual or ingenious conception as to be entitled to protection as a property right, and that defendant's motion for a directed verdict should have been granted.

Vaudable v. Montmartre, Inc.

20 Misc. 2d 757, 193 N.Y.S.2d 332, 123 U.S.P.Q. 357 (Sup. Ct. 1959)

An action for unfair competition. Plaintiffs' motion for summary judgment was granted, with injunction and damages as requested in the complaint.

Plaintiffs were the owner and operator of the famous Maxim's Restaurant in Paris; defendants owned and operated a newly opened restaurant in New York City, using the name "Maxim's." Plaintiffs had registered the mark "Maxim's" with the U.S. Patent Office for catering services and wines, and have sold food products under that name in the United States. Defendants had not merely copied the name "Maxim's" but had endeavored to create the illusion of identity with plaintiffs' restaurant. As the court said:

"They took the name of Montmartre, a Parisian subdivision, as their corporate name. The decor of their restaurant is so similar in its red and gold color scheme to the French restaurant as to be described in a newspaper article as its 'replica.' The most significant evidence, however, is the imitation of plaintiffs' distinctive style of script printing of the name Maxim's...They ...do not deny such type of printing on the awning, over the door,...and in their advertising....Whatever the source of the name, it is the origination and development of its use in a particular field which may entitle the user thereof to protection by virtue of the secondary meaning acquired therein."



The court concluded that the plaintiffs were entitled to relief not only by reason of defendants' appropriation of their trade name but also because of their "calculated imitation of features associated with plaintiffs' restaurant."

Vernick v. N.W. Ayer & Son, Inc.

59 D. & C.2d 718, 179 U.S.P.Q. 847 (Ct. C.P. Philadelphia County 1973)

An action for infringement of common law copyright and for misappropriation of an idea. Defendant's motion for summary judgment was granted.

The plaintiff, Vernick, offered to sell to Atlantic Richfield Company, through Ayer (Atlantic's advertising agent) a molded plastic ball which plaintiff was marketing as an object to attach by automobile owners to their radio antennas. Plaintiff offered to sell these balls in volume for use by Atlantic in connection with the company's current advertising program which featured "Red Ball Service." Atlantic was then using as a premium item a "highly elastic red bouncing ball called 'Super-ball'." The antenna ball then being marketed by plaintiff was called the "Here I am Ball," a red and white sphere; the purpose of attachment to an automobile, as indicated, was to aid the driver to help him to locate his car in a crowded parking lot. Plaintiff had corresponded with Ayer about the use of the ball by Atlantic. Atlantic began to use an antenna ball, such as the one suggested by plaintiff, which was provided by another producer -- whereupon plaintiff brought suit claiming a violation of a common law copyright property interest in the antenna ball use as an advertising idea, with damages claimed in excess of \$10,000. Defendant's basic position, on the other hand, was that no copyright situation ever existed; that the only thing involved was an offer to sell a product. Defendant also urged that plaintiff's idea was not protected by any common law copyright principles under Pennsylvania law, because the federal law preempted state court jurisdiction in this area (citing *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964)); and that plaintiff's idea was not protectable under quasi-contract or implied in fact contract principles of law.

The court replied to defendant's contentions:

"Our analysis of the decisions and writings on the preemption question leave us without any doubt that



the body of Pennsylvania common law as to copyright claims is still available for the protection of unpublished works or ideas. It is clear, however, that a plaintiff's claim for idea protection...whether based upon common-law copyright, or upon some form of quasi-contract or implied contract, must be founded upon the same ingredients: both novelty and concreteness of the idea sought to be protected."

The court therefore held "as a matter of law," that there was no genuine issue of a material fact as to any common law copyright or other protectable legal interest which could be properly presented for a jury's consideration.

Wolf & Vine, Inc. v. Pioneer Display Fixture Co.  
142 U.S.P.Q. 112 (N.Y. Sup. Ct. 1964)

An action for unfair competition, in which the complaint was dismissed.

Plaintiff was a creator and manufacturer of displays in the sculptured arts field. It developed a type of mannequin that represented a departure from the dress forms then in use. The models were known as the "sha parée girls." The defendant Goldsmith obtained several of these models when they came in for repair by a retail store that had originally purchased them from plaintiff. Goldsmith made models from which replicas of the mannequins were made and sold them at a lower price than those made by plaintiff. Goldsmith sold the replicas under its own name from catalogs and pictures and referred to them as "Les Femmes." Independent jobbers resold the line under their own name. One such jobber (Pioneer) resold under its own name and packaging the models it bought from Goldsmith. In its sales literature, Pioneer used the trade name "Parisettes" to identify this particular line.

This court indicated that "in the instant case, even if 'confusion' were established plaintiff would not be entitled to the restriction relief it seeks." The court went on to say that:

"Mere ability of the public to tell two identical articles apart is not enough to support an injunction against copying or an award of damages for copying that which the federal patent laws permit



to be copied, and where the article is un-  
patented and uncopyrighted, a state may not  
prohibit the copying of the article itself or  
award damages for such copying. See Sears,  
Roebuck & Co. v. Stiffel Co., [376 U.S.  
225 (1964)]."



C. Trade Association Comments on Attempts to Prevent Piracy

Baldwin, Mark, "Design Piracy--Bills, Bills, Bills," Women's Wear Daily, Vol. 108, No. 2 (January 3, 1964) 1, 111.

A somewhat critical article on the design bill, S. 776 (88th Congress, 1st Session, 1963). The author states that the intent of the bill is all for the benefit of the original designer; he can be protected from the first day his design is made public, and if the "administrator" does not grant him a registration, he has recourse to the courts:

"Its backers think it will protect the 'essence' of a design.

But, perhaps because it tries to nail down with legalities something so nebulous as the 'essence' of a dress, the bill itself appears to be designed to be evaded."

Cornell, Joann, "No Man's Land Cited in Design," Home Furnishings Daily, Vol. 31, No. 46 (Mar. 9, 1959) 13-14.

A summary of an address delivered by Sol B. Wiezer, Washington, D.C., patent attorney, at a meeting of the Lamp Manufacturers Anti-Piracy Committee in New York City, in which he explained to the members at the meeting the advantages of an association of lamp manufacturers whereby each member would agree not to copy each other's design without permission. Mr. Wiezer also explained the difference between mechanical patents, design patents, and copyrights, particularly in relation to the lamp industry.

Diamond, Sydney A. "Fabric Design Piracy Halted as Infringement of Copyright," Advertising Age, (May 18, 1959) 109.

Mr. Diamond, a member of the New York Bar, discusses the efforts of Peter Pan Fabrics to protect its designs, and points out that "the most serious legal technicality in the lawsuits was the adequacy of the copyright notice used by Peter Pan."

"Industry seeks guard in copyright law," Film Daily, Vol. 117, No. 3 (Feb. 23, 1960) 1, 7.

An article on the "united film industry" movement leading to the introduction of the Talmadge design protection bill (S. 2853,



86th Congress) as a substitute for the O'Mahoney-Wiley-Hart bill (S. 2075, 86th Congress) in order to retain existing copyright protection for toys, dolls, and other novelties developed for sale in connection with film characters, "principally those of Walt Disney."

Gotshall, Sylvan, "Why retailers should support laws to protect fashion designs," Stores (June 1961) 14-16.

An article on the problem of the retailer in facing the issue of design piracy. After an examination of existing legal protection, a case is made for a corrective legislation protecting creative designers and manufacturers of original designs, with special reference to the [then] pending design bills, H.R. 6776 and S. 1884.

Nemy, Enid, "The Story of an Angry Designer," The New York Times, Vol. 124, No. 42909 (City ed. July 18, 1975) 36.

An article about a jewelry designer who instituted two civil actions for infringement of his copyrighted designs, a scarab pendant and a man-in-the-moon buckle. The plaintiff settled the cases with injunctions preventing further infringements--a business decision, "since it was cheaper to pay tribute than to fight." The plaintiff nevertheless stated that he would leave no stone unturned and in future actions would be more tenacious and would go after retailers who sell the copies. The author commented that "although commercial firms have, in the past, instituted similar actions against other commercial firms, [the plaintiff] whose designs sell to such stores as Georg Jensen and Nieman Marcus, is one of the comparatively few prestige jewelry creators to have taken such a course."

Reynolds, William H., "What Business Needs to Know About Industrial Designs," Business Topics, Vol. 14, No. 3 (Summer, 1966) 57-66.

The author explains that --

"...it is commonplace that some businessmen have much better judgment than their designers with respect to which designs will sell. This is often referred to as merchandising flair. The point, however, is that this judgment of the businessman is not based on aesthetic factors. It is based on his skill in another almost totally unrelated area, marketing to the American



consumer. The task of the businessman is to convince the designer that one of the major objectives of a design is to communicate something about the product to the market."

Italy (Milan), "Italian Designers View Piracy as Fact of Life,"  
Women's Wear Daily, Vol. 114, No. 127 (June 30, 1967) 30.

This article is based on observations and interviews of Italian designers relating to design piracy, which indicate that the established practice of "copy-strolling" stirred up such a strong reaction among merchants in Milan, Rome and Florence that now most of the elegant shops protect their display with blinds or full darkness after 7:30 P.M. "With foreign manufacturers, the 'eye-copying' is more frequently compensated by the purchasing of wanted handbags."



D. Design Patent Cases

Aileen Mills Co. v. Ojay Mills, Inc.  
188 F. Supp. 138, 127 U.S.P.Q. 370 (S.D.N.Y. 1960)

Action for patent infringement and unfair competition. Defendants moved for summary judgment to dismiss the cause of action relating to plaintiff's design patent covering a textile fabric, defendants claiming that the bedspreads made and sold by them did not infringe upon the design of the fabric illustrated in the patent. Defendants' motion for summary judgment granted.

To sustain the validity of the patent, plaintiff's argued that "prior to this fabric there was no fabric on the market combining the distinctive characteristics of parallel rows of tufts with parallel metallic yarns alternating with the rows of tufts."

The court explained that where a defendant moves for summary judgment in a patent infringement case on the ground that he has not infringed the patent involved, the issue of the invalidity of the patent itself will be disregarded; the issue of infringement, coupled with a charge of unfair competition may be separately determined. The court discussed the difference of appearance between the plaintiff's finished fabric (in sample form) and defendants' bedspreads, resulting from the fact that the completed fabric had apparently been washed, which gave it a different appearance than that presented by the drawing or print submitted by the plaintiff for the design patent. The court held that the total impression that defendants' fabric would make upon the eye and mind of the ordinary purchaser would not be that made by the plaintiff's patented design; therefore, an infringement of plaintiff's claim had not been made out. The court remarked, concerning unfair competition, that the issue still remained but need not be specified here, and was referred to the trial court.

Allen v. Ideal Products, Inc.  
300 F. Supp. 349, 163 U.S.P.Q. 176 (W.D. Pa. 1969), aff'd per curiam,  
426 F.2d 185, 165 U.S.P.Q. 417 (3d Cir. 1970)

Suit by Allen for patent infringement in which defendants counterclaimed for violation of the antitrust laws. Plaintiff's motion to dismiss the counterclaim was granted, but defendants



then moved for summary judgment, which was granted.

The Allen patent was for a "wrinkle free gun butt pad for shooting garment." The advantages claimed were that the pad is resilient and that it was removable. The examiner rejected the patent because of prior art.

At the request of the court in this case the parties briefed the question whether in view of Fashion Originators' Guild of America v. F.T.C., 312 U.S. 457 (1941), there could be such a thing as a patent protecting the design of a garment. Perhaps one sufficient distinction, according to the court, was that in the Fashion Originators case the designs involved were merely decorative or ornamental, created to establish a mode or fashion, whereas in the case at bar the court was dealing with a functional or utilitarian type of design, intended to protect the sportsman's body against the recoil of his weapon. The court in its discussion of obviousness under 35 U.S.C., section 103, pointed out that the 1952 amendment requirement of novelty was no longer to be interpreted, as in the days of Thurman Arnold, as requiring a "flash of genius," Cuno Engineering Corp. v. Automatic Devices Corp., 314 U.S. 84 (1941), but added a new requirement of non-obviousness, Graham v. John Deere Co., 383 U.S. 1 (1966). The court concluded that the entire structure of Allen's alleged invention was thus disclosed in the prior art as established of record in the Patent Office, and was void. Moreover, there was no infringement.

Anchor Hocking Corp. v. Eyelet Specialty Co.  
377 F. Supp. 98, 183 U.S.P.Q. 87 (D. Del. 1974)

Suit by plaintiff for patent infringement involving two patents was before the court on a motion by defendant for partial summary judgment to declare invalid for double patenting a "utility patent" (mechanical patent) on a "safety closure for containers," issued some months later (in 1973) than a design patent on an ornamental design for a container closure to the same inventor (issued in 1971). Motion denied.

The object involved was the cover which functions in conjunction with containers to make them extremely difficult to open, especially by children, while allowing them to be readily opened by users instructed in the operation. The design patent showed drawings and specification for a locking ring for a container closure, and the specification and drawings



of the utility patent indicated the functional operation of the locking ring.

The court concluded that it was possible on this record to draw the inference that the patentee used a single article of manufacture to illustrate two separate and distinct inventive concepts -- one being the novel appearance of the locking ring which may be a valid subject of a design patent and the other a novel utilitarian aspect of the locking ring which may be the valid subject of a utility patent. The court decided here that when inconsistent or opposing inferences may reasonably be drawn from the undisputed facts as to which reasonable men might differ, the case may not be determined on a motion for summary judgment.

Bachmann Bros. Inc. v. Opti-Ray, Inc.  
273 F. Supp. 847, 155 U.S.P.Q. 160 (E.D.N.Y. 1967)

Action by Bachman was for patent infringement of a design (by McNeill) for a pair of spectacles. The complaint was dismissed on the basis of invalidity of the design patent.

The design as shown consisted of a pair of spectacles in which the brow bridge and nosepiece are a single line, curved in the general configuration of the face at eye level, the lense portions taking on the convexity of the frame. As indicated by the court, the overall impression was of a simple, cohesive, "swept back" or "wrap around" design. The examiner had cited several examples of prior art.

The court referred to the statutory protection for designs (35 U.S.C. Section 171) "which by its express terms, makes the test of the patentability of a design the same as that provided for utility patents (35 U.S.C. Section 103)," emphasizing that the statutory protection afforded under the patent laws is reserved for invention; in other words, the claim must be creative and must be the product of more than the ordinary skill of the designer. The court considered the outlines of the respective designs referred to, including the design of a French patent, the "Orma Sportgoggle" which had been distributed in this country, and continued with the conclusion:

"...differences in color and materials are eliminated. It then becomes apparent that the McNeill design is but a slight modification of the over-all design of the Orma



sunglasses. The court finds that the modification was such that it would have been obvious to a designer of sunglasses at the time the modification was made."

NOTE: There was little comment in this case as to the actual "ornamentality" of the McNeill design in issue here, the only reference to that factor being the description of the design given by plaintiff's expert witness, who said it was "a very simple cohesive design without ornamentation, almost classic in its simplicity, a simple single form."

Barofsky v. General Electric Corp.

396 F. 2d 340, 158 U.S.P.Q. 178 ((th Cir. 1968), aff'g 289 F. Supp. 187, 158 U.S.P.Q. 182 (S.D. Cal. 1966)

An action for patent infringement. From summary judgment for defendant, plaintiff appealed and the Ninth Circuit affirmed.

The suit involved the validity of a design patent entitled "Television Cabinet or Similar Article." The dominant features claimed by plaintiff for his design related to the doors attached by hinges to the sides of the center cabinet; the doors were provided along their outer edges with a level plainly apparent when the doors were closed.

The appellate court pointed out that the district court had stated two reasons why the design patent was invalid: the design was not ornamental as required by 35 U.S.C. Section 171 (1964) and there was no invention in view of the prior art (Section 103). An additional and most important reason was that the essential elements of the design were primarily for the purpose of serving a functional or utilitarian purpose. Thus the district court had stated in part in its opinion in clarification of this issue, that all of the appearance features of the cabinet "are dictated primarily by functional or mechanical requirements".

The appellate court, having in view the various indisputable mechanical facts concerning the design, thought that the district court was entitled to conclude that as to the dominant features of the design there was no genuine issue of fact precluding summary judgment, and that the design patent was invalid.



In re Bartlett and Fletcher  
49 C.C.P.A. 969, 300 F.2d 942, 133 U.S.P.Q. 204 (1962)

Appeal from the decision of the Board of Appeals of the Patent Office rejecting the claim for "the ornamental design for a Plastic Floor Tile as shown" on the basis of a prior reference. The decision of the board was reversed.

The design in question involved a square floor tile showing a pattern of figures of mixed white and gray coloration on a black background; the pattern, according to the court, had a random, as distinguished from a regular, design. The Patent Office, relying on In re Johnson, 175 F.2d 791 (36 CCPA 1175, 1949) had arrived at a supposed test "that the degree of difference [from the prior art] required to establish a patentable distinction occurs when the average observer takes the new design for a different, and not a modified, already existing design."

This court, for which Judge Rich wrote the opinion, felt that the Johnson opinion was not stating a test for patentability but a test for novelty of the design; however, novelty, as Johnson pointed out, is only one of the prerequisites to patentability. Explaining that the appellants had produced a distinctively new and different impression, adopting a new approach, the court said:

"We cannot better describe it than to say that instead of using marbleizing technique which produces a bidirectional pattern they adopted a blob-smearing technique which produces a distinctive and strongly unidirectional pattern. Judging as we must, from the basis that the single reference depicts the most relevant prior art, what we see is that appellant's design was obviously the result of creative rather than imitative efforts, origination rather than close copying."

Chief Judge Worley dissented, saying that there was nothing here of a patentable nature; "to give appellant a monopoly will effectively prevent others in this field from exercising even the simplest kind of ordinary skill."



In re Boldt

52 C.C.P.A. 1283, 344 F.2d 990, 145 U.S.P.Q. 414 (1965)

Appeal from decision of the Board of Appeals of the Patent Office. Application for design patent refused; applicant appealed. Reversed. Judge Rich dissented.

Involved here was an application for a design patent for a "Radio Cabinet." To support his allegations that the Board erred, appellant advanced the contentions that the secondary references were from non-analogous arts, and that his design created a visual effect distinctly different from any of the references, "particularly in the development of varying moire patterns with variations in viewing angle and ambient lighting."

As to the first question, the court (Chief Judge Worley) stated that the question in design cases was not whether the references sought to be combined were in analogous arts in the mechanical sense, but whether they were so related that the appearance of certain ornamental features in the one would suggest application of those features in the other, citing In re Glavas, 43 CCPA 797 230 F.2d 447 (1956). Thus the contribution which the moire effect made to the ornamental appearance of appellant's design supported the court's conclusion that what appellant had done was not obvious.

Judge Rich dissented. In his opinion the claimed design was clearly obvious within the meaning of 35 U.S.C. 103 and therefore unpatentable. He did not believe circular brushing would produce the moire effect. The judge added that the moire effect as an aspect of appearance, "for which alone design patents are granted," was not "shown" but only mentioned in words, and being vague, "evanescent" and indefinite, should not be relied on for patentability. Judge Rich would have affirmed here.

In re Braun

47 C.C.P.A. 819, 275 F.2d 738, 125 U.S.P.Q. 192 (1960)

In this action Braun had applied to the Patent Office for a design patent for "ornamental iron work." The application was rejected and the appellant appealed from the decision of the Board of Appeals, one member dissenting. This court reversed.

The rejection was based on unpatentability over the prior



art as shown by a single reference which showed a design based on the grape vine. Appellant's design was based on the wisteria vine.

Speaking for the majority of this court, Judge Rich thought that the reference design, combined with ordinary ornamental iron work designing skill, would not result in appellant's design as the obvious outcome; the designs were of the same general class, "the twisted vine school of iron work art."

"Nevertheless...We see no aping here, or mere development. Something from the creativity of of the artist impinges itself on our consciousness which we are unable to equate with the concept of obviousness. The resulting article of manufacture is a different thing from the treillage of the reference to an extent which makes us feel sure purchasers would choose between them on the basis of different emotional responses to what they behold. If this is so, then the treillage art has been enriched and the design merits the patent protection which is sought."

Judge Martin dissented, with whom Chief Justice Worley joined. Judge Martin said he could not see a sufficient difference in the overall appearance of appellant's design to satisfy him that it was patentable over the cited prior art, and would have affirmed the decision of the Board of Appeals.

Blumcraft of Pittsburgh v. Citizens & Southern National Bank of South Carolina

407 F.2d 557, 160 U.S.P.Q. 642 (4th Cir. 1969), rev'g 286 F. Supp. 448, 158 U.S.P.Q. 642 (D.S.C. 1968), cert. denied, 395 U.S. 961 (1969). See also 255 F. Supp. 441, 150 U.S.P.Q. 198 (D.S.C. 1966)

Appeal from a judgment for plaintiff in an action for patent infringement first tried in the District Court. Reversed.

Involved were a design patent and a mechanical patent relating to a railing structure to be attached to and made part of a building or other structure. The plaintiff at the trial in the District Court had argued, with respect to the design aspects of the railings, that they produced a "floating" visual effect.



Blumcraft had, before trial in the District Court, filed a claim against the federal government in the Court of Claims for infringement of the Blum patent (372 F. 2d 1014, Ct. of Cl. 1967); in that action it was decided that the Blum patent was valid. The District Court, after a full trial upon essentially the same evidence, also decided that the Blum patent was valid and had been infringed (286 F. Supp. 448, D.S.C. 1968).

On this appeal the Fourth Circuit reversed. Applying the standards set forth in Graham v. John Deere Co., 386 U.S. 1 (1966), the court found that the Blum patent was obvious in terms of the prior art and was invalid. In spite of the conflict between the Fourth Circuit and the Court of Claims, the Supreme Court denied Blumcraft's repeated petitions for certiorari.

The appellate court, in considering the arguments presented in the District Court and the decision of the Court of Claims that the Blum patent was valid, agreed that plaintiff's design was novel because the prior art did not disclose multiple rails offset from posts by inconspicuous connectors presenting the illusion of rails floating in space. But the court stated that a design must be more than novel; there must be an exercise of the inventive faculty, and if the design lacks this quality it will not suffice to say that it is new, original and ornamental, and has received wide public acceptance. In conclusion the court said that it was Blum's "railing system" that was unique, but that his system was not the proper subject of a design patent which is for appearance, not for a method of manufacture of assemblage.

NOTE: The Blum design patent has been further litigated and the issue of collateral estoppel ultimately discussed. (See Blumcraft of Pittsburgh v. Architectural Art Mfg., Inc. 337 F. Supp. 853 (D.Kan. 1972), affd. 459 F. 2d 482 (10th Cir. 1972) and Blumcraft of Pittsburgh v. Kawneer Co., Inc., (5th Cir. 1973), and p. 191 of this bibliography.

Blumcraft of Pittsburgh v. Kawneer Co.  
482 F.2d 542, 178 U.S.P.Q. 513 (5th Cir. 1973), aff'g 344 F. Supp. 1018, 172 U.S.P.Q. 43 (N.D. Ga. 1971)

Action for infringement of a patent for an ornamental railing design developed by Blum and issued in 1954. From summary judgment for defendant, plaintiff appealed. Judgment for defendant affirmed.



Defendant had asserted an estoppel, and this court was asked to decide whether the collateral estoppel, made possible by the 1971 Supreme Court decision of Blonder-Tongue Laboratories v. University of Illinois Foundation (402 U.S. 313), attaches where a prior judicial finding of invalidity (in the Fourth Circuit, Blumcraft of Pittsburgh v. Citizens and Southern National Bank of South Carolina (4th Cir. 1969)) was preceded by an earlier finding of validity (Blumcraft of Pittsburgh v. United States, 372 F.2d 1014 (Ct. of Cl. 1967)). In the Blonder-Tongue case, the Supreme Court overruled a long line of cases (e.g. Triplett v. Lowell, 297 U.S. 638, 1936) and held that collateral estoppel could be applied in patent infringement cases regardless of mutuality as long as the patentee had had a "full and fair opportunity" to litigate the validity of his patent in a prior action and was successful.

Here the Fifth Circuit after consideration of the Blonder-Tongue decision and of Blumcraft's argument that this case left to plaintiff an escape hatch as to whether the decision would rest on the trial court's "sense of justice and equity," giving discretion to deny estoppel in this case, did not agree with the plaintiff's argument, and held that the Fourth Circuit judgment met every criteria for estoppel articulated by Blonder-Tongue; and also said that it had been unable to find or infer any exception in Blonder-Tongue for design patent cases. The court ruled that under the letter and the spirit of the Supreme Court's ruling in that case, the district court was correct in applying collateral estoppel and in granting defendant's motion for summary judgment.

NOTE: The case of Blumcraft of Pittsburgh v. Citizens and Southern National Bank of South Carolina, 407 F. 2d 557 (4th Cir. 1909) is summarized at p. 190.

In re Cooper

480 F. 2d 900, 178 U.S.P.Q. 406 (C.C.P.A. 1973)

This case involved an application to the Patent Office for a design patent for a "Design for a Restaurant" which was rejected by the examiner and also by the Patent Office Board of Appeals. The Court of Customs and Patent Appeals affirmed the decision. The applicant appealed.

The claim was in conventional design form, referring to a drawing which portrayed a building in the shape of a barrel with a



double door extending part way from the bottom and five hoops encircling it. There were as references two other design patent registrations. The applicant urged that its design looked like a barrel, whereas Cunliff's design, for example, resembled a barrel only vaguely, the dominant visual impression being more like a rather dour human face wearing a "coolie hat," and with respect to the differences between his design and Cunliff's drew a parallel with two cases in this court, In re Swett, 59 CCPA 1235, 464 F.2d 1399 (1972) and In re Laverne, 53 CCPA, 356 F.2d 1003 (1966).

Judge Rich considered these cases, saying that Swett was a three-to-two decision holding the design of a lettuce bowl and cover unobvious, a precedent in favor of appellant; that Laverne involved designs for molded plastic pedestal chairs. His opinion was that there was considerably more difference in overall appearance than existed in this case, and referred to as significant one of the court's most recent design decisions, In re Lapworth, 59 CCPA 738, 451 F.2d 1094 (1971), on a sailboat design, wherein Laverne was also relied on. Judge Rich agreed with the examiner and the Board in this case that the modifications of Cunliff were so slight to the total design and the overall appearance as to be obvious.

Ex parte Dembski  
130 U.S.P.Q. 115 (Pat. Off. Bd. App. 1960)

An appeal by Dembski from the final rejection by the Patent Office examiner of a claim for a design which related to a clock or watch facing having conventional numerals on the dial, and having a T-shaped minute hand and a straight hour hand. Reversed.

The appellant in his specification stated that the hands "in certain positions in their travel around the dial formed a cross." The examiner had explained his rejection in part by saying that the result of these configurations was that periodically a cross was formed, whereby there was a multiplicity of movable parts; and hence there was no definite design, citing In re Koehring, 37 F.2d 421, 17 CCPA 774 (1930).

The Patent Office Board of Appeals in reversing stated: "We do not believe that there is such a multiplicity of movable parts as to produce a confusion of designs. Therefore we will not sustain the rejection."



Design, Inc. v. Emerson Co.

319 F. Supp. 8, 168 U.S.P.Q. 519 (S.D. Tex. 1970)

This suit concerns the infringement and validity of a design patent assigned to plaintiff. Judgment was for defendant.

The subject of the patent was an insulated beverage container and carrier. The only features which served no utilitarian purpose were the rounded edges and corners.

The court concluded that the patent was obvious and not invention: "There is no novelty in rounded corners, and the requirement that the design patent should not be primarily functional or utilitarian is clearly indicated as lacking, since the design serves functional functions.

In specifically analyzing the provisions of section 171, 35 U.S.C. the court stated that a design patent must be ornamental. Blisscraft of Hollywood v. United Plastics Company, 294 F.2d 694 (2d Cir. 1961). The court said:

"There is a difference in the meaning of the terms 'artistic' and 'aesthetic'. The former stresses the point of view of one who produces art and thinks in terms of creating beauty and form; the latter stresses the point of view of one who analyzes and reflects upon the effect of a work of art. Either term may suggest a contrast with the practical, functional, or moral aspects of something."

Ex parte Dom

135 U.S.P.Q. 100 (Pat. Off. Bd. App. 1960)

This was an application to the Patent Office for the "ornamental design for a font of three-dimensional display letters substantially as shown and described." There were several prior references. The examiner rejected the claim and the applicant appealed. The Patent Office Board of Appeals reversed.

This design related to an assembly or font of display letters; the letters, numerals, and characters were illustrated as three-dimensional, and further characterized by having a "lightweight" appearance achieved by slender strokes or widths of the frontal face of the limbs of each letter or numeral,



and by appearing rather narrow or compressed laterally in comparison with the height. The limbs were of even width and the depth or third dimension appeared to slightly exceed the limb width. The examiner was of the opinion that whatever differences existed between the reference designs and the Dom design were not sufficient to patentably distinguish the design in its entirety. Appellant on the other hand contended that the individual differences served only to point up and emphasize the overall differences and that the instant letters had a "narrow or semi-condensed, high-waisted single weight look" patentably distinct from the prior reference.

The Board believed that not one of the differences had a substantially similar overall appearance when compared with the Dom design, and reversed the decision of the examiner.

Fields v. Schuyler, Comm'r Pats.

472 F.2d 1304 (D.C. Cir. 1972), 175 U.S.P.Q. 514, cert. denied

411 U.S. 987 (1973)

This was an appeal by plaintiff-appellant from a judgment dismissing its complaint which sought the issuance of a design patent for the ornamental design of a pen. The district court had upheld the determination that appellant's design was so similar to the prior art as to be a minor modification rather than a new design. Judgment affirmed.

The appellant had urged that this case involved an error in law in the application of the general rule denying patentability for advances "obvious...to a person having ordinary skill in the art" (35 U.S.C., Sec. 103), without attention to the requirement that in the case of design patents, this requires a determination that the advance was obvious to the "ordinary intelligent man." Appellant relied on In re Laverne, 356 F.2d 1103 (C.C. Pa. 1966) and Schwinn Bicycle Co. v. Good-year Tire and Rubber Co., 444 F.2d 295 (9th Cir. 1970). The district court had relied on Blumcraft of Pittsburgh v. Citizens and Southern National Bank, 407 F.2d 557 (4th Cir. 1969), citing Graham v. John Deere Co., 383 U.S. 1, 17 which applied the statutory term (obviousness "to a person having ordinary skill in the art") without any special gloss to design cases.

This appellate court said that Blumcraft did not discuss Laverne but that it and Schwinn were analyzed in Hadco Products, Inc. v. Walter Kidde & Co., 462 F.2d 1265 (3rd Cir. 1972)



[cert. denied 409 U.S. 1023 (1972)]. This court specifically joined in Hadco's rejection of the approach of Laverne and Schwinn. The court added that its decision in dismissing plaintiff's complaint came down in the last analysis to a conviction that while Congress had provided for a limited monopoly to a means of enhancement of the industrial arts, it never intended to give such a monopoly to a person whose contribution could fairly be regarded as one that was obvious to a person of "ordinary skill" in the pertinent art.

Ex parte Fishback

160 U.S.P.Q. 30 (Pat. Off. Bd. App. 1968)

An appeal by the applicant, Fishback, from a decision by the Patent Office examiner rejecting a claim for "the ornamental design for a Set of sign Panel Letters, Numerals and Symbols as shown" as obvious under 35 U.S.C. 103 by virtue of prior references. The Board of Appeals reversed.

The Board explained that it appeared to it that the claimed set of symbols displayed in connection with border and background features gave a distinctive and characteristic effect supporting appellant's allegations as to design improvement over the reference appearances.

"To arrive at the design by piecemeal consideration of references using such elements in one way or another is not difficult but appears to us to be guided by appellant's disclosure rather than by a rationalization giving credence to the view that the design would be obvious to the ordinary observer working from the references alone."

Flexible Plastics Corp. v. Black Mountain Spring Water, Inc.  
357 F. Supp. 554, 176 U.S.P.Q. 227 (N.D. Cal. 1972)

Suit for infringement of plaintiff's patented design for a plastic jug. Defendant moved for summary judgment on the ground that the plaintiff's patent was invalid as a matter of law because 1) it did not involve the exercise of invention over certain prior art jugs previously patented and 2) was not ornamental. In the court's view defendant was entitled to summary judgment.

The court agreed with defendant that plaintiff's jug was not "ornamental" within the meaning of Section 171 of 35 U.S.C.



In citing and quoting from Bliss v. Gotham Industries, Inc. 316 F.2d 848 (9th Cir. 1963), which involved a pitcher to which the reaction inspired was simply that of the visual and useful and not unattractive piece of kitchenware, it observed that the remarks of the court in the Bliss case applied with equal force to plaintiff's jug. In other words, the court here reacted to the jug as simply an ordinary and useful storage container, not a thing of beauty and without the slightest appeal to the aesthetic sense.

The court explained briefly with respect to summary judgment that it is true that it is seldom used in patent cases, but that this was largely a result of technological problems which arise in litigation relating to utility as opposed to design patents and which require the assistance of expert testimony. The court concluded that this case was appropriate for summary judgment, where no technological problems were presented.

Frantz Mfg. Co., v. Phenix Mfg. Co.  
307 F. Supp. 822, 164 U.S.P.Q. 381 (E.D. Wis. 1970)

An action for patent infringement in which defendant counter-claimed for declaratory judgment of patent invalidity. Judgment for plaintiff in part and defendant in part.

The design was for an overhead aluminum garage door. There were two patents involved, one for the ornamental design, the other for a mechanical patent. As to the mechanical patent, a similar door had been sold more than one year prior to the filing (35 U.S.C., Section 102(b)), but plaintiff argued that the door sold earlier was distinguishable. The court held that the difference between the earlier door and the mechanical patent, which related solely to a process of exerting greater force, was obvious to one skilled in the art and did not attain the level of invention, hence was barred by the earlier similar invention and invalid.

The court held that the design patent was not under the same infirmity as the mechanical patent since the application for that patent was filed just a few day after the first sale of the door. Defendant had argued as to the design patent, not only that there was certain prior art but also that the Patent Office Board of Appeals was wrong in finding that it disclosed a design sufficiently creative to be patentable. In response, the court, in comparing the photographs of the Frantz design and that of the prior patent referred to by defendant, found that the Frantz design patent had met all the requirements



for design patentability. In fact something greater was required to create the "attractive appearance" which was attained in the Frantz door. As to infringement, the court found the defendant had infringed the Frantz patent by virtue of identity of appearance. Thus Frantz was entitled to injunctive relief as well as damages.

In re Garbo

48 C.C.P.A. 845, 287 F.2d 192, 129 U.S.P.Q. 72 (1961)

Appeal by Garbo from the decision of the Board of Appeals of the Patent Office sustaining the examiner's rejection of the single claim of appellant's application for a design patent, the claim being "the ornamental design for a cinematic multiple-place trainer for automotive drivers." This court affirmed. The prior reference relied on by the examiner was in Your Car Magazine, April 1954, page 43, "Behind the Wheel Training."

The court, referring as a parallel to In re Frick, 275 F. 2d 741 (47 CCPA 826) which involved a design for a mobile double ended carrier, concluded that the design at bar did not fulfill the requirements of the statute [35 U.S.C. section 171] as enunciated in the Frick case.

"This design is nothing more than the obvious result of confining the training cars into a limited enclosure in a manner to give the optimum view to each student. This result could have been produced by any one skilled in the art who had the knowledge of the reference and the well known seating arrangement and wide screen concept of theatres."

In response to appellant's argument that a design may embody functional features and still be patentable, the court remarked that the design must have an unobvious appearance distinct from that dictated solely by functional considerations, and that "we do not find this situation here."

In re Geiger & Wilfert

425 F.2d 1276, 165 U.S.P.Q. 572 (C.C.P.A. 1970)

This case pertained to an application filed in the Patent Office for a design patent relating to the "ornamental design



for an automobile of the limousine type." From the decision of the Board of Appeals of the Patent Office rejecting the claim, the applicant appealed. This court reversed.

Rejection of the application was based on the ground of double patenting by the applicant himself as to the same design as that claimed in his own patent, the application for which was filed the same day. The Board took the position that the two designs presented the same appearance.

This court did not agree with the Board, saying that manifestly the subject matter disclosed in the applicant's patent was not identical to that disclosed in the instant application, one vehicle being a sedan, the other a limousine. This court was of the opinion that the Board was in error in stating that the statutory basis for rejection was section 101, 35 U.S.C., and explained that the correct and only basis in the statute for the granting of more than one design patent for the "same invention" is section 171, 35 U.S.C., In re Thorington, 418 F.2d 528 (57 CCPA 1969); in the area of double patenting a reading of the claims alone is not enough -- a visual analysis of the drawing is required. Citing In re Vogel, 422 F. 2d 911 (57 CCPA 970), the court concluded that the subject matter claimed in the application before it was not identical to the subject matter in the patent and that the decision of the Board must be reversed.

Green Valley Products Inc. v. Sterwood Corp.  
308 F. Supp. 700, 162 U.S.P.Q. 627 (E.D.N.Y. 1969)

Action for patent infringement and an injunction, and involved here was motion for discovery which was denied.

The plaintiff sought disclosure of the name of the moldmaker employed by defendant to make the molds which were used in the manufacture of the accused items. Plaintiff's design patent covered a plastic silver-washing basket, a device which held silverware while it went through a dishwasher. Defendant claimed that the name of the mold maker was a trade secret, that disclosure would cause real prejudice and that the name was irrelevant. Plaintiff asserted that the moldmaker was a possible witness as to whether the defendant "willfully, deliberately and knowingly" copied features of plaintiff's invention as alleged in the complaint.

The court, in determining the possible risk to the moldmaker



from disclosure, said it could consider the fact that a patent suit involves issues of validity and infringement as well as damages and profits; in fact the question of knowledge or willfulness will not arise in the determination of validity or infringement. The court explained that if the issues of validity or infringement are resolved against the plaintiff it would not be necessary to reach the issues on which the moldmaker might have relevant information, hence the court decided that under the circumstances it would not compel disclosure of the moldmaker's name at this time. The motion to seek disclosure of the moldmaker's name was denied with leave to renew the matter when and if remedies for infringement are litigated.

Hadco Products, Inc. v. Walter Kidde & Co.  
462 F. 2d 1265, 174 U.S.P.Q. 358 (3d Cir.), cert. denied, 409  
U.S. 1023 (1972)

Appeal by defendant in a patent infringement case in which there had been judgment for plaintiff deciding its design patent valid and infringed. The appellate court vacated the judgment for plaintiff and declared the design patent invalid.

The design was for a lighting fixture or lantern represented to be of Old English style and was advertised and sold as the "Tudor" by Hadco. Hadco conceded that the lantern was composed of a combination of elements commonly known and extensively used in the prior art, but argued that the particular combination embodied in the "Tudor" design created an unusual and aesthetically pleasing visual impression lacking in the prior art.

The appellate court discussed section 103 of 35 U.S.C. and the method of judicial application under that section as it is explained by the Supreme Court in Graham v. John Deere Co., 338 U.S. 1 (1966). This court commented that with the addition of that section to the Patent Act of 1952, the Congress expressed its intent to shift judicial focus in determining the validity of patents by emphasizing "non-obviousness" as the operative test of the section, rather than the less definite "invention" language previously utilized by the courts; under this approach it is clear that mere distinctions between the design and the prior art are insufficient to warrant a patent. The court concluded that the Hadco lighting fixture, although novel and pleasing to the eye, did not by some slight changes over the prior art, reflect invention, but appeared "simply as an attractive variation of a well-played theme."



Horwitt v. Longines Wittnauer Watch Co.  
388 F. Supp. 1257, 185 U.S.P.Q. 123 (S.D.N.Y. 1975)

Action for patent infringement for the design of a watch face devoid of any hour indices except a single dot at the 12 o' clock position. Defendant sought a declaration that plaintiff's design patent was invalid. The design was held valid but not infringed.

In its challenge to the validity of the design patent the defendant contended that it was fully anticipated under prior art and 35 U.S.C. 103, as obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertained.

The court agreed with the conclusion of the Patent Office Board of Appeals that plaintiff's design was a concept directly contrary to the teachings of the prior art and thus would not occur to the "ordinary designer" with greater skill than that exercised by the average designer aware of the prior art, hence resulting in a unique design in no way resembling the dials relied upon by the examiner. The court discussed section 171 of Title 35 U.S.C. and the aspects relating to patentability; the design must be "new, original and ornamental;" as to ornamentality, the design must be the product of aesthetic skill and artistic conception, and "ornamentality" relates to something beautiful. This design had been recognized by the Museum of Modern Art by a special award in 1960. The court found the design valid, fulfilling all three requirements of section 171 of Title U.S.C. The court did not find infringement, however; under the test of infringement based on the eye of the "ordinary observer," the plaintiff's design and that of the infringer were not similar, plaintiff's being graced with simplicity, the defendant's ornate.

In re Hruby  
54 C.C.P.A. 1196, 373 F.2d 997, 153 U.S.P.Q. 61 (1967)

This case involved appeals from the decision of the Board of Appeals of the Patent Office, which had rejected applications for four design patents for the ornamental design for water fountains as shown and described, and the four applications were argued as one. The court reversed, the Chief Judge dissenting. Judge Rich wrote the opinion.

The sole rejection was that the claim did not define an "article of manufacture" as designated under 35 U.S.C. 171. The precise



question before the court, therefore, was whether that portion of a water fountain which is composed entirely of water in motion is within the statutory term "article of manufacture," a question of first impression without any closely analogous case.

Judge Rich, in holding that the designs for water fountains met the "article of manufacture" requirement of 35 U.S.C. 171 stated:

"It is not denied that designs exist. It is perfectly clear that these designs are of the three-dimensional or configuration-of-goods type. The 'goods' in this instance are fountains, so they are made of the only substance fountains can be made of--water. We see no necessary relation between the dependence of those designs made of water upon the means for producing them and their being articles of manufacture...."

Chief Judge Worley dissented, saying "it is inconceivable that Congress could possibly have intended Sec. 171, in letter or spirit, to allow an individual to remove from the public domain and monopolize mere sprays of water."

NOTE: A comment on this case appears in a law review article which states that the conclusion that the subject matter falls within the spirit of the design statute is questionable because In re Mygatt, 39 App. D.C. 432 (1912) was not considered, and because water fountains have never before been the subject matter of design patents. See Wigert, William J. Jr., "Patents--The Design Created by a Fountain of Water is the Proper Subject--In re Hruby, of a design patent 373 F. 2d 997 (C.C.P.A. 1967);" George Washington Law Review, Vol. 36, No. 1, (October 1967) 256-258. The author concludes that Hruby has now obtained a statutory monopoly for designs in an area never previously considered to be patentable. In view of this, it seems doubtful that Hruby correctly concluded that the spirit of the design statute was met when it extended a patent monopoly into a subject area long within the sphere of human activity, yet never before within the sphere of the patent laws. Any changes in the scope of the subject matter covered by the patent laws should be left to Congress and not the courts.

Hygienic Specialties Co. v. H.G. Salzman, Inc.  
302 F.2d 614, 133 U.S.P.Q. 96 (2d Cir. 1962), rev'g 189 F. Supp.  
790, 128 U.S.P.Q. 79 (S.D.N.Y. 1960)



Suit brought by Hygienic for patent infringement and unfair competition. From judgment for plaintiff, defendants appealed. The appellate court reversed.

The unique feature of this soap dish was a latticed tray upon which a bar of soap could rest while excess water dripped into a receptacle below. The inventor of the soap dish design had admitted that the only design element not resulting from a mechanical function was a group of horizontal lines on the side of the dish.

In the words of this court, Hygienic was required to comply with the provisions of 35 U.S.C. 171 in order to obtain "the monopoly benefits of our patent laws," and the first requirement was that the design be the result of invention. Blisscraft of Hollywood v. United Plastics Co., 394 F. 2d 694 (2d Cir. 1961). The court said that "concededly, this concept of invention is an elusive one, especially when applied to elements of design;" it concluded that it was convinced that Hygienic's soap dish clearly did not meet the statutory test of invention. Moreover, the soap dish patent was invalid for another reason; it was not ornamental; in order to qualify a design "must be the product of aesthetic skill and artistic conception." The court, mentioning the fact that the presumption of validity is rebuttable, held the design patent invalid. In dealing with the issue of unfair competition the court said that since the soap dish was not protected by a valid design patent, there was little to prevent others from producing similar articles; consumer protection had been limited to the prevention of confusion, and the plaintiff must show "secondary meaning." This had not been done here with respect to this soap dish. There was an absence of direct evidence of confusion; and this court did not infer from the facts that actual deception had occurred here nor was there "palming off." Moreover, both plaintiff's and defendants' names were displayed on their respective soap dishes.

International Silver Co. v. Julie Pomerantz, Inc.  
271 F.2d 69, 123 U.S.P.Q. 108 (2d Cir. 1959) aff'd 119 U.S.P.Q.  
461 (S.D.N.Y. 1958)

This case was summarized in the 1959 Supplement on Design Protection at page 159 (Design Patent Cases), and involved an action for infringement of a design patent for flatware. The district court had found that plaintiff's design "required



artistic concept and creative ability beyond that possessed by the ordinary skilled designer familiar with the prior art" and concluded that plaintiff's patent was valid and infringed and that plaintiff was entitled to profits and damages. International Silver Co. v. Julie Pomerantz, Inc. 119 USPQ 461 (S.D.N.Y. 1958).

On the later appeal the Second Circuit affirmed, saying that it thought the judge below did not err in his conclusion that the design in suit was not only novel, original and of genuine artistic merit but also so striking and so arresting in the effect produced as to attest the presence of a creative skill surpassing that of a routinier. The conclusion was supported, according to the court, by the preponderance of expert opinion in the case. Judge Swan concurred, saying that in recent years this court had sustained few design patents, and that had he been sitting alone he would be disposed to hold that the design of the patent in suit did not differ sufficiently from the prior art to establish that "invention" was required to create it:

"But what is 'invention' in a design is a matter upon which one can seldom reasonably hold a dogmatic opinion. My brothers are satisfied that the patent in suit is valid. While not free from doubt, I am willing to concur in their judgment."

Ex parte Jaffe

147 U.S.P.Q. 45 (Pat. Off. Bd. App. 1964)

This was an appeal from the decision of the Patent Office examiner, rejecting the claim for a design patent described as "ornamental design for a Printed Circuit Board for Frequency Shift Tone-Keyer"; in other words, the design was that of a printed circuit structure. The decision of the examiner was affirmed. There were two prior references.

The Board decided that the circuit had no ornamental features which it could fairly characterize as setting it apart as an ornamental design from the two prior references: there was no unobvious modification. The Board stated that appellant's brief did not point to any "purely ornamental characteristics which would distinguish the circuit aesthetically, as opposed to functionally" from any adequate printed circuit design: a sine qua non of patentable distinction on the basis of 35 U.S.C. 171 is that the design be ornamental. Since the



design was dictated by functional considerations, the Board sustained its examiner's rejection on this basis and also on the other ground that the object involved would be hidden in normal use, even though the printed circuit would "often" be seen when its cover was removed.

Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp.  
287 F.2d 228, 128 U.S.P.Q. 278 (9th Cir. 1961)

Action by Ajax for patent infringement in which defendant counterclaimed for declaratory judgment of patent invalidity, seeking injunctive relief. From judgment for plaintiff, defendant appealed. This court reversed.

The design patent in question was an article of metal shaped for use as a handle or drawer pull for furniture. The appellant assigned two errors: that the District Court erred in holding that the design patent was valid and erred in refusing to enjoin appellee from harrassing or annoying appellant and its customers.

The court (Per Curiam) here pointed out that there were at least six prior art references as to devices "strikingly similar" to this design, which were unknown to the Patent Office; hence the presumption of the validity of the patent was overthrown. The court commented that "frankly it seems to us that the article in question is no more than a routine design of furniture or cabinet hardware." The court explained that the lower court, although it had found that the patent was duly issued to appellee for the design for a handle, did not find or even consider in what respect the article was the recipient of the "inventive genius" necessary to the creation of a valid "design" patent; a person cannot be permitted to select an existing form and simply put it to a new use. "In other words, there must be more than mere mechanical skill and the completed article must rise above the ordinary." The court was convinced that the finding of the lower court upholding the validity of the patent was clearly erroneous by reason of anticipation of the prior art and for lack of invention. As to appellant's contention that the lower court should have enjoined appellee from harrassing appellant and its customers, the appellate court found no error in the action of the trial court in refusing a permanent injunction.



D. Klein & Son, Inc. v. Giant Umbrella Co.  
341 F. Supp. 1400, 173 U.S.P.Q. 662 (S.D.N.Y. 1972)

The keystone of this action was plaintiff's assertion of invalidity of a design patent for a dome-shaped umbrella design issued to one Kates, defendant's assignor in 1971. Plaintiff sought a declaratory judgment that the patent was invalid; defendant counterclaimed for patent infringement. Plaintiff's motion was denied.

Plaintiff had asserted that the design patent was invalid either as anticipated by prior publications (35 U.S.C., Sec. 102), or as obvious because of such prior publications (35 U.S.C. Sec. 103).

The court emphasized in this case, that there were certain unclarified facts in relation to what transpired at the Patent Office to bring this patent to its maturity: whether alleged prior publications were actually examined by the Office before granting the patent; as to nonobvious qualification; and as to how this design had been received in its respective trading market. There was also a charge by plaintiff of harassment by defendant. The court indicated that at this time there could be no fixed certainty as to the validity of the patent in suit and stated therefore that reasonable doubt on the question must be resolved in favor of the patent holder. The court did say that the claim that the "bubble" design was obvious was not borne out by defendant's counterclaim as to the record-setting sales that it was allegedly responsible for. Nevertheless, under the circumstances it felt compelled to deny summary judgment, although in design patent cases summary judgment should be utilized where possible to avoid an absurd waste of time and effort.

NOTE: A later aspect of this "dome" umbrella design patent case appeared in D. Klein & Sons Inc. v. Giant Umbrella Co. Inc. (S.D.N.Y. 1972) when defendant Giant, assignee of the patent, sought leave to file an amended and supplemental answer and counterclaim and to prosecute a counterclaim to enforce its patent as a class action, with plaintiff Klein to represent infringers as a class. The motion to conduct this case as a class action was denied. It was pointed out in that decision that there are 114 corporations or persons who are variously manufacturers, importers and retailers of umbrellas and also 22 million users who are said to be infringers of this successful dome-shaped type of umbrella of which there are different



renditions; that the question of similarity could not be successfully litigated in the class action unless a substantial number of subclasses were created. It is to be recalled that at this point the ultimate validity of the patent had not been determined.

In re Lamb

48 C.C.P.A. 817, 286 F.2d 610, 128 U.S.P.Q. 539 (1961)

This appeal from the decision of the Board of Appeals of the Patent Office involved an application for a design patent which had been rejected. The rejection was affirmed by the court.

The design was for a knife handle provided with protuberances and depressions that fitted the hand and fingers when grasped. A design patent had previously been issued to Lamb which disclosed a knife handle conforming substantially to the contour of the handle shown in the appealed application. The Board, in affirming the examiner's rejection, had been of the opinion that the designs of the reference and that of the applications were the same except that "the instant design presents a somewhat longer and slimmer version of the handle." The Board had observed that it would be "expected" that a designer skilled in the cutlery art would use a somewhat narrower or slimmer handle with a slim blade. The appellant had argued that the manner in which the slimming was done involved patentable invention and was not a mere scaling down or "miniaturization" of the patented handle such as would have been suggested to the average designer.

The appellate court did not agree; nor did it agree that the design of the application was "distinctly different" from the previously patented design: it stated that it was the appearance as a whole which must be considered, and the mere fact that there were differences over the prior art did not justify a holding that the design was patentable. A comparison with the prior reference made it clear to the court that there was not such variation as to create the impression of a new or different design, the overall appearance being the same, even though the instant design was somewhat slimmer.

Lancaster Colony Corp. v. Aldon Accessories, Ltd.

506 F.2d 1197, 184 U.S.P.Q. 193 (2d Cir.), aff'd 182 U.S.P.Q. 262 (S.D.N.Y. 1974)

Action for infringement of a patent for a design of a cigar-



holding ashtray. From summary judgment for plaintiff, defendant appealed and the Circuit Court affirmed.

Appellant contended that the ashtray design, in the form of a trapezoid, was anticipated by prior art and invalid under 35 U.S.C. §103 as obvious as a whole to a person having ordinary skill in the art. The district court had found that appellant's ashtray was virtually identical to that of appellee, the only differences being that the appellant's ashtray was smaller and its top surface inclined at approximately an 8 degree angle from the trough end while the top surface of appellee's ashtray was parallel to its base.

As the appellate court stated, the only issue on appeal was the validity of the patent, and indicated that the case seemed to it, as it had to the district court, "a close case." Referring to the holding of this court in G.B. Lewis Co. v. Gould Products, Inc., 436 F.2d 1176 (2d Cir. 1971), that §103 was intended simply to codify the existing precedents (see Graham v. John Deere Co., 383 U.S. 1, 17 (1966), which applied the teaching of the principal precedent to design patents, Hotchkiss v. Greenwood, 52 U.S. (11 How.) 248 (1851)) to the effect that the requirement of invention is not met by a design which is merely "new and pleasing enough to catch the trade;" and that rather we have insisted that the design reflect "some exceptional talent beyond the skill of the ordinary designer:" the court here found that this design reflected such a talent, and advance over the prior art, and though only a simple cigar ashtray was an aesthetically pleasing design. The court also referred to the commercial success of the design, "which is an otherwise close case might tip the scales."

In re Lapworth

451 F.2d 1094, 172 U.S.P.Q. 129 (C.C.P.A. 1971)

This case related to an application for a design patent which was rejected by the Patent Office examiner. The Patent Office Board of Appeals affirmed. The applicant appealed to the Court of Customs and Patent Appeals and the decision was again affirmed.

The design was for a "Sailboat," but the design pertained only to the hull portion which was designated as the "CAL-36." The rejection was based on a single reference, another sailboat



of appellant's design designated as the "CAL-40", a description of which had been published in a 1964 issue of "Popular Boating". The basis for the rejection was that the CAL-36 was unpatentable over the CAL-40 reference under 35 U.S.C. 103, the differences between the two designs being insubstantial in effect. In this court appellant relied on In re Laverne, 53 CCPA 1158, 356 F.2d 1003 (1966) which he said "stands on all fours" with the present case, and urged that the Board had not applied the law as delineated in Laverne.

Judge Rich did not agree, but did agree with the Board, and drove his determining comments home by saying:

"The argument repeatedly made is that CAL-40 'provides a feeling of a flat, powerful racing platform' whereas CAL-36 'is a more graceful, fuller and finer racing--cruising yacht.' We think we get the point of this combination of wishful thinking, advocacy and salesmanship, but from the standpoint of design patentability the [comparative] illustrations [shown] bring us back to reality and persuade us of the correctness of the decision alone, which is affirmed."

In re Laverne & Laverne  
356 F.2d 1003, 148 U.S.P.Q. 674 (C.C.P.A. 1966)

Appeal from the decision of the Patent Office Board of Appeals affirming the rejection of an application for the design for a chair. The decision of the Board was reversed.

The sole issue was that of obviousness of appellants' design under 35 U.S.C. section 103 in view of the single reference relied on by the Board, the design patent to Eero Saarinen in 1958. Neither the examiner nor the Board had referred to any statutory ground of rejection. Appellants' chair and the Saarinen chair were of the same general type, each consisting of a one-piece molded seat supported on a pedestal (the latter being no part of the design claimed), a back and sides. It was the examiner's position that the chair disclosed and claimed was substantially similar in overall appearance to the Saarinen chair and as such possessed no patentable merit thereover. The Board had affirmed.



The court, after referring to 35 U.S.C., sections 171 (patents for designs) and 103 (obviousness over prior art) stated that under section 103 we must, according to Judge Rich, determine obviousness to the "ordinary intelligent man"; the test being inherently a visual test, for the design is nothing more than appearance, and the appearance is that of the article as a whole; it is bound to be an individual reaction. Finally, the court, having studied appellants' and Saarinen's drawings and tried to visualize what their chairs would look like in real life, concluded that under the statutory test, appellants' chair design would not be obvious from Saarinen's: any differences "result in a new and ornamental design which would not be obvious from the prior art." The court added that the design which initiates a new style does not automatically close the field to all other designs within the same style pattern or style trend.

Ex parte Levinn  
136 U.S.P.Q. 606 (Pat. Off. Bd. App. 1962)

This case involved an application for a design patent for an ornamental design for a thermostatic switch. There were three prior references. The application was rejected by the Patent Office and Levinn appealed. Reversed by the Patent Office Board of Appeals.

The appealed claim was rejected as being functional rather than ornamental, hence unpatentable as a design. The examiner had stated that since the nature of bimetallic thermostatic switches had long been known to those skilled in the art, it was not thought that appellant had done anything unobvious in making certain riveting changes involving a switch point on a block of insulating material.

The Board failed to see any merit in the examiner's position: and stated that a thermostatic switch may be proper subject matter of a design patent, even though it has a mechanical function, unless the design is wholly or substantially dictated by the mechanical function to be performed. The point was further made that the examiner had not established, as suggested to the contrary, that appellant's thermostatic switch was intended to be hidden from view when in use. Stating that the examiner's rejection appeared to be in error in all respects, it could not, according to the Board, be sustained.



G.B. Lewis v. Gould Products, Inc.

436 F.2d 1176, 168 U.S.P.Q. 386 (2d Cir. 1971), aff'g 297 F. Supp. 690, 160 U.S.P.Q. 311 (E.D.N.Y. 1968)

Suit in which plaintiff claimed patent infringement by defendant for a design which embodied a combination of plastic bins and incorporated a rectangular plastic box open at the top. Defendant sought summary judgment that the patent was invalid. From judgment for defendant plaintiff appealed. Affirmed.

The appellate court, in affirming the judgment, cited Graham v. John Deere Co., 386 U.S. 1 (1966) and section 103, 35 U.S.C. in support of the view that the design was obvious. In reference to the utilization of old elements in combination, the court cited Blisscraft of Hollywood v. United Plastics Co., 294 F. 2d 694, 696 (2d Cir. 1961) to the effect that the combination must represent an exercise of creative talent beyond that of the ordinary designer chargeable with knowledge of the prior art. The court referred to the fact that plaintiff had argued that he should have been permitted to present expert witnesses, and that summary judgment was not appropriate because there were issues of fact. In response, the court took the position that this argument would have more force if the case were dealing with complex technical achievements: here the subject-matter was a design patent whose essential claim lies in the originality of the visual impression.

In re Marti & Braunschweig

359 F.2d 900, 149 U.S.P.Q. 534 (C.C.P.A. 1966)

Appeal from the decision of the Board of Appeals of the Patent Office. Reversed in favor of the applicants.

Applicants had applied for a design patent for a "Timepiece Dial," an "ornamental design," as shown by drawings in three embodiments; they were required to elect and did so. There was only one reference, that of Cohen. Appellants' drawings of its designs showed the hour indicia in one of them as round dots which grew progressively larger as they circled the dial; in another drawing the hour dots were square and grew larger as they proceeded around the dial; in the third drawing the hour dots were sticklike and showed less variation in size. The Cohen dial presented what appeared to be an abacus arrangement on the dial and the hour numbering was



conventional; its appearance was entirely different from that of the applicants.

The court decided here that the Board had erred in rejecting the claim and in abstracting a "concept" from appellants' three embodiments, then searching for and applying in a rejection what it considered to be a common concept which it found in the Cohen reference. Judge Martin explained that applicants were not attempting to claim a concept, but merely a claim covering several appearances; there seemed to be no question that in overall appearance applicants' dials were so dissimilar from that of the Cohen reference as to be non-obvious in the design sense, requiring reversal of the decision of the Board to reject the application. In other words, the two designs of appellants and of Cohen for a Time-piece Dial "simply do not look enough alike to support the appealed rejection," and there was no anticipation of appellants' designs.

In re McKay

50 C.C.P.A. 1257, 316 F.2d 952, 137 U.S.P.Q. 558 (1963)

In this case McKay applied for a design patent for a "Lint Remover." The application was rejected and the Patent Office Board of Appeals affirmed the examiner's rejection, as lacking invention. McKay appealed and this court reversed.

There were two prior references, but appellant contended that he had created a lint remover design which was aesthetically pleasing and which imparted "an unexpected dramatic flair to an otherwise commonplace household article." He urged that the prior art disclosed "solid, bulky, unitary designs" in which the handle and body portions tended to merge together and that it was not obvious from them to achieve either the "unique open-end hollow shell-like handle" or the "unique size-contrasting counter-balance design configuration" of his device.

The court first pointed out that in determining whether a design is patentable, the design as a whole, and the impression it makes on the eye must be considered. In re Jennings 182 F.2d 207, 37 CCPA 1023 (1950). After considering the prior references and comparing McKay's design, the court, in reversing the Board, concluded that the proportions of the components of appellant's device, along with the trim appearance resulting from the utilization of straight-line effects and, parti-



cularly, the hollow, thin-walled handle, resulted in a new and ornamental design which would not be obvious from the prior art.

Chief Judge Worley dissented, remarking that "surely the minor, indeed almost insignificant, modification appellant makes in the prior art would be obvious to one of ordinary skill and thus falls far short of patentable dignity."

Patriarca Mfg., Inc. v. Sosnick  
278 F.2d 389, 125 U.S.P.Q. 260 (9th Cir. 1960), aff'g 169 F. Supp. 204, 120 U.S.P.Q. 143 (N.D. Cal. 1958)

An appeal by Patriarca from a judgment for defendants in an action for infringement of a design patent. The appellate court affirmed.

The design was that of a showcase used principally in the display of cigars, a "Self-Service Display Container." The district court had ruled that the design was lacking in invention and the sole question raised was the patentability of the design. There was a reference ("Royal") as an example of prior art. The appellants, in differentiating their design from the prior art reference, argued in essence that the lower front wall of the Royal cabinet "sets up a barrier to sales, while plaintiffs' wall invites the customer to buy."

The appellate court concluded that the patented showcase embodied nothing new, explaining however that although the patented showcase marked an advance in matters of design, not every advance is the result of creative invention. "Appellants have happily combined matters of prior art into a pleasing assemblage. They may be credited with good taste and a sound sense of proportion, but not with creative invention."

Payne Metal Enterprises, Ltd. v. McPhee  
382 F.2d 541, 155 U.S.P.Q. 123 (9th Cir. 1967)

An action by plaintiffs for declaratory judgment of patent invalidity and non-infringement with respect to the McPhee design patent, which was for a liquor pourer. From judgment for defendants, plaintiffs appealed. The appellate court reversed, adjudging the patent invalid.

The main allegedly unique feature which McPhee contended lent an inventive quality to his patent as a whole, was the "pinched-



in waistline" which was formed at the point where the body of the pouring device joined the flared or tapered skirt. The waistline effect was not produced in prior patents because the skirts in those patents extended straight down from the body of the pouring device. McPhee's testimony showed that the basic purpose of the flared skirt was for ease of construction of the pouring device and not to enhance the aesthetic quality of the design. There were before the Patent Office references which included a prior McPhee mechanical patent, "Liquid Dispenser for Bottles." The trial court had found that the McPhee design patent disclosed a design that involved "invention which was not obvious to those having ordinary skill in the art in view of the prior art," and it concluded that the McPhee patent was valid.

The appellate court stated that the ultimate question here was whether the changes over the prior art resulted in an appearance of the design as a whole which would have been obvious. 35 U.S.C. 103, 171 (1964). The court concluded that the flaring of the skirt to produce a waistlike effect, would have been obvious to a person having ordinary skill in the art. In other words, commented the court, "any pleasing aesthetic effect was a minor windfall." The court held that the trial court erred in failing to declare the McPhee invalid under the terms of the governing statutes; it therefore did not reach the question of infringement.

Popeil Bros. Inc. v. Morris  
176 U.S.P.Q. 353 (D.N.J. 1972)

Action for patent infringement of two patents, relating to both mechanical and design patents of plaintiff's "Trimcomb," a combination hair cutter and shaver; also for charges of unfair competition through the sale and promotion of a similar device at a lower price (15 U.S.C. 1125). Defendants denied infringement and counterclaimed. Judgment for defendants as to patent infringement; judgment for plaintiff as to action under 15 U.S.C. 1125.

The hair trimmer is a hand held device intended to eliminate costly haircuts. It was much advertised on TV and was a success until defendants marketed their "Home Barber," when plaintiff's market was undersold and collapsed.

Plaintiff's mechanical patent was adjudged invalid by the court as obvious under section 103, 35 U.S.C. As to the



design patent in issue, the court said that the standards for validation closely parallel those for mechanical patents and it must be ornamental. Based on the earlier determinations as to what guidelines should be followed, this court was not persuaded that the use of the electric shaver motif was such an aesthetic accomplishment that it should be rewarded with a patent. Nevertheless, the court considered that the patent claims in suit had been infringed.

As to the issue of unfair competition under the Lanham Act, 15 U.S.C. 1125, the court found that defendants had violated that statute through their representations in connection with plaintiff's television advertising and the sale of the hair trimming devices and should be enjoined from activities such as those alleged to end customer confusion. The court did not feel money damages were necessary.

Rains v. Niaqua, Inc.

406 F.2d 275, 160 U.S.P.Q. 370 (2d Cir. 1969), aff'g 282 F. Supp. 383, 157 U.S.P.Q. 695 (W.D.N.Y. 1968)

Plaintiff Rains appealed from an adverse judgment in his patent infringement action against defendant. The district court had held the patent invalid and not infringed. Affirmed.

The design dealt with the appearance of an above ground as distinguished from an inground or excavated swimming pool. One of the prior references showed a photograph of a pool known in the trade as the "Esther Williams" pool which apparently was the first above ground redwood-type swimming pool to be widely marketed in this country; it revealed an above ground rectangular pool with an elevated deck and vertical fence with redwood weave intersposed between posts, rendering the pool invisible.

The appellate court stated that the question before it was whether the trial court was wrong in concluding that plaintiff's design would have been obvious under 35 U.S.C. Section 103 to "the ordinary designer who is chargeable with knowledge of the prior art," and that it was aided by the guide laid down by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1 (1966). Thus plaintiff's design was seen by the court to be a mere adaptation of the similar redwood type pools of the prior art. Plaintiff in this case pointed to a recent decision of the Third Circuit which overruled a trial court finding



that plaintiff's patent was invalid. Rains v. Cascade Industries, Inc., 402 F. 2d 241 (3d Cir. 1968). As explained by the court here, in that case the Third Circuit held that the existence of factual issues made the lower court grant of summary judgment inappropriate, while here there has been a judgment after trial; therefore on that basis Cascade is technically distinguishable -- but only barely -- and not an adequate response to plaintiff's reliance on it. This court, in any event, stated that it would agree with the trial judge in Cascade and the dissenting member of the Court of Appeals panel.

NOTE: In view of the discussion in the instant case, (Rains v. Niaqua) of Rains v. Cascade *supra*, the latter case relating to the same Rains patent is not presented in this bibliography.

In re Schilling

421 F.2d 747, 164 U.S.P.Q. 576 (C.C.P.A. 1970)

An appeal from the decision of the Board of Appeals of the Patent Office rejecting an application for a patent of a design of which the claim read "the ornamental design for a tumbler." The appellate court affirmed. Judge Rich dissented.

The appellant stated that his tumbler was primarily a plastic receptacle designed as a disposal drinking glass, originally designed for air line use; an important feature, he said, is "superior stackability." The examiner rejected the claim as unpatentable over two prior references under 35 U.S.C. 103. The Board affirmed. Appellant contended that the Board had erred in failing to follow In re Laverne, 356 F. 2d 1003 (53 CCPA 1158 (1966)), in which, according to appellant Schilling, the court felt that "what we have to do is determine obviousness to the ordinary intelligent man. That test is inherently a visual test, for the design is nothing more than appearance, and the appearance is that of the article as a whole."

The present court, disagreeing with appellant, stated that the Board had not erred, and that its decision was not contrary to the view expressed in Laverne, adding that the alleged superior stackability of the tumbler did not lend patentable weight to the design, since it must have an unobvious appearance distinct from that dictated solely by functional considerations.



Judge Rich in his dissent took the view that the majority decision was wrong because it failed to follow the reasoning of the unanimous opinion in Laverne, while acknowledging it as a viable precedent. Judge Rich said that the references here were not half as good as was the single reference in Laverne; what the examiner and the Board here were doing was hindsight redesigning or new designing to reconstruct Schilling's design out of elements he could find in prior art objects, after analyzing appellant's design. Judge Rich thus found, "beyond question," even more clearly than in Laverne, the "distinctly different appearance" of the Schilling design and that the majority had disregarded the "appearance as a whole" which must be considered.

Schnadig Corp. v. Gaines Mfg. Co.  
494 F.2d 383, 181 U.S.P.Q. 417 (6th Cir. 1974), aff'g 177 U.S.P.Q. 313 (W.D. Tenn. 1973)

Action for patent infringement of a design for a sofa. From judgment for plaintiff, defendant appealed on the principle grounds that the patent was anticipated by and obvious over the prior art, and that there was no infringement. Affirmed, patent held valid and infringed.

The design was for a "Sectional Sofa," L-shaped or "corner-type," described broadly as of Spanish style, the overall effect of which was "warm and inviting as opposed to the cold, harsh lines of traditional Spanish style sofas."

The appellate court agreed with the district court that the patented design was not anticipated by the prior art. With respect to the issue of obviousness the court referred to Graham v. John Deere Co., 383 U.S. 1 (1966), a landmark patent case outlining the section 103, (35 U.S.C.) condition and sub-conditions as to scope of the prior art, the differences between it and the claims at issue, and the level of ordinary skill in the pertinent art. The appellate court states that these factors had been considered and, referring to 35 U.S.C. 171, also agreed that the design was a new concept distinctively different from the prior art in overall shape, form and appearance, that is, the "tout ensemble." Re-emphasizing the fact that the differences between defendant's sofa and the plaintiff's were minor and would appear substantially identical in the eye of an ordinary observer, the court affirmed that there had been infringement by defendant.



Schwinn Bicycle Co. v. Goodyear Tire & Rubber Co.  
444 F.2d 295, 168 U.S.P.Q. 258 (9th Cir. 1970), aff'g 160 U.S.P.Q.  
587 (N.D. Cal. 1969)

This appeal affirmed a judgment for defendant against whom plaintiff had brought suit for infringement of a design patent for a bicycle seat and strut assembly. The district court had decided that the design was anticipated under prior art and obvious under section 103 of 35 U.S.C.

The appellate court agreed that the approach of Graham v. John Deere 386 U.S. 1 (1966) was equally applicable in this case; it discussed the question of the level of ordinary skill in the art and referred to In re Laverne 356 F.2d 1003 (CCPA 1966). That case, according to this court, had rejected the suggestion that the pertinent inquiry was to the "expected skill of a competent designer" and reaffirmed its view that the determination must be "obviousness to the ordinary intelligent man." The present court noted that there was a presumption of validity of a patent where the Patent Office had considered prior art, and their expertise was to be considered, but that was not conclusive here. The eyes of this court, as did the eyes of the district court, saw this design and the prior art through the eyes of the ordinary observer and concluded that plaintiff could not prevail here. Moreover, if the design were valid, it was not infringed since its appearance was not the same as or substantially the same as that of defendant in appearance.

Scovill Mfg. Co. v. Roto Broil Corp. of America  
304 F. Supp. 834, 162 U.S.P.Q. 341 (E.D.N.Y. 1969)

Action for infringement of a design patent for a power-operated knife, and for unfair competition arising from the alleged unauthorized use by defendant of the phrase "the knife with the hole in the handle" adopted by plaintiff in its advertising to promote the sale of the product. Defendant had counter-claimed. Judgment for defendant.

Defendant contended that the patent was invalid, and that it had been anticipated; denied that its design was unique or distinctive, and asserted that the patent was invalid and void. The statutes referred to as applicable were 35 U.S.C. 102 (invention published more than one year prior to the date of the application for patent in the U.S.); section 103 (conditions for patentability, non-obvious subject matter; section 171



(patents for designs); and section 282 (presumption of validity).

The court stated that "to merit a patent and a consequent monopoly the idea must be original as well as ornamental." Graham v. John Deere Co., 383 U.S. 1 (1966). It was the court's conclusion that what the plaintiff claimed in its design patent was really functionality; the design was not new, original and ornamental under section 171. With respect to unfair competition and use of plaintiff's slogan relating to the knife with the hole in the handle, there was no proof that defendant had used the phrase nor induced any of its customers to do so; moreover, plaintiff's slogan could hardly be said to have acquired a secondary meaning in view of the brief existence of the knife on the market. Defendant's counterclaim for declaratory judgment was granted. Costs and reasonable counsel fees were denied since the court believed plaintiff's action was brought in good faith.

Ex parte Smith

160 U.S.P.Q. 32 (Pat. Off. Bd. App. 1968)

An appeal from the final rejection of an application for the ornamental design for an aircraft, in which the Patent Office Board of Appeals reversed the decision of the examiner.

The design claim was rejected as unpatentable over previous references including a "Grand Commander" and a "Jet Commander." The applicant urged that its design was distinctive over the Grand Commander design, and that the examiner had fabricated a design guided by applicant's disclosure, rather than by what would have been obvious to workers of ordinary skill in the art working from the reference.

The Board of Appeals supported appellant's position and said significantly:

"In a highly developed field where mechanical considerations direct basic relationships, the field of appearance improvement by design changes appears to us to require that detailed attention be given to features as pointed out by appellant to be distinctive of the claimed design. It appears to us that the appearance so created is distinctive in the field and to create it by selection of features from several



references is not an acceptable basis for anticipation. We find no plane in the references which has the same over-all appearance and do not agree that the changes detailed by the examiner for the Grand Commander design can properly be held 'obvious'."

Spaulding v. Guardian Light Co.  
267 F.2d 111, 121 U.S.P.Q. 288 (7th Cir. 1959), aff'g 170 F. Supp. 679, 120 U.S.P.Q. 215 (N.D. Ill. 1958)

Suit was for infringement of a design patent to Spaulding on a design for a "Fluorescent Lighting Fixture." Defendant had filed a counterclaim for a declaratory judgment of invalidity and non-infringement. On appeal the judgment was affirmed.

The patent disclosed a lighting fixture in the form of a housing for lighting equipment; that is, a plain unornamented geometrical configuration. When these lighting fixtures were installed at filling stations in the usual manner, they rested on tall pipes or standards, usually nine feet above ground level. The district court had held that if the patent were valid, defendant infringed, but further held that the patent was invalid.

This court did not agree with the district court that the patent was invalid on the ground that it lacked patentable novelty, originality and design invention over the prior art, but it did agree with its other finding that plaintiff's design patent in suit was invalid on the ground that it was functional and utilitarian rather than ornamental. The court pointed out that plaintiff had advertised its fixture as throwing "MORE light over a WIDER AREA." As a result the court concluded that:

"This advertisement gave the impression that the fifteen degree angle arrangement of the glass side bottom panels was patented. Of course, plaintiff has or had no patent on that feature....The design of the fluorescent lighting fixture...represents merely the expected skill of designers and mechanics working in the art and did not represent design invention."



In re Swett

464 F.2d 1399, 175 U.S.P.Q. 102 (C.C.P.A. 1972)

Appeal from the decision of the Board of Appeals of the Patent Office which related to an application for a design patent entitled "Storage Container for Lettuce or the Like" which was rejected. Reversed.

Other references had been considered by the Patent Office, one having appeared in a catalog as an advertisement in the Housewares Review, another in a catalog displaying "refrigerator" bowls. Both types of bowls had sealing covers, but the covers did not have the domed central portion of the design at bar.

In considering the prior art submitted, the court's opinion was that the design at bar created a distinct and different impression. Turning to detail, it pointed out that the raised portion of the covers of the containers in the Housewares Review is completely flat, and remarked that it no more suggests a "dome" than the roof of the Kennedy Center suggests the roof of the Capitol. The court in further comments said, that whether or not the doctrine of "analogous arts" is applicable in any manner to design patents, we think that the references relied on here are not "so related that the appearance of certain ornamental features in one would suggest the application of these features to the other." In re Glavis, 43 CC Pa. 797, 801, 230 F.2d 447 (1956).

Judge Rich dissented and would affirm, stating that in his view the claimed design was obvious in view of the references. Judge Maletz also dissented, feeling that the prior references were sufficiently related so that the appearance of certain ornamental features would suggest application of those features to the design at bar [In re Glavis, supra].

In re Talbott

443 F.2d 1397, 170 U.S.P.Q. 281 (C.C.P.A. 1971)

This case involved an application for a design patent for a rear view mirror for automobiles. It was refused and this court affirmed.

This case involved for the first time the question whether the registration of an industrial design (Geschmacksmuster) under the laws of Germany may be considered for purposes of applying



the statutory time bar of 35 U.S.C. 102(d) and 172 against an application for a United States design patent on the same subject matter. Also for the first time was the ancillary issue, to be decided only if the first question is answered in the affirmative, whether an applicant may avoid the statutory bar by keeping the subject matter of the German grant in secrecy, that is, not available for public inspection until after his U.S. application has been filed. The appellant took the position that it is error to consider the Geschmacksmuster registration in Germany as satisfying section 102(d) that the claimed invention be "patented...in a foreign country," because there is a difference between the nature of the rights obtained by the German grant and those in the grant of a U.S. design patent. Thus appellant argued that the Geschmacksmuster should not be regarded as a "patent" right, since it is more in the nature of copyright and could not have been contemplated as within the scope of section 102(d). Appellant also argued that since the registration in Germany was kept secret, such secret "patents" (even if held to be "patents" under section 102(d)) may not be used as references under 35 U.S.C. 102(a) and should be similarly excluded.

This court adopted the decision of the Patent Office and of the Board of Appeals, stressing that the issues raised by appellant were also raised in Ex parte Weiss, 159 USPQ 122 (Pat. Off. Bd. App. 1967) and fully discussed there. This court said that "we agree with the board that 'it is sufficient if the inventor receives from the foreign country the exclusive privilege that its law provides for.'"

Tappan Co. v. General Motors Corp.  
380 F.2d 888, 154 U.S.P.Q. 561 (6th Cir. 1967), aff'g 245 F. Supp. 972, 147 U.S.P.Q. 67 (N.D. Ohio 1965) and 248 F. Supp. 978, 148 U.S.P.Q. 344 (N.D. Ohio 1965)

An action for patent infringement and unfair competition.  
From judgment for defendants, plaintiff appealed. Affirmed.

The two design patents involved here covered the design for two similar electric cooking ranges generally referred to as free-standing, high oven models, the oven units being arranged above the surface burners unlike the conventional range, positioned approximately at eye level. The more important model of the two was the Tappan "Fabulous 400" range. Its



initial prosperity was cut short by the introduction of the General Electric range, "Flair."

The appellate court pointed out that the district court had not reached the question of the validity of the patents, ruling only that the patents had not been infringed; however, the court did not feel that Tappan had been prejudiced by the district court's present disposition of the case based on its careful evaluation of the infringement evidence, the test of infringement having been established by the Supreme Court in Gorham Co. v. White, 81 U.S. (14 Wall.) 511 (1871). The court, mindful of the legal test of overall appearance to the average observer, went on to say that while any one of the differences between the "Flair" and "Fabulous 400" might not serve to differentiate the two designs, their total effect resulted in an appearance different from the disclosures of the Tappan patent. The appellate court also affirmed on the issue of unfair competition, the district court having based its judgment on the theory that Sears and Compco extended even to cases where the patent had not yet been invalidated and still retained its presumption of validity: thus to allow relief under state law would run counter to the paramount federal decision of protection. This court also disposed of Tappan's contention that the case came within the "exception" to the Sears rule in claiming relief from defendants' product confusion, since defendants' "Flair" ranges were conspicuously marked with General Motors, Frigidaire and Flair names and trademarks before being offered to the public.

Ex parte Weiss

159 U.S.P.Q. 122 (Pat. Off. Bd. App. 1967)

An appeal from the final rejection of the claim in an application for a patent for a design of a "Coffee Grinder." The rejection was affirmed by the Patent Office Board of Appeals.

The design of the same article was registered in Germany by appellant on June 12, 1964, and since that date more than six months had expired prior to the filing of the present application (May 26, 1965), therefore barred by 35 U.S.C. sections 102(d) and 172. The appellant raised two issues in regard to the rejection: one relating to the nature of the rights secured by the registration of a design in Germany, the other to the argument that a secret patent cannot be used against an applicant.



Mr. Federico, the Examiner in Chief who wrote the opinion on this appeal, explained as to the first issue that there can be no argument that the rights conferred or protected by the design registration in Germany are "exclusive rights;" the Constitution of the United States gives the power to Congress of "securing to authors and inventors the exclusive rights to their respective writings and discoveries," and the rights under the United States copyright law must be regarded as exclusive rights: Mr. Federico further explained:

"In connection with the interpretation and application of 35 U.S.C. 119 and 172....Applications for design patents in the United States routinely refer to the prior filing of an application for a design registration in a foreign country without distinguishing the term 'patent,' and claim...priority under 35 U.S.C. 119 of such applications....We see no good reason for adopting a different rule in connection with foreign applications for design registrations and design registrations under 102(d) and 172, than has been and is the practice under 119 and 172."

As to the second issue, Mr. Federico found it not relevant to the situation under German law and in this case, and affirmed.

In re Wise

52 .C.C.P.A. 936, 340 F.2d 982, 144 U.S.P.Q. 354 (1965)

Appeal from the decision of the Board of Appeals of the Patent Office. Affirmed.

Wise had applied to the Patent Office for a design patent for the "ornamental design for a promotional advertising souvenir," which disclosed an object within a hollow teardrop shape. The Board rejected the design as obvious under 35 U.S.C. 103. There were prior references, and appellant conceded that she had utilized a teardrop shape in creating her design; but she asserted that she had gone a step forward by adding an advertising object within the hollow interior of the teardrop shape and that the fact that the interior object was shown in broken lines (in the drawing) did not mean that it had no significance in determining design patentability. The Manual of Patent Examining Procedure (section 1503.02) provides that a dotted or broken line is employed to show that such portions of the article claimed are not important, that it



should be explained in the specification by a statement that the dominant features of the design reside in the portions shown in full lines [i.e. the outline of the teardrop shape]; such statement was included here as was the language that the dotted line portion was an "immaterial part of the design," and the Board so regarded it.

The court agreed that appellant's claimed design patent was obvious in view of the cited art, a "mere simulation of that which has long been known as conventional."

In re Yardley  
493 F.2d 1389, 181 U.S.P.Q. 331 (C.C.P.A. 1974)

Appeal from the decision of the Patent Office Board of Appeals affirming the examiner's rejections of the claim based on 1) obviousness under 35 U.S.C., Section 103 and 2) estoppel in view of prior copyright registrations. The Court of Customs and Patent Appeals reversed.

This case involved an application to the Patent Office for a design patent for an ornamental design for a watch on the face of which is displayed hour numerals and a caricatured figure of Spiro Agnew. Extended arms and hands of the figure serve as the hour and minute hands of the watch.

As to the rejection on the basis of obviousness, the court on appeal did not agree that it was obvious under section 103 to derive appellant's specific design from that shown in a mentioned prior design of a human figure that was completely dissimilar.

As to the rejection based on estoppel in view of the prior copyright registrations, the court discussed the question of an area of overlap as to statutory subject matter under the copyright act and under the design patent statute. The court said that this court had cited Mazer v. Stein in In re Deister Concentrator Co., Inc. 289 F.2d 496, 500 (CCPA 1961) as recognizing an area of overlap, but stated here that it believed that the "election of protection" doctrine is in direct conflict with the clear intent of Congress manifested in the two statutory provisions, the Congress not providing that an author-inventor must elect between securing a copyright or securing a design patent. Moreover, with reference to Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964), the court said that Sears related to a situation where the article copied involved neither a federal patent nor a copyright.



E. Significant Patent Cases

Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation

402 U.S. 313 (1971), vacating & remanding 422 F.2d 769, 164 U.S.P.Q. 545 (7th Cir. 1970)

Action by the Foundation for patent infringement suits relating to its patent for "Frequency Independent Unidirectional Antennas." Defendant counterclaimed for unfair competition, violation of anti-trust laws.

The antennas were designed for transmission and reception of electromagnetic radio frequency signals used in many types of communications, including the broadcasting of radio and television signals.

The Eighth Circuit first ruled the patent invalid and thereafter the Seventh Circuit, on the basis of an independent analysis, affirmed the Illinois District Court's ruling that the patent was valid. Faced with these obviously inconsistent determinations, the Supreme Court nevertheless ruled that the earlier judgment of invalidity could bind the later suit, regardless of which was "correct."

In the course of the opinion of the Supreme Court, two questions not raised in the petition for review were indicated: (1) Should the holding of Triplett v. Lowell, 297 U.S. 638 (1936), that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to? (2) If not, does the determination of invalidity in the Winegard litigation bind the respondents in this case? [University of Illinois Foundation v. Winegard Co., 271 F. Supp. 412 (S.D. Iowa 1967), in which the patent involved was held invalid.]

This Court's holding in Triplett, that a determination of patent invalidity is not res judicata against the patentee in subsequent litigation against a different defendant, was overruled to the extent that it foreclosed an estoppel plea by one facing a charge of infringement of a patent that has once been declared invalid; and in this infringement suit where, because of Triplett, petitioner did not plead estoppel and the patentee had no opportunity to challenge the appropriateness of such a plea, the parties should be allowed to amend



their pleadings and introduce evidence on the estoppel issue. The judgment of the Court of Appeals was therefore vacated, and the cause remanded to the District Court for further proceedings consistent with this opinion.

Graham v. John Deere Co. of Kansas City  
383 U.S. 1, 148 U.S.P.Q. 459 (1966), aff'g 333 F.2d 529, 142 U.S.P.Q. 243 (8th Cir. 1964)

This suit by petitioners presented a conflict between two Circuits over the validity of a patent on a "clamp for vibrating Shank Plows." The invention, a combination of old mechanical elements, involved a device designed to absorb shock from plowshanks as they plow through rocky soil and thus prevent damage to the plow. In 1955 the Fifth Circuit had held that patent valid under its rule that when a combination produces an "old result in a cheaper and otherwise more advantageous way" it is patentable. In 1964 the Eighth Circuit held in the case at bar, that there was no new result in the patented combination and that the patent was, therefore, not valid. The Supreme Court granted certiorari, and concluded that the patent was invalid under section 103, 35 U.S.C., affirming the judgment of the Eighth Circuit.

"The questions involved in each of the companion cases before us are what effect the 1952 Act had upon traditional statutory and judicial tests of patentability and what definitive tests are now required. We have concluded that the 1952 Act was intended to codify judicial precedents embracing the principle long ago announced by this court in Hotchkiss v. Greenwood, 11 How. 248 (1851), and that, while the clear language of section 103 places emphasis on an inquiry into obviousness, the general level of innovation necessary to sustain patentability remains the same."

NOTE: There were two cases considered by the Supreme Court here: the other for a Scoggin Pump-Type Liquid Sprayer, Calmer, Inc. v. Cook Chemical Co. and Colgate Palmolive Co. v. Cook Chemical Co., but only the John Deere case is stressed here.

Lear, Inc. v. Adkins  
395 U.S. 653, 162 U.S.P.Q. 1 (1969), vacating 67 Cal.2d 882, 435 P.2d 321, 156 U.S.P.Q. 258 (1967)

An action by Adkins against Lear for royalties under a patent



license. On writ of certiorari to review judgment for plaintiff, the judgment of the California Supreme Court was vacated by the U.S. Supreme Court, and the case was remanded to the California Supreme Court.

Adkins was an inventor and mechanical engineer, and in 1953 was hired by Lear to develop a gyroscope. Lear and Adkins had made an agreement to grant Lear a license as to all ideas he might develop "on a mutually satisfactory royalty basis." In 1954 Adkins filed an application with the Patent Office, and a more definitive agreement with Lear was made in 1955 in which the parties agreed that "if the United States Patent Office refuses to issue a patent...or it is subsequently held invalid then...Lear at its option shall have the right forthwith to terminate." Adkins did not obtain a patent until January 5, 1960, six years after the date of his first application. The agreement was terminated in 1959, and Adkins brought suit in the California courts, arguing that the gyros incorporated his patented apparatus and that Lear's failure to pay royalties was a breach of the 1955 contract and of Lear's quasi-contractual obligations. Lear sought to raise patent invalidity as a defense. When the case reached the California Supreme Court, it rejected the Court of Appeals' conclusion that the 1955 license gave Lear the right to terminate its royalty obligations in 1959, and concluded that the doctrine of estoppel barred Lear from questioning the propriety of the Patent Office's grant. (67 Cal. 2d et 907).

Justice Harlan discussed at some length the doctrine of estoppel and its history in the Supreme Court, referring to the revival of the doctrine in Automatic Radio Manufacturing Co. v. Hazeltine Research, Inc., 339 U.S. 827 (1950), which declared that licensee estoppel "was the general rule." He concluded that; Hazeltine "is now overruled." Justice Harlan pointed out, however, that in this case a problem arose out of the fact that Lear obtained its license in 1955, more than four years before Adkins received his 1960 patent. Hence, at the core of this case was the difficult question whether federal patent policy bars a state from enforcing a contract regulating access to an unpatented secret idea. The Supreme Court held that Lear must be permitted to avoid the payment of all royalties accruing after Adkins' 1960 patent was issued, if Lear can prove patent invalidity. Justice Harlan emphasized, however, the Adkins' claim to contractual royalties accruing before the 1960 patent issued, raised a much more difficult question: whether and to what extent the states may protect the owners of unpatented



inventions who are willing to disclose their ideas to manufacturers upon payment of royalties; he added that the California Supreme Court had not addressed itself to this issue with precision: "Consequently, we have concluded, after much consideration, that even though an important question of federal law underlines this phase of the controversy, we should not now attempt to define in even a limited way the extent, if any, to which the states may properly act to enforce the contractual rights of inventors of unpatented secret ideas." He stated that "we believe that Lear must be required to address its argument attacking the validity of the underlying patent to the California courts in the first instance." Therefore the case was remanded to the Supreme Court of California.



F. Trademark Cases

American Basketball Ass'n. v. AMF Voit, Inc.

358 F. Supp 981, 177 U.S.P.Q. 442 (S.D.N.Y.), aff'd without opinion  
487 F.2d 1393, 180 U.S.P.Q. 290 (2d Cir. 1973)

Action for trademark infringement and unfair competition; this motion by plaintiff was for a preliminary injunction to prevent infringement of an alleged trademark owned by plaintiff. Motion denied.

The American Basketball Association (ABA) adopted the red, white and blue basketball which included ten uniform panels, the three colors alternating to form the red white and blue combination. When the ABA originally used its red, white and blue ball steps were taken without success to assert a design patent right over the coloration of the basketball; the ABA then applied for a copyright for the coloration of the basketball, and the application was rejected. In 1971 an application for trademark registration was filed by plaintiff with the Patent Office, and the trademark was published in 1972. Four separate oppositions to registration were filed including one by defendants AMF.

The court pointed out first that the basic issue of this controversy was whether the claimed trademark of the ABA was valid, and stated that "the mere coloration of the various panels of the ordinary basketball is not sufficiently distinctive to be the subject of a statutory trademark....the colors are merely a decoration or embellishment."

As to the plaintiff's claim of secondary meaning, the Court explained: "Basically, 'secondary meaning' within the trademark laws is equivalent to an association between the 'trademark' and the supposed source of the goods such that an ordinary man would immediately associate the goods with their source." The court then stated that at no time had the ABA held itself out to be the source of red, white and blue basketballs.

American Rolex Watch Corp. v. Ricoh Time Corp.

491 F.2d 877, 180 U.S.P.Q. 417 (2d Cir. 1974) aff'g 178 U.S.P.Q.  
49 (S.D.N.Y. 1973)

Action brought under section 43(a) of the Lanham Act, 15 U.S.C.



section 1125(a) (1970); the complaint sought injunctive relief and damages based on trademark infringement and unfair competition. The District Court judge had dismissed the complaint, and the appellate court affirmed.

The allegations arose from Ricoh's use on its wristwatches of a "trident" mark said to have infringed Rolex's "crown" mark used on its watches, and from Ricoh's use of a general configuration similar to that used by Rolex.

The appellate court agreed that the configuration of Rolex watches was not unique and had been on the market for many years; Rolex had failed to establish any secondary meaning for the configuration of its watches; Ricoh had clearly labeled its product and had not attempted to palm it off as a product of Rolex; Ricoh's trident mark was not so similar to Rolex's crown mark as to give rise to confusion; and there was no likelihood that an appreciable number of average prudent purchasers of wristwatches would confuse Ricoh's watch with the Rolex watch in view of, among other things, the widely disparate prices and marketing practices. Moreover, from a distance the watches all looked pretty much alike, but when seen nearby they looked different.

The court also pointed out that Rolex contended that the District Court had erred in applying the rule of Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964), and stated that: "Under Sears and Compco, the act of copying (even if there were proof of such) does not provide a basis for a charge of unfair competition....And, Rolex's reliance upon the interdiction of 15 U.S.C. section 1125(a) which forbids a false designation of origin appears to be misplaced in view of the prominent display of 'Ricoh' on the challenged watch...."

In re Bachman Chocolate Mfg. Co.

153 U.S.P.Q. 753 (Pat. Off. T.M. Trial & App. Bd. 1967)

This action involved an application for supplemental registration of the trademark of the Bachman Chocolate Manufacturing Company, which was refused by the examiner of trademarks. The applicant appealed. The refusal to register was reversed.

Applicant had described the mark as consisting of the entire configuration of the chocolate bar. The facsimile specimens filed with the application showed the configuration of the bar, but also the wording "BACHMAN" immediately above "THE



FINEST CHOCOLATE IN THE WORLD," imprinted in the center of the top side of the configuration. Registration was refused on the ground that the configuration was not registrable unless the word "BACHMAN" was added to the drawing, since the word formed an integral feature of the configuration.

The Patent Office Trademark Trial and Appeal Board stated in its opinion that it believed that the examiner's position was untenable, stating that "Section 23 of the Trademark Act provides for the registration of configurations of goods which are capable of distinguishing an applicant's goods and the examiner has cited no authority for his holding that some of the wording which appears on the configuration must form a part thereof." The court concluded:

"...it is our opinion that the shape of applicant's candy bar is somewhat unique in design and since the examiner has made nothing of record to show that this configuration is either so non-distinctive as to be incapable of distinguishing or has any functional aspects, it must be held that it is, prima facie, capable of distinguishing applicant's goods and, therefore, registrable on the Supplemental Register."

In re Baker Drapery Corp.

178 U.S.P.Q. 431 (Pat. Off. T.M. Trial & App. Bd. 1973)

In this case an application was filed to register a trademark for drapery hardware, described as a "fanciful representation of a portion of a drapery heading system." Registration was refused, and the Patent Office Trademark Trial and Appeal Board affirmed.

The design shown indicated an artist's fanciful representation of a short length of tape with one slider and the top of several folds or pleats of drapery undulating in a series of curves apparently embodying textile material. Registration had been refused on the ground that what applicant sought to register was a configuration of the goods, and dictated solely by functional considerations. The applicant on the other hand contended that the device sought to be registered was not a representation of its goods and that actually the device was an arbitrary, fanciful characterization of the goods.



which was opposed on motion for summary judgment. The motion was denied by the Patent Office Trademark Trial and Appeal Board, with a dissent.

The applicant had sought to register as a trademark a design which appeared on the crown of applicant's goods, namely, protective or safety helmets, hats, and caps. The design consisted of two beads or ridges intersecting at right angles in the form of a modified "T"; the application alleged that the design was primarily functional in nature, namely for strengthening the crown of the hat to provide extra protection against hard blows. The opposer alleged that applicant's requested mark formed a portion of the subject matter of an expired design patent owned by applicant's predecessor and now in the public domain, so that trademark registration would extend the statutory monopolistic life of the patent in perpetuity.

The Board, in discussing the effect of the Sears and Compco cases, as resolving whatever conflict may have existed as to the question of whether or not the subject matter of an expired design patent could function as a trademark, said that in the cited cases the Supreme Court did not, in its opinion, demarcate the area of patent protection from that of other federal statutory protection, including the Trademark Act of 1946.

"In this regard, it must be appreciated that if the Board were to make the ruling which the opposer is requesting through its motion, namely, that a configuration of goods is by virtue of the Supreme Court rulings unregistrable, per se, as a trademark, the Board would, in effect, be ruling that section 23 of the Act of 1946 which expressly provides for the registration of configuration of goods on the supplemental register [or, under section 27 on the principal register, as in this case] is unconstitutional. Obviously, the Trademark Trial and Appeal Board, an administrative tribunal, cannot presume to pass upon this constitutional question."

The Board also concluded that questions regarding functionality and secondary meaning could not be determined as a matter of law, on motion for summary judgment.



In re Fashionbilt Garment Co.

125 U.S.P.Q. 311 (Pat. Off. T.M. Trial & App. Bd. 1960)

This action concerned an application for registration of a trademark. Applicant appealed from a decision refusing registration. Affirmed.

The application was to register a trademark for women's apparel, namely coats and suits, and the applicant described its mark as "consisting of a scroll design having a plurality of loops on each side of a straight line which extends horizontally around the skirt portion of the lining of a garment and simulates embroidery." Registration had been refused on the ground that the subject matter of the application functioned as decoration or embellishment for the goods, rather than as a trademark to identify applicant's goods and distinguish them from the goods of others.

The Patent Office Trademark Trial and Appeal Board indicated first that the fact that applicant's scroll design was decorative or ornamental in nature was not in of itself a bar to registration under section 2 of the statute which provides that "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the Principal Register on account of its nature...." Hence the question here was whether or not applicant's scroll design was a trademark, that is to say, does it identify the goods from those manufactured or sold by others -- a question of fact.

Applicant had from time to time used the phrase "Look for the Embroidered Lining," and displayed the embroidery design in catalogs featuring its wearing apparel. However, the catalogs were distributed to jobbers and retailers of ladies' apparel for their own use. The Board concluded that "the record presented is insufficient to show that ultimate purchasers recognize applicant's scroll or embroidery design as an indication of origin for its goods."

Flexitized, Inc. v. National Flexitized Corp.

335 F.2d 774, 142 U.S.P.Q. 334 (2d Cir. 1964), modifying 214 F. Supp. 664, 136 U.S.P.Q. 590 (S.D.N.Y. 1963)

This action involved a claim of trademark infringement under the Lanham Act, 15 U.S.C. section 1051 et seq., together with claims of breach of contract and unfair competition.



From judgment for plaintiffs in part and defendants in part, both parties appealed. Modified.

Plaintiffs produced and marketed a flexible collar stay which they had developed. The essential characteristics of the collar stays were their capacity, when sewn into a collar, to retain a configuration or style shaped by the wearer. The term "Flexitized" was registered with the Patent Office as its trademark. There had been a contract between plaintiffs and defendants whereby the latter formed an affiliate using the name "Flexitized." However, plaintiffs finally discovered that defendants, without plaintiffs' knowledge, were selling collar stays which plaintiffs neither sold nor manufactured, and using the name "Flexitized" even after plaintiffs had terminated the agreement. The plaintiffs then brought this action in the United States District Court and the jury found that defendants had breached the contract. The lower court entered judgment that plaintiffs recover damages plus interest and costs, but held plaintiffs' trademark "Flexitized" was invalid, so dismissed the claim for trademark infringement; and as to the claim for unfair competition enjoined defendants from using the word "Flexitized" but refused to order an accounting and assessment of products made by defendants in connection with the use of "Flexitized" by them.

This court affirmed the judgment below in all respects except the refusal to grant plaintiffs an accounting. In turning to the question of unfair competition, the court determined that the applicable law was that of New York, rather than federal law and held that defendants' continued use of the word "Flexitized" after they had ceased to distribute plaintiffs' product made plaintiffs the victim of unfair competition, notwithstanding the fact that plaintiffs' mark had not yet acquired a secondary meaning as to either source or quality: "if plaintiffs are able to establish their sought-for lost profits with reasonable certainty, nothing in the case law of New York prevents the granting of accounting relief." Since the court held that plaintiffs' loss of profits were recoverable, it remanded the case on that point.

Haig & Haig, Ltd. v. Maradel Products, Inc.  
249 F. Supp. 575, 148 U.S.P.Q. 375 (S.D.N.Y. 1966)

Action for trademark infringement and unfair competition.  
Plaintiff moved for a temporary injunction, which was denied.



Plaintiff alleged trademark infringement under the Lanham Act, 15 U.S.C. sections 1051-1127, and dilution of its respective trademarks under the New York Anti-Dilution Statute, section 368 - d General Business Law. Plaintiff is a distiller of a Scotch whiskey known as "Pinch," a term registered as a trademark in 1955; it also registered in 1955 a trademark on its bottle with three indented sides, designated as the "Pinch bottle." Defendant's bottle is a pinch bottle with the word "Pinchy" imprinted in white letters on one of the indentations as does plaintiff's similar pinch bottle; the color of defendant's bubble bath is similar to plaintiff's Scotch. Defendant also put out a whiskey-colored after shave lotion called "Scotch 'n Soda," the bottle being of the same conformation as plaintiff's.

The court here felt that the degree of similarity between plaintiff's Pinch and defendant's Pinchy was striking, but not so striking between the after shave lotion and the Scotch. As to the strength of plaintiff's mark, the court said that "while the mark may be considered strong from the length of time that plaintiff has used it in connection with the selling of its Scotch in this distinctive type bottle, it is weak when considered as applied solely to the bottle." As to "intent to palm off products as those of another," the court thought that it was difficult to know at this stage, because of the wide difference in type of product, whether the public would believe that defendant's product was issued by or with the blessing of plaintiff. Turning to plaintiff's claim under the New York Anti-Dilution Statute the court remarked that "state law allowing injunction against the pirating of good will alone would seem to run afoul of the Supreme Court's 1964 decisions in the Sears and Compco cases." Hence plaintiff's motion was denied.

In re Honeywell, Inc.

169 U.S.P.Q.. 619 (Pat. Off. T.M. Trial & App. Bd. 1971)

This case involved an application for registration of a trademark. Registration was refused; applicant appealed. The decision was affirmed.

The mark was described in the application as consisting of "the arbitrary and unique combination of an outer cover ring of a thermostat and a center disk positioned concentrically within said ring, said ring and disk comprising a portion of the configuration of a thermostat." In refusing registration the



examiner had explained that the circular shape of the thermostat, and the details claimed as a mark were merely circular bands, dictated by the shape of the instrument and were without such distinguishing characteristics as to function as a trademark. The examiner had also urged that since the applicant had secured a design patent covering the shape, the subject matter could not be registered as a trademark whether or not the design patent had expired as here. The applicant had urged that the examiner's second assertion was not in accord with the decision in In re Mogen David Wine Corporation, 140 USPQ 575 (CCPA 1964).

The court, in affirming the refusal of registration, explained that:

"Since applicant's design patent expired in 1970, it is apparent that the issuance of a registration for the same subject matter, including the same mark and goods, would be inconsistent with the right of others under the terms of the patent grant to make fair use of the ornamental design for control instruments including thermostats after the expiration of the patent and that it would serve, in effect, to extend the protection accorded the patented design contrary to the purpose and intent of the patent law."

With respect to the possible applicability of the Mogen David case, the court said that the Mogen David case, relied on by applicant, was clearly distinguishable in that the applicant was seeking to register the subject matter of the design patent, namely, configuration of the bottle for a product contained therein and not for a bottle, per se, "whereas here applicant is seeking to register the design of the product for the product itself."

Knickerbocker Toy Co; v. Faultless Starch Co.  
467 F.2d 501, 175 U.S.P.Q. 417 (C.C.P.A. 1972)

Appeal by Knickerbocker from the unreported decision of the Patent Office Trademark Trial and Appeal Board (TTAB) granting appellee's motion to strike portions of appellant's pleadings in an opposition and two cancellations in regard to trademarks sought and registered by Faultless Starch Company. This court modified the decision and remanded.



Faultless (appellee) owned two registrations of a trademark consisting of a representation of a rag doll, covering laundry preparations; and also had filed an application to register the same trademark for laundry starch. Knickerbocker (appellant) owned a trademark registration of the word-mark "RAGGEDY ANN" for "stuffed rag dolls" and a copyright registration of a "stuffed rag doll" entitled "Raggedy Ann." The controversy here concerned appellant's right, in proceedings before the TTAB (Board) to rely on its copyright property in the doll. The Board had granted appellee's motions in their entirety and stated that the TTA Board had no jurisdiction to determine the validity of or infringement of a copyright since that authority rested with the federal courts (28 U.S.C. 1338(a)). The Board then had stated that the "sole question" before it was (1) whether the averments sought to be stricken comprised a claim of copyright infringement and (2) whether such a question could be determined by the Board as a collateral matter to the question of damage within the meaning of the Trademark Act of 1946. It answered the first question in the affirmative and the second in the negative, concluding that it was precluded from considering the second question and granted appellee's motion to strike.

The court at the outset said (Acting Chief Judge Rich writing the Opinion): "This is one of those often perplexing cases involving the interrelationship between various forms of intellectual property." The court held:

"We affirm the decision of the Board insofar as it struck portions of appellant's pleadings charging copyright infringement and unfair competition, but reverse the decision of the Board insofar as it struck portions of appellant's pleadings relating to its charges that confusion, mistake, or deception is likely to result from appellee's alleged use of a representation of appellant's copyrighted doll as its trademark or that registration of the mark may otherwise damage appellant. Because portions of appellant's pleadings relating to these three separate issues are hopelessly intermingled, we remand to allow appellant to replead. . . ."

Laura Secord Candy Shops Ltd. v. Barton's Candy Corp.  
368 F. Supp. 851, 179 U.S.P.Q. 715 (N.D. Ill. 1973)

Suit for trademark infringement and unfair competition.



Defendants' motion for summary judgment was granted in part and denied in part.

Plaintiffs had used the word TURTLES and representations of turtles in the sale of candy for years and registered them as trademarks with the U.S. Patent Office. Defendants' product, but not plaintiffs', was formed in the shape of a turtle, and was marketed in packages bearing photographic representations of the product and a claim that the candy was "turtle shaped"; they sold the candy under the name CREEPIES. Plaintiffs contended that defendants have violated plaintiffs' rights under the Lanham Act, 15 U.S.C. section 1051 et seq., the Illinois Deceptive Trade Practices Act, the Illinois Anti-Dilution Act, and the common law of unfair competition.

The court in this case concluded that plaintiffs had failed to show that they were entitled to an injunction against the shape of defendants' product even if its manufacture and sale created a likelihood of confusion and dilution. In explanation of this issue the court said:

"Likelihood of confusion and dilution can be remedied by requiring that packaging and labelling fairly warn purchasers of the true source of the product. Plaintiffs have not, and doubtless cannot, obtain a monopoly in turtle shaped candy under the patent and copyright laws, and this in itself provides reason for providing no such protection under the trademark and unfair competition laws. Cf. Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, . . . (1964); Compco Corp. v. Day-Brite Lighting, Inc. 376 U.S. 235 . . . (1964)."

The court went on to say, however, that the right to produce and sell a product did not create a right to describe it in a manner which infringed another party's trademark, but fairly and in good faith only to describe the product to purchasers. The court concluded that the issues of possible fair use and likelihood of confusion and dilution could not be resolved on a motion for summary judgment.

NOTE: On September 20, 1973 plaintiffs moved to have this court amend its opinion to certify the case for interlocutory appeal and the motion was granted. The court then pointed out that in granting partial summary judgment for defendants, this court



had held that plaintiffs under the facts could not enjoin defendants from manufacturing and selling turtle shaped candy, and explained further that "this appears to be a case of first impression on this issue;" and added that the question presented was a controlling one on which there was substantial ground for difference of opinion.

In re G. LeBlanc Corp.

57 C.C.P.A. 1339, 429 F.2d 989, 166 U.S.P.Q. 561 (1970), rev'd  
155 U.S.P.Q. 603 (Pat. Off. T.M. & App. Bd. 1967)

This was an application for registration of a trademark, which was refused. The applicant appealed. Reversed.

The applicant sought to register on the Principal Register as a trademark for trumpets the "plate-like configuration" visible on the brace of the trumpet, as actually used by appellant, which is a medallion bearing the profile representations of Georges Le Blanc, the founder of appellant corporation, and Leon, his son. It was sought to prove by letters from customers that "the medallion on the brace on the trumpet gives immediate recognition to the viewer (no matter what the distance) that this instrument is a Le Blanc; no other instrument has any identifying mark of that nature..." The examiner and the Board, in refusing to register appellant's mark, had taken the position that appellant was attempting to register the "mere location" of a particular medallion on the brace of a trumpet and that a "location" per se could not function as a trademark.

This court took a different approach saying that "on this record, we are satisfied that the configuration adopted by appellant is unique." The court held:

"Considering the evidence in the record as a whole, we are satisfied that the configuration asserted by appellant does function to distinguish its goods from those of others and, therefore, should be registered on the Principal Register under section 2 of the Lanham Act. The decision of the Board is reversed."

In re Master Kleens of America, Inc.

171 U.S.P.Q. 438 (Pat. Off. T.M. Trial & App. Bd. 1971)

This case involved an application for registration of a service



mark; from the decision of the examiner of trademarks refusing registration, the applicant appealed. The decision was affirmed.

The applicant had filed an application to register for clothes cleaning services a building design which was a representation of the building from which it rendered its services. Registration had been refused on the ground that the subject matter of the application had not been used as a mark to identify the origin of applicant's services.

In affirming the decision of the examiner, the Board explained its conclusion:

"In none of the advertising available to us does applicant use simply the representation of the building shown on the drawing. What applicant does use is the building with a sign thereon bearing the word 'MASTER KLEEN' and a silhouette figure. The representation of the building and the sign are so integrated that it conveys only a singular impression. In our opinion what is presented for registration is not the mark used to identify and distinguish applicant's services and in the absence of any evidence that the public recognizes the representation of the building without the sign appearing thereon, we conclude that the matter is not registrable."

The refusal to register was affirmed.

In re Minnesota Mining & Mfg. Co.

51 C.C.P.A. 1546, 335 F.2d 836, 142 U.S.P.Q. 366 (1964), rev'g  
136 U.S.P.Q. 676 (Pat. Off. T.M. Trial & App. Bd. 1962)

An appeal from the decision of the Trademark Trial and Appeal Board of the Patent Office, which had refused to register a trademark on the Supplemental Register. Reversed. Judge Rich wrote the opinion of the court.

The mark sought to be registered was the overall configuration of the promoter-chemical of undisclosed size; the goods were formed into triangular cakes which could be the size of a pill, a bar of soap, or a cement block. It was considered by appellant that ordinary purchasers of the goods would be likely to consider that the configuration of these goods did



indicate their origin, and in fact did consider the triangular shape as an indication of the origin of those goods. The ground for refusal of the mark was that it constituted the overall configuration of the goods and as such did not constitute proper subject matter for registration. The Board had admitted that section 23 of the Lanham Act (15 U.S.C. 1091) "specifically provided for the registration of a mark which consists of a 'configuration of goods'."

The court reached the conclusion that the shape adopted was entirely arbitrary and, except for its solidity (all shapes being solid), had no functional significance whatever. It cited and quoted In re Deister Concentrator Co., 48 CCPA, 952, 968, 289 F. 2d 496. . .

"Where a shape or feature of construction is in its concept arbitrary, it may be or become a legally recognizable trademark because there is no public interest to be protected."

In re Mogen David Wine Corp.

54 C.C.P.A. 1086, 372 F.2d 539, 152 U.S.P.Q. 593 (1967), aff'd  
145 U.S.P.Q. 85 (Pat. Off. T.M. Trial & App. Bd. 1965)

Appeal from the decision of the Trademark Trial and Appeal Board of the Patent Office, relating to an application filed in 1959 for registration of a trademark on the Principal Register, which was refused. This court affirmed.

The registration sought was for the configuration of a decanter bottle as a trademark for wines. Appellant contended that the mark had acquired, for wines, a secondary meaning. The Board had held that a then existing, but now expired, design patent covered the bottle of this application so that the configuration was precluded as a matter of law during the life of the design patent from constituting subject matter which might properly be registered on the Principal Register. On appeal this court, in In re Mogen David Wine Corp., 51 CCPA 1260, 328 F.2d 925 (1964), had held that the existence of the design patent did not preclude appellant's right to register on the Principal Register, and remanded the case to the Board for decision on the factual issue as to whether the evidence submitted was sufficient to establish that appellant's bottle design functioned as a trademark to indicate origin. In its decision on remand from this court the Board affirmed the examiner's refusal of registration on the ground of



insufficient evidence of secondary meaning. It is from the latter decision that the instant appeal was taken.

This court said that it found no indication that the configuration of the bottle per se was an indication of the origin of the wines, or that the container was promoted separate and apart from the word mark "Mogen David"; in fact there was no reference to the container itself. Therefore the court here agreed with the Board that the bottle had not acquired secondary meaning, and affirmed. Judge Smith concurred and stated his views at some length in reference to the brief filed by the solicitor, with whom he disagreed.

In re Olin Corp.

181 U.S.P.Q. 182 (Pat. Off. T.M. Trial & App. Bd. 1973)

This case involved an application for the registration of a trademark, which was refused and applicant appealed. Reversed.

The subject matter for registration was the letter "O" displayed in a highly stylized form and applied to the goods, which were T-shirts.

Registration was refused because the mark did not serve to distinguish the applicant's goods from "like goods of others," the examiner holding that as used on the T-shirts the marks appeared to be "merely ornamental."

The Board stated that the "ornamentation" of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source:

"In the case before us, the T-shirt is ornamented with applicant's trademarks, and considering the nature of T-shirts, that particular ornamentation can serve as an indication of a secondary source of origin. The matter sought to be registered is an arbitrary symbol and can and does function as a trademark. As used on the T-shirts, we conclude that the mark serves as an identifier of a secondary source and as such is registrable."

The refusal to register was, as indicated, reversed.



Planters Nut & Chocolate Co. v. Crown Nut Co.  
50 C.C.P.A. 946, 305 F.2d 916, 134 U.S.P.Q. 504 (1962), rev'g  
128 U.S.P.Q. 345 (Pat. Off. T.M. Trial & App. Bd. 1961)

This case involved a trademark opposition by Planters regarding Crown's application to register a design mark for goods "nuts, shelled and unshelled, and salted and unsalted." The opposer, Planters, appealed from a decision of the Trademark Trial and Appeal Board dismissing the opposition. Reversed, with dissents.

The design mark was in the form of an animated peanut, and applicant claimed use only since 1953. Opposer relied on use since 1916 of a trademark symbol consisting of a humanized peanut on the same goods, "salted peanuts and peanut bars." Its design was a male humanized unshelled peanut; the words "Mr. Peanut" appeared on the hatband. This character was depicted in various advertisements, and on billboards in three-dimensional form in giant size on the rooftops of stores and factories. Pushed to amazing popularity, he established identity for the company's package and brand name and enabled advertising to produce maximum results at the point of sale. The figure of appellee showed flowing royal robes and a crown and printed across the crown were the words "Fit For a King." A face also appeared on the peanut shell. The Board had found that "the marks of the parties were distinctively different in every material respect and that purchasers would not be likely to attribute products sold thereunder to a single source."

The court did not agree with this conclusion: "In our opinion, formed from observation, the marks resemble each other in many material respects." The court, in reversing the decision of the Board, said :

"Appellee is in no sense here exercising its right as a member of the public, engaging in the nut business to illustrate its product. It is, instead, asserting a right, which we do not believe it has, to tread closely on the heels of opposer's very successful trademark and promotion practices, and to acquire an exclusive right to use another little man in the form of a humanized peanut as its sales promotion device or trademark."

Chief Judge Worley and Judge Kirkpatrick dissented. Judge



Kirkpatrick said that to reach its conclusion, the majority must have based it upon a resemblance in the abstract idea stressed in the opposer's advertising rather than in the competing marks. "This, I think, is not in accord with the intent of the Trademark Law."

In re Port-A-Hut, Inc.

183 U.S.P.Q. 680 (Pat. Off. T.M. Trial & App. Bd. 1974)

In this case an application was filed to register as a trademark on the Supplemental Register a portable pig shelter. The decision refusing registration was appealed and affirmed by the Appeal Board.

Registration was refused on the ground that the design sought to be registered was considered to be merely a representation of appellant's goods and not capable of distinguishing applicant's goods from those of others.

Here, as the Board pointed out, the overall configuration of appellant's product was, at its inception and its subsequent use, necessarily governed by its basic and essential utilitarian function as a farrowing house and pig shelter. It explained further that the basic shape of the product resembled that of a Quonset hut dictated by the desire to provide, as indicated in the specimen brochures, easily assembled, completely portable units telescoped together for transporting. In the course of the opinion, there was some discussion of the possible impact of In re Minnesota Mining and Manufacturing Company, 142 USPQ 366 (CCPA 1964), which held that the overall configuration of a product is registrable on the Supplemental Register if it possesses the capacity to distinguish an applicant's goods. The applicant here relied on the Minnesota Mining case, but the Board stated:

"...not everything that a party adopts and uses with the intent that it function as a trademark necessarily achieves this goal or is legally capable of doing so and not everything that is recognized or associated with a party is necessarily a registrable trademark."

It was concluded that the configuration of applicant's product was essentially functional or utilitarian in character, and that it was therefore incapable of performing a trademark function.

In re Quikey Mfg. Co.

159 U.S.P.Q. 490 (Pat. Off. T.M. Trial & App. Bd. 1968)

This was an application for supplemental registration of a trademark. From the decision refusing registration, the applicant appealed. Affirmed.

The application involved the configuration of goods represented by vacuum cup soap holders; the applicant urged that the configuration sought to be registered was capable of distinguishing its goods in that its "circular three-dimensional configuration" was distinctive and was not dictated solely by functional considerations. It relied on the decision in In re Minnesota Mining and Manufacturing Company, 142 USPQ 366 (1964) in which it was held that an arbitrary, non-functional triangular three-dimensional configuration of a chemical composition in solid form was registrable on the Supplemental Register.

The Board, on appeal stated that it did not agree with applicant that what it was seeking to register was a particular shape, since the suction cups were the most prominent feature of its configuration, and it was readily apparent that the cups were dictated solely by functional considerations. "In any event, a circular shape is as common as a square or rectangle and cannot, therefore, be considered as a distinctive shape."

The court went on to say that:

"Under all the circumstances, the configuration sought to be registered is clearly distinguishable from the type of configuration presented in the 'Minnesota Mining' cases, supra, and is an overall configuration of goods without distinguishing characteristics other than those dictated solely by functional considerations."

Remington Arms Co. v. Weatherby's, Inc.

141 U.S.P.Q. 844 (Pat. Off. T.M. Trial & App. Bd. 1964)

This action related to a trademark cancellation sought by Remington against Weatherby, which had a trademark registration of a diamond design for firearms, issued in 1961. The petition was granted and the registration canceled.



Petitioner had alleged that the registered mark was merely decorative in nature, thus incapable of distinguishing registrant's firearms from like goods of others. The respondent, Weatherby, contended, however, that it adopted the diamond inlay to be applied to the grip cap of all its firearms to indicate origin of the goods and had used the design continuously in that position on the firearms so that it "has become synonymous with the goods of the respondent."

The Board, in coming to the conclusion that the registration should be canceled, stated that in view of such common usage of a diamond shaped design in the firearms trade, it was manifest that a design of this character was incapable of distinguishing the firearms of any one producer from those manufactured or sold by others.

"Accordingly, there can be no question but that respondent's registration with the presumptions afforded it by the statute is inconsistent with the right of petitioner and others in the trade to continue to utilize as they have in the past a diamond design for ornamentation of firearms. (citing cases)"

In re Servotronics, Inc.

156 U.S.P.Q. 592 (Pat. Off. T.M. Trial & App. Bd. 1968)

This case involved an application to register a trademark. Applicant appealed from the decision refusing registration. Reversed.

The design which applicant sought to register showed a letter "s" entwined around a drawing of a globe, or map, of the world; that is, the letter "S" encircled the globe and part of it extended in a long line with the representation of an airplane at the end of the line. The mark was to be used for umbilical connectors, torque motors and servo valves. Registration was refused because the matter sought to be registered did not constitute the mark as actually used. The examiner had held that that which was sought to be registered was a mutilation, in that it separated the letter "s" from the remainder of the name and because the elongated line extending from the letter "S," and the representation of an airplane designated an area in which the remainder of the trade name was placed.

However, the Board agreed with the applicant that what was sought



to be registered was, per se, an inherently distinctive design and as actually used created an impression separate and apart from the trade name "SERVOTRONICS, INC. The Board also stated:

"The record further shows that applicant has used in promotional material substantially the design herein sought to be registered apart from its trade name, differing only to the extent that the 'slipstream' is not elongated."

Accordingly, the Board concluded that the subject matter of the application was a mark and registrable.

In re Shaw

184 U.S.P.Q. 253 (Pat. Off T.M. Trial & App. Bd. 1974)

This case involved an application for registration of a trademark on the Supplemental Register. From a decision refusing registration, the applicant appealed. Affirmed.

The applicant, Carolyn Hagner Shaw, filed an application to register for a publication ("The Green Book") a mark described as "the green suede cover of the book as a package or configuration of goods," the mark having been used since 1930. It had been held that the mark was not registrable on the Principal Register in the absence of evidence that it had acquired a secondary meaning or become distinctive, and held that the shape of the book was in its concept utilitarian or nonarbitrary. Application to register on the Supplemental Register was refused.

The Board, on appeal pointed out that the subject matter for registration of a mark on the Supplemental Register need be only for a mark "capable of distinguishing applicant's goods." However, the refusal to register was affirmed and the Board explained:

"Applicant's cover is green, the entire cover is green. The overall application of the color green to the cover of a book lacks distinction. It is a matter of common knowledge that covers of books are presented in overall colors and it is clear beyond peradventure that the color green of applicant's goods is not capable of distinguishing applicant's book as to origin from other books having green covers. Further, color is not subject to trademark



exclusiveness, except in connection with some definite arbitrary symbol or design. [citing cases.]"

In re Shenango Ceramics, Inc.

143 U.S.P.Q. 48 (Pat. Off. T.M. Trial & App. Bd 1964)

Appeal from the decision of the examiner of trademarks regarding an application for registration on the Principal Register of a trademark of Shenango Ceramics, which was refused. Affirmed.

What applicant sought to register for china dishware was a molded rim (RIM-ROL) located midway between the outer edge and the foot of the plate and making "a firm gripping surface for wet, slippery fingers." The applicant asserted that it made no difference whether the device was the subject matter of a patent or not (here an expired patent) and stated that the only question to be decided was whether or not the matter presented for registration distinguished applicant's ware from ware produced by others, citing In re Mogen David Wine Corporation, 140 USPQ 575 (CCPA, 1964). Applicant further contended that the matter it was seeking to register was not "a feature dictated solely by 'functional' (utilitarian) considerations," citing In re Deister Concentrator Co. Inc., 129 USPQ 314.

The Board explained that in this connection the Court of Customs and Patent Appeals in a more recent decision, In re Minnesota Mining and Manufacturing Company, 142 USPQ 366, had indicated that the Mogen David case (which was distinguishable from the instant case), dealt only with the right to register "the overall configuration of an ornamental container for a beverage."

The Board, which cited the Deister case as in point, concluded that it appeared obvious that the molded rib construction which applicant sought to register was merely a functional feature of its chinaware and, as such, was inherently incapable of functioning as a trademark for its goods.

NOTE: This case was affirmed on appeal, 53 CCPA 1268 (1968), wherein Judge Martin expressed the view of the court in his opinion that the expired utility patent was adequate evidence that the under-rim configuration sought to be registered was indeed functional, and did not find that the Board had erred



in rejecting the contention that the configuration was registrable because its functionality was so incidental as to be "arbitrary" or a mere design. Judge Martin also said that the court found that the Mogen David case and the Minnesota Mining case were not apposite to this case: the Mogen David case involved the design or non-functional configuration of a container for goods and thus could not stand as precedent on the functionality issue here; the Minnesota Mining case involved an arbitrary, non-functional configuration of goods. Judge Martin added a further comment: "so far as is pertinent to registrability for federal trademark protection, we believe Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 and Compco Corp. v. Day-Brite Lighting, Inc. 376 U.S. 234, to be consistent with the result reached herein."

Societe Comptoir De L'Industrie Cotonniere v. Alexander's Department Stores, Inc.  
299 F.2d 33, 132 U.S.P.Q. 475 (2d Cir. 1962), aff'g 190 F. Supp. 594, 128 U.S.P.Q. 242 (S.D.N.Y. 1961)

Suit for trademark infringement and unfair competition. From orders denying motions for preliminary injunctions, plaintiffs appealed. Affirmed.

The motions for preliminary injunction sought to enjoin the use by defendant of the names "Dior" and "Christian Dior" which are registered as trademarks. Defendant used the names extensively to promote the sale of garments copied from original creations designed by the House of Dior. The garments were copies of plaintiffs' original creations, and the merchandise was so described in newspaper advertisements, on hang tags attached to the garments reading "Original by Christian Dior -- Alexander's Exclusive -- Paris -- Adaptation," and on a television fashion show sponsored by defendant which employed a singing commercial. The district court concluded that no attempt had been made to deceive the public and that no deception or confusion existed with respect to the garments being sold or as to sponsorship by plaintiffs.

The appellate court pointed out that the Lanham Act does not prohibit a commercial rival's truthfully denominating his goods as a copy of a design in the public domain, though he uses the name of the designer to do so: "In the case at bar it is conceded that the 'pirating' of the design is lawful and proper. Fashion Originators' Guild of America v. F.T.C. 114 F. 2d 80 (2d Cir. 1940), aff'd, 312 U.S. 467, 48 USPQ 483 (1941)."



The court said further that "the interest of the consumer here in competitive prices of garments using Dior designs without deception as to origin, is at least as great as the interest of plaintiffs in monopolizing the name."

Tiffany & Co. v. Tiffany Tile Corp.

52 C.C.P.A. 1396, 345 F.2d 214, 145 U.S.P.Q. 483 (1965), rev'g  
139 U.S.P.Q. 311 (Pat. Off. T.M. Trial & App. Bd. 1963)

This case involved a trademark opposition by Tiffany against Tiffany Tile Corp. From the decision dismissing the opposition, the opposer appealed. Reversed.

The Tile Corporation had sought registration of "Tiffany Tile" for use on ceramic tile. A jewelled crown design was used to dot the "i" in Tiffany. Tiffany and Company opposed on the basis of forty-seven registrations of "Tiffany" and/or "Tiffany & Co." for a wide variety of household and personal articles including ceramics and porcelain products, such registrations antedating "Tiffany Tile" by many years. The Trademark Trial and Appeal Board, despite the virtual identity of the marks in issue, had been of the opinion that confusing similarity would be precluded because the goods had "nothing whatever in common," and dismissed the opposition.

This court said that its review of the record led it to a different conclusion than that of the Board. The Court said further:

"We are not here dealing with such diverse products as bulldozers and cosmetics, but with products that are, in the main, decorative in nature and appeal, made from the same basic material, and normally found and used in homes. Under such circumstances, we are satisfied that the average purchaser seeing such a well known mark as 'Tiffany' on the involved goods would be likely to assume they emanated from the same source."

In re Weber-Stephen Products Co.

184 U.S.P.Q. 509 (Pat. Off. T.M. Trial & App. Bd. 1974)

This case involved an application to register on the Principal Register a trademark for barbeque grills. Registration was refused.

The design was a composite of a generally spherical kettle having a rounded cover, a triangular grillwork bottom shelf, and a tripod stand composed of straight, downwardly divergent legs which, according to applicant, was in its concept arbitrary in concept, distinctive of applicant's goods, and serving as a trademark to denote origin in applicant.

The Board concluded that the overall configuration of applicant's grill was essentially functional in character and hence did not possess the necessary attributes of a proprietary trademark. In the course of its explanation the Board stated that "a shape or configuration of a product which is in its concept essentially utilitarian or non-arbitrary cannot function as a trademark under the provision of the statute, either under the Principal or Supplemental Register."

In re World's Finest Chocolate, Inc.

474 F.2d 1012, 177 U.S.P.Q. 205 (C.C.P.A. 1973) rev'g 166 U.S.P.Q. 63 (Pat. Off. T.M. Trial & App. Bd. 1970)

Appeal from the decision of the Trademark Trial and Appeal Board sustaining the examiner's refusal to register a design trademark for "candy." Reversed.

A specimen of applicant's candy showed it to be a four-ounce chocolate bar shaped to simulate railroad ties, with an inner wrapper of silver foil and a wrapper of silver foil and a white wrap-around wrapper upon which appeared, among other things, the trademark "WORLD'S FINEST." The shape of the packaging for the candy conformed to the shape of the candy itself. The trademark examiner had refused registration on the ground that the packaging for applicant's product was not inherently distinctive and did not serve to identify applicant's candy bars and distinguish them from similar goods of others.

On appeal the Court explained, after a comparison of this case with In re Deister Concentrator Co., 48 CCPA 952, 289 F.2d 496 (1961):

"We do not agree that the package design here is so functionally oriented within the sense of In re Deister that, assuming de facto distinctiveness, a private right to use it exclusively should be denied in favor of a more pleasing public interest in copying. We think competitors can readily meet the



demands for packaged candy bars by use of other packaging styles, and we find no utilitarian advantages flowing from this package design as opposed to others as was found in the rhomboidally-shaped deck involved in Deister."

The court accordingly held that on the record the package design did in fact identify appellant's goods and distinguish them from those of others. Appellant was therefore entitled to registration.

Zippo Mfg. Co. v. Rogers Imports, Inc.  
216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963)

This action was for trademark infringement and unfair competition in which defendant counterclaimed for unfair competition. Judgment for plaintiff in part and defendant in part.

In 1956 Zippo introduced its "slim-lighter," a new model designed to appeal to women; it included the same mechanical features as its standard lighter, but it was noticeably narrower and, therefore, less square and more rectangular in shape. In 1957 defendant began to sell imported Japanese lighters with full knowledge that they closely resembled the Zippo lighter, in fact there was a striking similarity in shape and appearance. Also defendant used the name "slim-lighter" which plaintiff claimed as an act of trademark infringement. The marking on the imported lighter read, "Rogers, Inc., New York, N.Y., made in Japan." The evidence showed that the Zippo lighters were superior to the Rogers lighters, which were sold for less.

The court said:

"...even though copied features are functional, if plaintiff has proved (as it has with respect to the standard lighter) secondary meaning as to any or all of these features and likelihood of confusion, the case does not end. If defendant has not taken reasonable steps to set its lighter apart from plaintiff's, plaintiff may still be entitled to relief....in the exercise of my discretion, because of the high likelihood of confusion between these almost identical lighters, I find that defendant should take further steps to

differentiate its lighter from plaintiff's, although no accounting should be ordered or damages awarded for past failure to take these steps."

The court held, however, that use of the word "slim-liner" did not amount to trademark infringement because it was purely descriptive of plaintiff's slim-lighter model for which there was no secondary meaning. No relief was granted on defendant's counterclaim.